

Report Q167

in the name of the Argentinean Group
by Ricardo RICHELET, Daniel DE LAS CARRERAS, Alicia Alvarez DE BERKENWALD,
Carlos ALONSO and Martín BENSADON

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

- 1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

A prior art disclosure before the filing date or priority date may render the invention unpatentable for lack of novelty or lack of inventive step.

In principle there are no differences established in Argentine legislation between prior art regarding novelty on the one hand and inventive step on the other hand (Section 4 of the Argentine Patent Law No. 24,481, as amended, hereinafter, the "Argentine Patent Law").

Section 4 of the Argentine Patent Law does not provide that pending applications not yet published, which are later on published, may affect the assessment of novelty and inventive step applications with a later filing date. In any event, according to Section 15 of the Argentine Patent Law, to avoid double patenting for applications filed in the same jurisdiction, priority is given to the applicant that first filed the application.

- 1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Section 4 of the Argentine Patent Law does not define the term "disclosure". In any event, paragraph b) of said Section provides that "(l)ikewise, all inventions not included the state of the art, will be considered novel."

Section 4, Subparagraph c, defines prior art ("estado de la técnica") as "*... all technical knowledge which has become public before the date of filing of the patent application, or, if applicable, of the recognized priority, by way of oral or written description, by use, or by any other means of disclosure or information, in the country or abroad.*"

- 1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.*

There are no guidelines other than those given by law in Argentina for determining when a piece of prior art has been disclosed. In any event, it is not unusual for Argentine examiners to informally follow the guidelines of the European Patent Office.

2. Criteria for disclosure

- 2.1 *Means of disclosure*

What are recognised means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclo-

sure through written documents? If certain means of disclosure are not recognised either by law or in practice, what are the reasons?

The Argentine Patent Law (Section 4, Subparagraph c) recognises as acceptable means of disclosure:

- (a) oral or written descriptions;
- (b) use;
- (c) any other means of disclosure or information.

The Argentine group considers that the Argentine Patent Law definitions are so broad in connection with disclosure, that no means of disclosure should be considered as not recognised by law.

There are no additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents.

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

The only relevant date pursuant to the Argentine Patent Law is the date of application or the priority date. As long as the disclosure was made before such dates, the knowledge or information disclosed will be considered to be a prior art disclosure. To be sure, evidence on the existence of such disclosure should be available.

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

Section 4, subparagraph c of the Argentine Patent Law expressly provides that the disclosure may happen "*in the country or abroad*". Accordingly, the place of disclosure is not relevant for the Argentine Patent Law with respect to patents.

However, in respect to utility models, Section 55 of the Argentine Patent Law requires that a model must be new and have an industrial nature, but the lack of inventive merit *or the fact that it is known or has been disclosed abroad* shall not constitute a bar for obtaining protection thereon. Thus, the place of disclosure seems to be relevant for utility models. Nevertheless, Section 55 of the Decree regulating the Law sets forth that the novelty of the utility model will not be lost provided that it is the applicant himself that has disclosed the model or made it known abroad and only within six months prior to filing the application in Argentina. Thus, according to the regulatory decree, if the model was disclosed abroad - but not in Argentina, according to Section 55 of the Patent Law - by applicant himself, and the application is filed within six months of the disclosure, novelty is not affected.

The applicable law for determining whether a disclosure has occurred is the Argentine Patent Law, regardless of the country where the information was disclosed.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

Section 5 of the Argentine Patent Law provides that "*The disclosure of an invention shall not affect its novelty, when within one year prior to the date of filing the patent application, or, if applicable, of the recognized priority, the inventor or his lawful successors have dis-*

closed the invention by any means of communication or have exhibited the same in a national or international fair. ..."

Therefore, if the disclosure was made by the inventor or his successors within the one-year grace period, the novelty and inventive step of the invention will not be affected. Novelty and inventive step would be affected if such disclosure is made by any other person.

If the disclosing person was bound by a confidentiality agreement, the Argentine group is of the opinion that the disclosure should not be taken into consideration for novelty and inventive step purposes. There are not express provisions in Argentine legislation, nor any relevant case law in Argentina as regards this particular issue.

There are no precedents either in connection with errors in the disclosed information. In any event, the Argentine group is of the opinion that the nature of such errors would be decisive, namely, whether such errors would implicate that the disclosure did or did not effectively occurred. That, to be sure, should be determined on a case by case basis.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

There are no express provisions or guidelines regarding the ability to understand the information by the recipient. In any event, the Argentine group is of the opinion that the Patent Office or the Courts would consider that there was a disclosure, even if the recipient could not understand the information, especially if the recipient could further disseminate the information without limitations.

As provided by Section 4 of the Argentine Patent Law, use of the invention, even if it is not possible to understand the invention, will be considered to be prior art affecting novelty and inventive step. If reverse engineering or disassembly of embodiments were necessary to obtain the information, the Argentine group believes that disclosure would not be considered to have occurred, unless there was an effective use of the invention.

There are no specific rules providing for the effect of confidentiality or implied confidentiality agreements. In any event, the Argentine group is of the opinion that if the information is disclosed under an explicit or implied confidentiality agreement, disclosure for prior art purposes should be deemed as not having occurred. As stated in the answer to question 2.4., if the agreement is breached and the information is released to the public, disclosure would be considered to have occurred, with the ability of the inventor to seek damages from the person breaching the implied or explicit confidentiality.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

As explained in question 2.1., Section 4, c, of the Argentine Patent Law expressly provides that any means of disclosure is acceptable.

There are no specific requirements for disclosure through paperless information, such as the one existing in electronic networks or on the internet.

With respect to the various forms of networks or communications, such as the Worldwide Web, chat groups or forums or e-mail, the relevant issue would be whether a disclosure has

occurred according the general rules for any type of disclosure. Section 4, c, of the Argentine Patent Law only provides that the information must have "become public." If the information was made available to the public through any of the above mentioned means without limitations, then disclosure would have occurred.

Certainly, the level of accessibility to the network should be taken into account to determine whether the information became public or not. For instance, encrypted or private e-mail should not in principle be considered as prior art. However, there could be a grey area when the recipient could use the information without any type of restraints or confidentiality limitations, especially in such cases where such e-mail communications were effectively further legally disseminated.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

Encryption of the information may be relevant if it impedes that the information becomes public. The same applies for passwords.

It does not seem a necessary requirement for the existence of disclosure the fact that the information is made available to the public through the use of search engines. As long as the public has the ability to accede to that information without limitations through other means, disclosure should be considered to have happened, regardless of whether or not there has been actual access.

A simple payment requirement does not seem to impede access to the information by the public, and therefore should not be considered a bar to the existence of disclosure.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

As explained in the answer to question 2.3., the place of disclosure ("*in the country or abroad*") is not relevant for the Argentine Patent Law as regards patents.

For utility models, there are no rules regarding what is the place of disclosure if the information is put on the internet, nor is there any especial condition or requirement in that respect. In any event, the Argentine group is of the opinion that the mere fact that a web-site can be accessed in Argentine should be considered to be sufficient local disclosure.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

There are no specific requirements regarding the timing and duration of information available through electronic means. The Argentine group is of the opinion that as long as the information was available long enough so as to become available to the public, the duration should be considered sufficient. That should be determined on a case by case basis.

The creation of archives keeping all information that was at any time available to the public on the internet, or through any other electronic means, is an idea that seems difficult and probably expensive to put into practice.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed

through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

The principle should be that the burden of proof rests on the Patent Office during the prosecution of a patent application, or on the party who claims the nullity of the patent for lack of novelty or inventive step. In any event, if applicant (in the prosecution of application) or the plaintiff (in nullity cases) has that information easily available for him, then the burden of proof could shift to them.

Internet does not seem to require rules different from those already existing for oral disclosure or other ways of disclosure. In any event, the most difficult issue seems to appear when it is necessary to determine the precise date on which the information was published on the internet, especially in those cases in which the information is not available any longer at the time when the existence of novelty or inventive steps has to be determined.

Cases of manipulation of information through new media do not seem to require different standards than those existing for any other means of disclosure.

Summary

Under Argentine Patent Law, the existence of disclosure is construed very broadly. Disclosure may occur by way of oral or written description, by use, or by any other means, including new media such as the internet. There are, however, no precedents or express guidelines in connection with disclosure through new media. Therefore, many issues related therewith, such as questions of evidence, accessibility and duration of the information, will have to be considered on a case by case basis.

Zusammenfassung

Unter dem Argentinischen Patentgesetz, die Existenz der Veröffentlichung ist ausführlich ausgelegt. Die Veröffentlichung kann durch mündlicher oder schriftlicher Beschreibung, durch Verwendung, oder durch andere Weisen, wie Internet, stattfinden. Es gibt aber keine Vorfahren oder Regeln in Beziehung mit Veröffentlichung durch neue Weisen. Deswegen, viele Fragen in dieser Hinsicht, wie Fragen über Evidenzmittel, Zugang und Dauer der Information, sollen für jeden Fall beantwortet werden.

Résumé

Aux termes de la Loi des Brevets argentine, la possibilité de révéler un secret industriel est analysée d'une manière générale et vague. La révélation des secrets pourrait arriver en forme d'une description orale ou écrite, pour l'usage, ou par quelque moyen, inclus l'Internet. Il n'y a pas des précédents ou des expresses guides relatives à la révélation des secrets avec des nouveaux " media " moyens. En conséquence, beaucoup des aspects comme des questions de preuve, des possibilités d'accès à l'information et sa durée, devons être considérés dans chaque cas.

Report Q167

in the name of the Australian Group
Andrew MASSIE, Michael DOWLING, Wayne CONDON and Peter FRANKE

Current standards of prior art disclosure in assessing novelty and inventive step requirements.

A. Introduction

Patents Act 1990 (Cth) (the Patents Act) and the Patents Amendment Bill 2001 (the Patents Bill)

- a) When this Report is considered at Lisbon in June 2002, changes proposed to the treatment of prior art under *the Patents Act* will have come into force as at 1 April 2002 under *the Patents Bill*. We report the “before and after” positions in Australia because the evolution of the patent law here may be of assistance to others in determining harmonized positions internationally.
- b) The tests for novelty and inventive step require comparison of the claimed step with prior art bases defined by statute for each respectively. The tests both for novelty and inventive step will be more stringent by expansion of the data included in the respective prior art bases of those tests.
- c) There will be a higher burden of proof on an applicant to establish novelty and inventive step. Under *the Patents Act* before April 2002, an applicant is given the benefit of doubt. Under *the Patents Bill*, the applicant is required to demonstrate that the subject is new and inventive on the balance of probabilities.

What are the main principles with regard to the relationship between disclosure, novelty and inventive step?

- d) *The Patents Act* specifies the tests to determine novelty and inventive step. Both novelty and obviousness require that the data taken into account as relevant prior art must have been disclosed. What amounts to disclosure is determined by common law decisions which are dealt with in Section 1 below.

Pre April 2002

- e) The prior art base for novelty is documented information published anywhere world wide or information arising from an act done in Australia. This is a standard partly international and partly local.
- f) As to inventive step, the prior art base is basically the common general knowledge (**CGK**) in the relevant field in Australia. The effect of CGK may be considered on its own or together with documents published anywhere in the world, or with each particular piece of information which arose through doing an act in Australia.
- g) Each document or act is considered on its own with CGK unless there is cause to link more than one document or act together.
- h) Two or more related documents or two or more related acts can be treated together, provided that those sources would be reasonably expected to have been ascertained, understood and regarded as relevant to work in the relevant art by persons

skilled in the art in Australia at that time, and treated as a single source. The test as to what comprises CGK is common law – see the 3M test below. See (j) in Section 1 below.

- i) Thus, the prior art base in relation to novelty is wider than for inventive step. This recognises the view current when *the Patents Act* came into force in Australia in 1990 that inventors in Australia possibly had more limited information available to them in relation to inventive step.

Post April 2002

- j) Under the amendments introduced by *the Patents Bill*, the prior art base changes for both novelty and inventive step. For novelty, relevant information made available through doing an act will not be limited to Australia. The prior art base will be documented information published, or information made available through the doing of an act, in either case, anywhere in the world. That test is an absolute novelty test.
- k) In relation to inventive step, the prior art base will be extended to include documents published and acts occurring anywhere, and oral disclosures in Australia. Whether a document or act which is the source of prior art information is to be treated separately or in combination with another document or act, is essentially as before. The rules are outlined in (f), (g) and (h) above.
- l) In every case the document(s) or act(s) is or are (as before) to be read in the context of the CGK in Australia at the priority date.

1. Determination of prior art

1.1 What is the effect of a prior art disclosure on novelty and inventive step?

- a) A disclosure which is part of the respective prior art bases for novelty or inventive step will destroy the validity of a putative invention and thus of a patent or application for patent for that invention. This assumes of course that the disclosure has the effect of robbing the subject of novelty or making it obvious.

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?

- b) There are differences between novelty and inventive step in the characterisation and effect of prior art with respect to each, as well as in the prior art base. The following statements describe the position which applies from 1 April 2002.

Novelty

- c) In relation to novelty, the prior art must have been 'made publicly available'. This is not defined in *the Patents Act*. There are common law decisions that for documents, they must have been made available without restriction, somewhere in the world. There are likewise decisions that non-documentary disclosure is determined by whether the communication was made to the public.
- d) In assessing novelty, you may not make a 'mosaic' out of the prior art information - ***Minnesota Mining & Manufacturing Co & 3M Australia Pty Ltd v Beiersdorf (Aust) Ltd*** (1980) 144 CLR 253 (**3M**) decided in the High Court of Australia. The prohibited mosaic would be made (for example) by selecting individual items of information from prior documents or objects and putting them together to make them appear as one item like the subject of the invention in question.
- e) In considering novelty, several tests have been developed by the courts for determining whether the prior art invalidates a patent. The issue of novelty is assessed taking into account the common knowledge in the art with regard to how the person skilled in the art would interpret the prior art.

- f) Firstly, the prior art must contain an 'enabling disclosure'. That is a disclosure which gives enough information to the person skilled in the art to perform the invention. Secondly, for a prior publication to rob a subject of novelty, it must give 'clear and unmistakable directions' as to each of the elements of that subject.
- g) Another test of want of novelty is the reverse infringement test, which was referred to again in the Federal Court of Australia in **Advanced Building Systems Pty Ltd v Ramset Fasteners (Aust) Pty Ltd** (1993) 26 IPR 171 - if the patent were valid, would the alleged anticipation constitute an infringement of it? This requires identification of what are the 'essential integers' of the invention. If the only difference between the two subjects (ie. the prior art and the invention in question) is an 'inessential integer', the invention would be anticipated.

Inventive Step

- h) In relation to inventive step, the issue is whether there is an inventive step as compared with the prior art base. This essentially involves determining what a person skilled in the field would have done faced with solving the problem to which the patent is addressed, as at the priority date of that patent in the light of the prior art base. The relevant hypothetical person skilled in the art is regarded as unimaginative and uninventive.
- i) Accordingly, it is necessary first to identify the field relevant to the invention in question and the CGK relevant to that field. The question of what persons skilled in the field would have had as routine background knowledge cannot be identified until the area of inventive activity is identified.
- j) A test for determining the relevant CGK has been set out by the High Court in the *3M* decision (above). *3M* states that the CGK includes what is routinely known or used by those in the trade. That is, the information that forms the background knowledge and experience that is available to all those in the trade when considering making new products. It is likely that this test will continue to apply after April 2002.
- k) Having determined the CGK applicable, each document or act which is part of the prior art base is assessed as to what its relevance and effect would have been on the hypothetical non-inventive skilled person seeking to solve the problem without the benefit of knowing what the patentee has disclosed and claimed.
- l) Again, prior art documents and acts can only be combined with each other if they would have been treated as a single source by persons skilled in the art as at the priority date.

Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

- m) Pending patent applications, whether open to the public or not, can invalidate a later patent application, for want of novelty. The same tests of novelty referred to above, apply.
- n) Pending applications not open to the public, do not affect inventive step. Pending applications open to the public, can affect inventive step. The same tests of inventive step referred to above, apply.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

- a) What constitutes a prior art disclosure depends first upon whether the subject is part of the prior art base (which is defined by statute) and secondly, on whether the subject has been disclosed. What amounts to disclosure is determined by common law decisions, the effect of which is stated above.

1.3 Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.

- (b) In Australia there are no guidelines other than those given by law, which is a combination of statute and common law.

2. Criteria for Disclosure

2.1 Means of disclosure

What are the recognized means of disclosure?

- a) Disclosure may be in any form which makes the information available to the public. This clearly includes oral and documentary disclosures, and disclosure by public use or sale. There is no specific limitation in law on the form in which the disclosure is made. A general interpretation statute, the *Acts Interpretation Act*, makes it plain in s25 that the term “document” extends, for example, to

“any article or material from which sounds, images or writings are capable of being reproduced with or without the aid of any other article or device”.

It seems likely that this would encompass material which can be viewed via the internet. For example, in *Aktiebolaget Hässle v Alphapharm* [1999] FCA 628, the court considered as part of the CGK material which an expert located and viewed using the internet.

Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?

- b) The decided cases draw more of an evidentiary as opposed to substantive distinction between different forms of disclosure. For example, a disclosure by public working of an invention is more readily accepted than a written document, as in this case there is no doubt about the sufficiency of the disclosure. Case law states that a written disclosure needs to contain “clear and unmistakable directions” - for example, in *Flour Oxidising v. Carr* 25 RPC 428.

If certain means of disclosure are not recognised either by law or in practice, what are the reasons?

- c) *The Patents Act* contains specific savings for certain types of disclosure, for example:
- Disclosures without the consent of the applicant
 - Disclosures to State, Territory or Commonwealth governments
 - Recognised international exhibitions
 - Disclosures to learned societies
 - Reasonable trial by the applicant

For the purposes of inventive step, disclosures by some means may not meet the test of “..reasonably expected to be ascertained, understood and regarded as relevant” (see *Section A(h)* above). For example, public working of a machine but which working is not readily ascertained or understood by the skilled person (for example in a sealed housing) would not be relevant for the purposes of inventive step, although it would be for the purposes of novelty.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

- d) Provided the disclosure is before the priority date of the relevant claim, the time of disclosure is not relevant to novelty. It may be relevant to inventive step under the test of “..reasonably expected to be ascertained, understood and regarded as rele-

vant". For example, an oral disclosure only a few days before the priority date may be unlikely to meet this test. Similarly, a very old article in a journal which cannot be readily searched may fail this test. In each case it is a question of fact.

2.3 *Place of disclosure*

Is the place of disclosure relevant?

- e) Under the current law, actual use is only relevant if it occurs within Australia, while disclosure in a document may be anywhere. We note that any recordal, for example by a photograph or on television, will create a document as discussed.

How is the place of disclosure determined?

- f) Under the new law, place of disclosure will not be relevant. Determination of the place of disclosure is a question of fact, using the definitions of the patent area contained in statutes.

Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?

- g) Disclosure without the consent of the applicant is not relevant, and arguably accidental use in Australia could be considered without consent. The place of disclosure could be indirectly relevant to the determination of inventive step. For example, if the disclosure is published in an obscure journal which cannot readily be obtained either in Australia or via the internet, the disclosure may not meet the test of "*..reasonably expected to be ascertained, understood and regarded as relevant*".

Which is the application law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

- h) Australian courts would apply Australian law to determine whether a disclosure has occurred, regardless of where the disclosure took place.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art?

- i) In general, it does not matter whether the applicant or a third party makes a disclosure. The specific saving provisions assume that the disclosure is by or with the consent of the applicant, except the saving for disclosures without the consent of the applicant. In some cases, a separate ground of invalidity called secret use may be relevant, where the invention has been secretly commercially used by the applicant before the priority date.

Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

- j) A confidential disclosure will not normally be a publication. A confidential disclosure, however, may affect validity if it is an offer for sale of a product embodying the invention.

How are errors in the disclosed information treated?

- k) If the disclosed information contains errors, then it is a question of fact whether the disclosure contains enough information to be a sufficient disclosure to destroy the novelty of the invention. In this situation, the question is whether the gap in the disclosure created by the error is able to be filled by the skilled person in the field using the CGK or without undue experimentation.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information?

- l) A single, non-confidential disclosure is sufficient for the purposes of novelty. More widespread distribution or at least ability to be located is required to meet the test for inventive step. To amount to common general knowledge, the information must be well known to the relevant skilled workers. The prior art is considered to be read by the ordinarily skilled person in the art – the question is whether he would understand it. For inventive step see the specific requirement of Section A(h) above.

Are there general rules providing for the effect of confidentiality or implied confidentiality?

- m) A confidential disclosure is not considered to form part of the prior art – unless it amounts to an offer for sale, as discussed above.

Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?

- n) For the purposes of novelty, unless all the elements are disclosed, as the document would be read by the person skilled in the art, then there is not sufficient disclosure to affect validity. If a device could in principle be disassembled or reverse engineered, and the device is made publicly available, then this is likely to be a disclosure of any invention embodied in the device. Actual use of a device in public, to perform its stated function, may be a disclosure of an invention which is not directly presented to public scrutiny.

3. Disclosure through new Media

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step?

- a) It is clear that paperless information does constitute a disclosure which, subject to meeting statutory requirements, such as date of public availability, is sufficient to affect novelty and/or inventive step. Such paperless information has been considered when assessing novelty and inventive step, both at the Australian Patent Office level during pre-grant opposition proceedings, and at court level, and there is nothing in the decisions of these bodies that dismisses paperless information as not forming a suitable disclosure for novelty or inventive step. Such paperless information likely will meet with difficulties in respect of constituting a valid disclosure for other reasons, but not simply by virtue of its paperless form.

Are there specific requirements compared to other forms of disclosure?

- b) There are no differences in the statutory requirements given to the consideration of paperless information, compared to other traditional forms of disclosure. Paperless information does have its own peculiarities which differ in some respects to other traditional forms of disclosure, but those peculiarities principally alter the manner in which paperless information is shown to meet the statutory requirements to constitute a valid disclosure, rather than altering the requirements themselves. Accordingly, despite the emergence of paperless information in recent times, the statutory requirements for disclosure have not evolved to specifically accommodate that information in a manner different to traditional forms of information. Additionally, at present there is no push by government to do so, on the basis that the post-April 2002 situation in Australia (see Section A, paragraphs (j), (k) and (l) above) does not introduce provision for the treatment of paperless information different to traditional forms of information.

Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, email and others?

- c) The traditional principles relating to novelty and inventive step apply to paperless information regardless of the forum in which the paperless information is disclosed. Thus, the manner in which paperless disclosures emanate from various forms of networks or communications does not result in that information being treated any differently to other disclosures. There is no legislation in Australia specific to paperless information separate to that which is specific to traditional disclosures, while the

examination guidelines of the Australian Patent Office presently make no distinction between paperless information and other traditional disclosures. Accordingly, the rules applied by patent examiners and the courts, to determine whether a disclosure meets the requirements for novelty and inventive step, apply in the same way to paperless information of any kind, regardless of the form in which disclosure takes place.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted?

- a) Encrypted information is not likely to be considered as providing a higher level of confidentiality for considerations of novelty or inventive step, compared to non-encrypted information. The information, whether encrypted or not, will be treated according to established principles relating to the confidentiality of information generally, such as letters, oral disclosures and acts. That is, consideration would be given as to how the information was disclosed and in particular, as to whether the information was subject to obligations of confidence (see Section 2 of this report). Practically speaking, encrypted information is much more likely to avoid accidental disclosure during delivery to persons other than those for whom the information is intended. However, by encryption only, the intended recipients are not necessarily bound by obligations of confidence and therefore the encrypted information may nevertheless constitute a disclosure for novelty and inventive step despite its encrypted form.
- b) Email, whether encrypted or not, will be treated like other traditional forms of communication between two parties and will be considered confidential if, in the circumstances, it is reasonable to expect that the information was provided to the recipient in confidence. As a matter of practice, email transmissions generally confirm the claim to the confidential nature of the information by a confidentiality clause.

What relevance do passwords, search engines and payment requirements have?

- c) Passwords, search engines and payment requirements all will influence the position on whether particular paperless information is confidential, or is available as a disclosure for novelty and inventive step. However, like encryption, the major consideration is whether, despite restrictions on the availability of the paperless information by the above mechanisms, access to the information was still available to members of the public who were not bound to keep the information confidential. Thus, the relevance of the above mechanisms relates to how they operate to maintain a fetter on the persons or bodies who access the information, to maintain it confidential. Without actually imposing an obligation of confidentiality, the above mechanisms would have no effect on their own to confine the information as confidential.

3.3 *Place of Disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

- a) The place of disclosure in relation to information placed on the internet has been the subject of a very recent Australian decision issued by the Victorian Supreme Court (a State court). The case of *Gutnick v. Dow Jones & Co. Inc.* [2001] VSC 305, held that regardless of where material is uploaded (placed) on an internet server, it is the place at which the information is downloaded that publication is said to occur. Thus, material uploaded onto an internet site, say in the US, can still have a place of disclosure in Australia, subject to downloading being available in Australia. The case has created considerable debate as to the appropriateness of the decision and many commentators have indicated that the decision is correct in relation to a strict interpretation of the law, but it reinforces the need for legislation that is specific to internet publication, given the unique characteristics of the internet.

- b) *Gutnick v. Dow Jones* is a defamation case not a patent case and it was decided by a State court that would not normally decide patent cases, but it nevertheless provides an established precedent. There are indications that the decision will be appealed by Dow Jones.
- c) The decision of *Gutnick v. Dow Jones* in relation to the place of disclosure is largely irrelevant in respect of novelty considerations as the publication of a document anywhere in the world causes that document to be relevant prior art, subject to an appropriate date of publication. See Section A, paragraphs (e) and (j) above. Paperless information on the internet is considered to be a document for the purposes of Section 7. See Section 2.1 above. Thus, paperless information that satisfies the other necessary criteria will be prior art for novelty once it is available publicly on the internet.
- d) The place of disclosure when considering inventive step must be considered on two levels. An inventive step attack can be made on the basis of:
 - i) the CGK as it existed in the patent area (Australia) before the relevant priority date, or
 - ii) the CGK of (d)(i) together with a document or documents which have been published anywhere in the world.
- e) If a document is to be used to establish the CGK of (d)(i), then it almost certainly needs to be a document that has had wide publication in Australia (the patent area). In this case, the place of disclosure is important but as discussed under 3.3.(a), there would be publication in Australia of paperless information if that information became available on the internet.
- f) If on the other hand, a document or documents is/are to be used together with common general knowledge as under (d)(ii), so that the CGK is established without reference to the document or documents, then the place of disclosure of the document(s) is irrelevant, because the requirements for publication then become as for novelty (see paragraph 3.3(c)) above.

3.4 *Timing of Disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means?

- a) There appear to be no specific requirements regarding the timing and duration of the information being available electronically. The critical requirement is that the timing of disclosure predates the priority date and that the duration be such as to enable public access to the information. Availability for a matter of seconds is very unlikely to satisfy this requirement, as it would be unlikely that the information could be properly accessed in that timeframe. The duration may therefore have an impact on whether the information constitutes a disclosure, on a case by case basis.

Are archives necessary or desirable?

- b) Archives are necessary, to establish the form the information took at a particular date. Paperless information is easily manipulated and therefore, archives to establish the content of the information at any particular date may be the only way paperless information could be used at a later date as prior art. The absence of archives appears to be a major problem in the use of internet material at least, but quite conceivably other electronic information also. In several cases before the Australian Patent Office, internet material has been dismissed entirely because the form the material took at the relevant priority date was not established. These decisions noted the uncertain status internet material has by virtue of the ease with which it can be manipulated.

3.5 Questions of Evidence

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

- a) Establishing the prior art, whether for the purposes of determining novelty or non obviousness, invariably requires evidence to be adduced. The necessity for such proof may occur during the prosecution of a patent application in the context of pre-grant opposition proceedings, in the context of an appeal to the Federal Court from a decision of the Patent Office on a patent opposition or in post-grant revocation proceedings which, in Australia, may be commenced in either the Federal Court or in a State or Territory Supreme Court.
- b) Whether in the case of a patent application or in the context of revocation proceedings commenced in a court the function of the tribunal is to assess the facts in issue and to establish the truth of the propositions asserted. The practice and procedure by which documentary evidence is admitted differs as between the Patent Office and the courts.

Evidence before the Patent Office (IP Australia)

- c) Hearings before the Patent Office are not restricted by the formalities which may be applicable to court actions and strict evidentiary and other procedures are not applicable. For example, hearsay evidence is admissible before the Patent Office. The standard of proof before the Patent Office is the civil standard, ie. on the balance of probabilities.
- d) As to the "balance of probabilities" test see the speech of Lord Nicholls in **Re H(a minor)** [1996] AC563 at 586: *"the balance of probability standard means that a court is satisfied an event occurred if the court considers that, on the evidence, the occurrence of the event, was more likely than not. Where assessing the probabilities the court will have in mind as a fact that, to whatever extent is appropriate in the particular case, that the more serious the allegation the less likely it is that the event occurred and, hence, the stronger should be the evidence before the court concludes that the allegation is established on the balance of probability ... this does not mean that where a serious allegation is an issue the standard of proof required is higher. It means only that the inherent probability or improbability of an event is itself a matter to be taken into account when weighing the probabilities and deciding whether, on balance, the event occurred. The more improbable the event, the stronger must be the evidence that it did occur before, on the balance of probability, its occurrence will be established."*
- e) In applying the standard discussed in 3.5(d) above, the Patent Office currently gives any benefit of the doubt in relation to the validity of the patent to the applicant/patentee. Consequently, it is generally incumbent upon an opponent in opposition proceedings to establish its case.
- f) *The Patents Bill*, when it comes into force, will require a patent applicant to positively demonstrate that the application meets the threshold tests of novelty and inventive step. Although the intention of the amendment is to lift the threshold for validity of patents, this change may not have a significant impact in terms of how issues of novelty and inventive step are dealt with as a matter of evidence. At the application stage, this issue will most likely arise during pre-grant opposition. In those circumstances, it is still incumbent upon the opponent, challenging validity, to establish the prior art on the balance of probabilities - the change will simply mean that if there is any doubt in relation to a prior art disclosure, that doubt will no longer be positively decided in favour of the applicant. The doubt may still, however, be sufficiently

weighty as to lead to the consequence that the opponent has not established its case for invalidity on the balance of probabilities.

Revocation proceedings before the court

- g) Where prior art is to be established in the context of a court proceeding, the burden of proof lies with the party asserting the invalidity of the patent. The standard of proof required is, once again, the civil standard, ie. on the balance of probabilities. The standard of proof required does not change, no matter whether the prior art is in the form of a documentary disclosure, an oral disclosure or, for example, disclosure of information on the internet. It should be noted, however, that the Federal Court has the power (see Federal Court Rules 033 R3) to dispense with compliance with the rules of evidence for proving any matter which is not bona fide in dispute or where compliance with the formal rules might occasion or involve unnecessary or unreasonable expense or delay. This power is not often exercised by the court and it should be observed that it is highly unlikely that the Federal Court would relax the rules of evidence in such a way as to dispense with the necessity to prove the existence or date of publication of a prior art disclosure going substantively to the issue of whether or not a patent was valid. The trend in most common law jurisdictions, including Australia, is to ensure that, so far as possible and subject to considerations of reliability and weight, all relevant evidence is capable of being adduced.

Particular issues posed by the Internet

- h) Increasingly, data or other information relevant to whether a patent is novel and/or discloses an inventive step may be present on an electronic medium such as the internet. Disclosure of internet based information can be instantaneous, universal and transient. Such information is also theoretically capable of being manipulated.
- i) In Australia, there are no rules of evidence which specifically relate to establishing the existence and veracity of prior art disclosures on the internet. The usual rules of evidence apply and the party relying on any such disclosure has the burden of proving it. There seems to be no good reason to depart from the normal rule that "he who asserts must prove". In the Federal Court, where appeals from pre-grant oppositions are determined and where most patent revocation proceedings are heard, the standard of proof required in proving an internet disclosure is on the balance of probabilities.
- j) The *Commonwealth Evidence Act 1995* provides (see s140(2) Evidence Act 1995) that the Federal Court, in determining whether it is satisfied that the standard of proof has been met, may take into account the nature of the cause of action or defence, the nature of the subject matter of the proceeding and the gravity of the matters alleged. Bearing in mind that proof of prior art disclosure will be of critical relevance in the ultimate determination of the validity of a challenged patent, the Federal Court is not likely to lower the standard of proof required in those circumstances.
- k) The existing rules of evidence have provided a flexible approach to the proving of facts before a tribunal, whether that be a court or an administrative body charged with a responsibility of issuing patents. Although it is not suggested that the existing rules of evidence are perfect, they are generally well understood and have served users of the system well in a diverse range of circumstances. It is felt that there is no reason to introduce special rules of evidence to deal with electronic or internet based disclosures. In many respects, the issues presented by electronic disclosure are the same as those presented, for example, in relation to oral disclosures. Existing rules of evidence relating to who has the burden of proof and the standard of proof required in respect of establishing a particular fact, have been the same for oral and written disclosures. The Australian Group therefore considers that the existing rules of evidence provide a fair and reasonable balance between certainty (knowing what will be required in order to prove a particular fact) and flexibility (in terms of being able to meet different contingencies which may arise).

4. Conclusion

- 4.1 The Australian Group considers that the current standards for prior art disclosure in assessing novelty and inventive step requirements are reasonably satisfactory. The legislation which sets the standards for prior art disclosure provides a general structure for assessing whether a prior art disclosure meets the requirements, while the tribunals and courts that administer the legislation are permitted latitude in their decisions, on a case-by-case basis, where the requirements for novelty and inventive step are in dispute. This latitude enables the current standards to accommodate new media adequately, such that new standards in respect of new media are not necessary.
- 4.2 The Australian Group is reluctant to provide a definitive comment on the essential requirements for a common definition or standard of prior art disclosure without an awareness of the views of the other National Groups. However, the Australian Group considers three elements to be essential, these being:
- i) that there be a definition of the prior art,
 - ii) that the principles by which novelty is established be defined. This may include a requirement that the prior art provide clear and unmistakable directions to perform the invention,
 - iii) that the principles by which obviousness or lack of inventive step is established be defined. This may include definition that it is the underlying or basic knowledge of the person skilled in the art which provides the platform from which obviousness or inventive step is judged.
- 4.3 The Australian Group considers that a proposal for future harmonisation can only realistically be compiled when the views of each of the National Groups are known. The Australian Group therefore declines to put forward a harmonisation proposal at this stage.

Summary

The Australian Group considers that the current standards for prior art disclosure in assessing novelty and inventive step requirements in Australia, are reasonably satisfactory at present. The current standards are defined in legislation, but in a general manner that permits assessment in relation to a wide variety of different types of disclosure. The current standards have been found by the Australian Group to be such as to accommodate assessment of new forms of disclosure, in particular new media disclosure through email and the internet. This advantageous outcome occurs as a result of the general nature of the legislation, that permits the judiciary flexibility in assessing novelty and inventive step in light of different types and new forms of disclosure.

The current standards are to change as of 1 April 2002 and that will broaden the prior art base for each of novelty and inventive step. The test for novelty will change from relative to absolute, while acts which occur outside Australia which previously were unavailable for assessing inventive step, will then be available. Despite these changes, the Australian Group is of the view that this will not change the satisfactory nature of the current standards post 1 April 2001.

Résumé

Le Groupe Australien considère que les Normes courantes pour la divulgation de l'art antérieur en ce qui concerne les critères retenus pour l'appréciation des conditions de nouveauté et d'activité inventive sont assez satisfaisantes pour l'instant. Les Normes actuelles sont définies par la législation mais de manière générale ce qui permet de relier l'évaluation à une large variété de différents types de divulgation. Le Groupe Australien trouvait que les Normes fonctionnaient bien puisqu'elles permettaient de s'adapter aux nouvelles formes de divulgation en particulier dans les nou-

veaux moyens de communication comme les nouvelles technologies à savoir les méls et l'Internet. Cette conséquence avantageuse découle de la nature générale de la législation qui permet plus de flexibilité sur le plan légal dans l'appréciation des exigences de nouveauté et d'activité inventive à la lumière des différents types et des nouvelles formes de divulgation.

Les Normes actuelles vont changer à partir du 1er Avril 2002 et elles élargiront les précédentes notions de base de l'art antérieur pour l'appréciation de chacune des conditions de nouveauté et d'activité inventive. Le test de nouveauté changera de relatif à absolu tandis que les événements qui se passent à l'étranger pour l'évaluation de l'activité inventive deviendront désormais valides sur place. En dépit de ces changements le Groupe Australien maintient ses vues que cela ne changera aucunement la nature satisfaisante des Normes actuelles une fois passé le 1er avril 2001.

Zusammenfassung

Die Australische Gruppe findet, dass die gegenwärtigen Standards für Offenbarungen im Stand der Technik bei der Beurteilung der Voraussetzungen der Neuheit und der Erfindungshöhe momentan einigermaßen zufriedenstellend sind. Die gegenwärtigen Standards sind in der Gesetzgebung definiert, aber in einer allgemeinen Form, die Beurteilung in Bezug auf eine grosse Bandbreite verschiedener Arten von Offenbarungen zulässt. Die gegenwärtigen Standards wurden von der Australischen Gruppe als so befunden, dass sie die Beurteilung neuer Formen von Offenbarungen, speziell neuer Medien Offenbarungen durch E-Mail und Internet umfassen. Dieses vorteilhafte Ergebnis erscheint als eine Folge des allgemeinen Wesens dieser Gesetzgebung .

Die gegenwärtigen Standards werden vom 1 April 2002 geändert und das wird die Stand der Technik Basis von beidem, Neuheit und Erfindungshöhe, erweitern. Die Prüfung von Neuheit wird von relativ zu absolut wechseln, während Umstände die ausserhalb Australiens vorkommen und früher nicht zur Bewertung von Erfindungshöhe zur Verfügung standen, dann zur Verfügung stehen werden. Trotz dieser Aenderungen ist die Australische Gruppe der Ansicht dass das zufriedenstellende Wesen der gegenwärtigen Standards sich nach dem 1 April 2001 nicht verändern wird.

Rapport Q167

Rapport au nom du Groupe belge
par Pierre CLAEYS, Georges J. LEHERTE et Bernard VAN REEPINGHEN (rapporteur)

Les critères actuels de la divulgation de l'art antérieur pour l'appréciation des conditions de nouveauté et d'activité inventive

1. Détermination de l'art antérieur

1.1 *Quel est l'effet de la divulgation d'un art antérieur sur la nouveauté et l'activité inventive? Existe-t-il des différences entre l'art antérieur concernant la nouveauté d'une part, et l'activité inventive, d'autre part? Les demandes en cours, qui n'ont pas encore été publiées, affectent-elles l'évaluation de la nouveauté et de l'activité inventive?*

Il existe bien des différences entre l'art antérieur concernant la nouveauté d'une part et l'activité inventive d'autre part. S'agissant de la première, l'antériorité doit être compacte, et l'état de la technique comprend également le contenu des demandes en cours non encore publiées (art.5, § 3 de la loi). Pour l'évaluation de la seconde, la loi belge a retenu le critère de ce qui, pour l'homme du métier, ne relève pas de manière évidente de l'état de la technique, et l'état de la technique ne comprend pas les demandes en cours selon l'article 5 §3 de la loi. (art. 5 et 6 de la loi).

Quant aux demandes en cours, n'ayant pas encore été publiées, la loi belge en donne une liste limitative, à savoir les demandes,

- d'un brevet belge,
- d'un brevet européen désignant la Belgique,
- d'un brevet PCT, désignant la Belgique.

1.2 *Les lois nationales donnent-elles des définitions ou indications sur ce qui constitue une divulgation de l'art antérieur?*

La loi belge ne donne pas de définition ou d'indication sur ce qui constitue une divulgation de l'art antérieur. Le critère appliqué est celui de l'accessibilité (art. 5, § 2).

1.3 *Quelles sont les directives utilisées pour déterminer si un élément d'art antérieur a été divulgué? Cette question vise les directives autres que celles énoncées par la loi qui ont été établies dans les différents pays pour déterminer une divulgation.*

Il n'y a pas, dans la loi belge, de directives autres que les principes rappelés ci-avant.

2. Critères pour la divulgation

2.1 *Moyens de divulgation*

Quels sont les moyens reconnus de divulgation? Existe-t-il des exigences supplémentaires pour certains types de divulgations, tels que la divulgation orale ou la divulgation par l'usage, par rapport à la divulgation par le biais de documents écrits? Si certains moyens de divulgation ne sont pas reconnus par la loi ou par la pratique, quelles en sont les raisons?

Il n'y a pas de moyens de divulgation qui soient exclus dans la loi belge.

2.2 *Date de divulgation*

Est-il important qu'une divulgation ait été faite récemment ou depuis longtemps déjà? Existe-t-il des limites au-delà desquelles la publication d'une information, bien qu'elle cons-

titue une divulgation de l'art antérieur, n'est plus pertinente pour l'évaluation de la nouveauté et de l'activité inventive?

Elle est sans influence par rapport à l'appréciation de la nouveauté. *En revanche, elle peut avoir une influence dans l'évaluation de l'activité inventive.*

2.3 *Lieu de la divulgation*

Le lieu de la divulgation est-il pertinent? Comment déterminer le lieu de divulgation? Importe-t-il que la divulgation ait eu lieu dans ce pays par accident ou qu'elle ait eu lieu de façon intentionnelle? Quelle est la législation applicable pour déterminer si une divulgation a eu lieu (la législation du pays dans lequel l'information a été divulguée, ou la législation du pays dans lequel la nouveauté et l'activité inventive sont évaluées)?

Celui-ci est sans importance.

2.4 *Éléments personnel*

Quelles sont les différences observées par les Groupes à l'égard de la personne qui divulgue l'art antérieur? La divulgation est-elle traitée différemment si l'auteur de la divulgation était lié par un accord de confidentialité? Comment sont traitées les erreurs dans les informations divulguées?

Il n'y a pas de différence selon que la divulgation provient du demandeur ou d'une tierce personne, sous réserve d'une divulgation abusive selon l'article 5 § 5.a et du délai de grâce prévu par l'article 5, § 5.b. Le délai de grâce sort d'ailleurs du cadre du présent rapport.

2.5 *Bénéficiaire de l'information*

Quelles sont les exigences à l'égard de l'aptitude à comprendre les informations? Est-ce que la possibilité qu'une personne puisse obtenir les informations par des étapes supplémentaires, telles que le démontage de modes de réalisation ou une procédure de construction à l'envers (reverse engineering), suffisent à constituer une divulgation? Existe-t-il des règles générales couvrant l'effet de confidentialité ou la confidentialité implicite?

Il n'y a pas d'exigence particulière en ce qui concerne la nouveauté puisque le critère est l'accessibilité au public.

Quant aux obligations de confidentialité, elles ressortissent au droit commun.

3. **Divulgation par les nouveaux médias**

3.1 *Règles générales*

Des informations sans support papier, par exemple dans un réseau électronique ou à travers Internet, constituent-elles une divulgation suffisante susceptible d'affecter la nouveauté ou l'activité inventive? Existe-t-il des exigences spécifiques par rapport à d'autres formes de divulgation? Existe-t-il des différences à l'égard de différentes formes de réseaux ou de communications telles que la « toile » mondiale, les groupes de discussion ou les forums, le courrier électronique et autres?

Il n'existe pas d'exigence spécifique à propos du support de l'information divulguée. Le critère est, on l'a déjà vu, celui de l'accessibilité au public.

Cette condition ne sera pas réunie si la divulgation résulte, par exemple, d'un échange d'informations confidentiel, par une clé d'accès, un mot de passe ou une carte magnétique, etc.

3.2 *Problèmes de confidentialité*

Cela fait-il une différence si les informations sont cryptées? Quelle pertinence ont les exigences relatives aux mots de passe, aux moteurs de recherche et aux paiements sécurisés?

Les exigences relatives aux mots de passe, aux moteurs de recherche et aux paiements sécurisés, n'ont pas de pertinence particulière sauf s'ils ont une conséquence éventuelle sur l'accessibilité au public.

3.3 *Lieu de la divulgation*

Quel est le lieu de la divulgation si les informations sont mises sur Internet? Le simple fait qu'un site web puisse être accessible en un certain endroit suffit-il pour une divulgation dans cet endroit ou doit-il y avoir des conditions ou exigences supplémentaires?

Celui-ci est sans pertinence selon la loi belge.

3.4 *Date de la divulgation*

Existe-t-il certaines exigences quant à la date et la durée des informations disponibles par les moyens électroniques? Des archives sont-elles nécessaires ou souhaitables?

La date doit évidemment pouvoir être déterminée. La durée de la disponibilité des informations, par exemple par des moyens électroniques, est sans influence.

3.5 *Problèmes de preuve*

Qui doit avoir la charge de la preuve qu'une information spécifique a été divulguée sur Internet? Est-ce qu'Internet nécessite des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens, Doit-il exister différents niveaux de preuve pour différents modes de divulgation? La manipulation potentielle d'informations divulguées par les nouveaux médias exige-t-elle des normes différentes pour la reconnaissance de cette divulgation, et y a-t-il des règles spécifiques pour ce type de divulgation?

Quelle que soit la nature de l'information divulguée, la charge de la preuve de la divulgation ressortit au droit commun. Celui qui entend se prévaloir de la divulgation, doit donc démontrer que celle-ci répond au critère d'accessibilité au public.

Conclusion

Le Groupe belge estime que les critères de la loi nationale - qui sont d'ailleurs conformes à ceux de la convention sur la délivrance d'un brevet européen - sont à la fois clairs et satisfaisants et n'appellent donc pas d'aménagements particuliers.

Report Q167

in the name of the Brazilian Group
by José Antonio B.L. FARIA CORREA, President, Esther M. FLESCHE, General Reporter,
Lélio D. SCHMIDT, Assistant Reporter, Rana GOSAIN, Chairperson, Patent Committee,
Antonio Mauricio Pedras ARNAUD, Vice Chairperson, Patent Committee

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

As the title of the question indicates, the question deals with prior art disclosure. Its goal is not to deal with specific questions arising from disclosure in the context of the scope of protection or the formalities of patent applications. In order to determine criteria for prior art disclosure it should be stated at first, what the main principles are with regard to the relationship between disclosure, novelty and inventive step and how this is reflected in the various national laws.

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

The effect of a prior art disclosure regarding novelty and inventive step can be adverse on the patentability of a Brazilian application.

There are differences between prior art regarding novelty and inventive step. As a general rule, in order to prove lack of novelty it is necessary that all the elements of the claimed invention be disclosed in a single document of the prior art. As to inventive step, it is possible to submit several pieces of prior art to prove non-obviousness.

For the purpose of determining novelty only - i.e., not of an inventive step, Brazilian Law states that the whole contents of an application filed in Brazil but yet unpublished shall be regarded as comprised within the state of the art either from the filing date or from the priority date, provided that it is published, even if subsequently.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Article 11 of the Brazilian Industrial Property Law defines what is considered comprised by the state of the art. The state of the art encompasses everything made accessible to the public prior to the filing date of a patent application, by written or oral description, by use or any other way, in Brazil or abroad.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.*

The Brazilian Patent Office still has not issued guidelines for examination, and the regulations do not specifically address this issue. Nevertheless, in order to determine whether a certain document is part of the prior art it is necessary to provide evidence that its content was made accessible to the public in general before the date of filing or of the priority if any.

Available administrative decisions reveal that documents with restricted circulation – e.g., inside a factory or even between two companies – are not considered as being accessible to the public.

2. Criteria for disclosure

The determination of a disclosure has to consider various criteria. These criteria comprise the means of information (written, oral or otherwise), the time of information (recently or a long time ago), the place of information (domestic or abroad), the person who discloses the information (the applicant of an IPR or a third person) and the recipient of the information.

2.1 Means of disclosure

It should be stated in the Group Reports which form of disclosure has an impact on novelty and inventive step. In particular it will be interesting to hear if disclosure is limited to certain means of information or rather unlimited. This includes oral disclosure as well as new ways of information, such as the Internet, which will also be covered in the next question.

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

Recognized means of disclosure can comprise written or oral description, use or any other means, in Brazil or abroad.

However, the Brazilian Patent Office traditionally only accepts documentary evidences. Such behaviour bars the assessment of novelty/inventive step based in oral disclosures. As far as judicial procedures are concerned, a testimonial evidence about previous oral disclosures is only admissible in hearings and under oath. Nevertheless, a testimonial evidence alone will likely not be accepted unless they are supplemented by documentary evidences which provide concrete proof of date of its occurrence and its content.

Undated pamphlets and blue print, per se, are unacceptable since there is no clear evidence that the contents have been made available to the public, before the filing or the priority dates.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

No matters if the disclosure was recent or old (the grace period is not being considered in this answer, concerning the introduction guidelines given about Q167). What is relevant is that the disclosure should have taken place prior to the filing date of the application or to the earliest priority.

With specific regard to documents that will evidence lack of inventive step, although there are no fixed guidelines in this respect, if the prior art was published a long time ago, this constitutes a primary evidence that the invention does not derive in an obvious manner from such document. However, such aspect must be analyzed in a case by case basis.

2.3 Place of disclosure

In some countries only a disclosure of a piece of information in that specific country may affect novelty whereas a disclosure abroad will not be taken into consideration. As an example, one can mention the publication of printed materials which are published in one country and of which only a few copies will cross the border to another country by accident or unintentionally.

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred

(the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

No, the place of disclosure is irrelevant as Article 11 of Brazilian law states that the state of the art is everything made available to the public in Brazil or abroad. Therefore it is also irrelevant to determine the place of the disclosure, unless this is necessary to prove that the document was indeed made accessible to the public.

With respect to accidental or intentional disclosures, law makes no difference. The applicable law is the law of the country in which novelty and inventive step are assessed.

2.4 *Personal elements*

It may make a difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

Brazilian law provides a grace period of 12 months for the disclosure, which shall not be regarded as part of the state of the art, when made (i) by the inventor, (ii) by the PTO, regarding an application filed without the inventor's consent and based on information obtained from him or as a result of his acts; or (iii) by third parties, on the basis of information received directly or indirectly from the inventor or as the result of his acts.

The person bound by a confidential agreement will be liable for having disrespected the contract. Nevertheless, the effect of the disclosure depends on the time span between the unauthorized disclosure and the filing date of the respective patent application: (a) if it is comprised by the 12-month grace period, the novelty and inventive step of the invention shall not be affected; (b) if the disclosure happened more than 12 months before the filing date, it will destroy novelty.

If the disclosed information has errors, the effects of such disclosure will depend on the materiality of the error. If the error jeopardizes the appropriate identification of the subject matter, then it may not be considered as prior art disclosure and it will not affect the novelty of the claimed invention.

2.5 *Recipient of the information*

In general, the concept of disclosure requires that information be disclosed to the public. There may be differences with regard to the definition of the public. This concerns, among others, confidentiality obligations or the ability to understand the information.

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

In general, there are no requirements concerning ability or difficulty to understand the information. Nevertheless, the assessment of an inventive step is made considering what a skilled person would obviously infer from the state of the art.

Neither the Brazilian legislation nor the regulations establish the degree of effort needed to consider that a certain information is available to the public. However, since "public" must be broadly understood, it encompasses any person. Thus, if additional steps requiring a certain degree of expertise – such as that involved in a reverse engineering - are necessary to access the information, then this information will probably not be considered "accessible to the public". If the additional step, such as disassembling a product, does not require particular skills, then e.g. an internal component of a device available in the commerce can be regarded as being accessible to the public.

As to the effect of confidentiality or implied confidentiality, as inferred from decisions issued by the Brazilian Patent Office, an information passed to a certain recipient will possibly not be admitted as comprised by the prior art – i.e. as being accessible to the public - if it is made under a condition of express or implied confidentiality.

3. Disclosure through new media

Modern technologies and in particular the introduction of the Internet have made access to information world-wide much easier in a much shorter time. At the same time, the life of the information seems to be getting shorter. Information is visible and maybe also reproducible for a short time. This also leads to the danger of manipulating the disclosed information which can be done either by the author or by third parties. With regard to new media this danger seems significantly higher than in other forms of disclosure, such as written documents. The world-wide web raises questions as to the place of disclosure. Merely the fact that information can be accessed all over the world may not lead to a disclosure in the legal sense in every country. Problems arise which are similar to those in connection with oral disclosure, such as questions of evidence, accessibility and duration of the information.

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the Internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

In principle, a paperless information, e.g. in an electronic network or through the Internet, constitutes a sufficient disclosure to affect novelty or inventive step. The law does not specifically address Internet disclosures but as in the case of any paperless disclosures, the true difficulty lies in obtaining documentary proof of the disclosure. In the event the communications are regarded to be public then they would constitute prior art. Likewise e-mails messages sent to an unlimited number of persons constitute prior art. One possible manner of establishing the date and content of a certain disclosure by electronic means relies in accessing the information (e.g. website) in the presence of a notary public, printing a hard copy and obtaining a declaration from the notary public to the effect that the content of the printed copy was accessible to the public at the date in which he has accessed it.

3.2 Questions of confidentiality

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

Yes, if the information is encrypted, in principle it would not be accessible to the public. If accessibility to information depends on password protection, and if there are restrictions to obtain the password, then, in principle, the information is not accessible to the “public”, but merely to a limited group of persons.

If access through payment is provided to the public, then in principle the information has been made accessible to the public, presuming that the cost is not so high as to create a true obstacle to the access.

3.3 Place of disclosure

As explained earlier, in some cases the place of disclosure may be relevant for the assessment of novelty or the inventive step.

What is the place of disclosure if information is put on the Internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

Since Brazil's novelty requirements are absolute, with the exception of the grace period provisions, the place of disclosure will not be relevant for the assessment of novelty or inventive step.

3.4 Timing of disclosure

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

If information is available during a certain period of time to enable the public to produce evidence, this information (disclosure) shall be treated as being part of the state of the art.

3.5 Questions of evidence

The fact that information on the Internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or manipulation. Such problems may arise during the prosecution of a patent application as well as in infringement cases.

Who should have the burden of proof that a specific piece of information was disclosed on the Internet? Does the Internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

Interested third parties challenging novelty/inventive step should have the burden of proof that a specific piece of information was disclosed in the Internet. There are no specific legal rules related to prior art disclosure in the Internet, and such particular rules are unnecessary. The level of evidence should be the same, irrespective as to the source of the disclosure, i.e., in any case there should be clear evidence as to content and date of the disclosure. As in all cases of documentary evidence, the veracity of the disclosure will have to be attested.

4. Conclusion

The Groups are invited

- | - *on all of the foregoing questions, to express their opinion as to the current situation, including their experience from practice with the national and regional patent authorities (such as the EPO) and courts*
- | - *to suggest the essential requirements for a common definition or standard of prior art disclosure and*
- | - *to put forward any proposal for future harmonisation of such definitions and standards.*

The Groups are also invited to comment on any additional aspect which they find relevant with regard to the question and specific aspects of disclosure.

The Brazilian group does not agree with PLT terms at all. However, with respect to a future and partial harmonization, the Brazilian group accepts the definition of prior art in Article 8 of the current draft of the SPLT (document SCP/6/2 of September 24, 2001) as to the fact that “the prior art with respect to the subject matter of a particular claim shall consist of all information which has been made available to the public anywhere in the world in any form before the claim date”.

The Brazilian group also agrees with SPLT’s rules on lack of novelty, in which items of prior art (i) may only be taken into account individually and may not be combined, and (ii) must enable a person skilled in the art to make and use the claimed invention. The group does not foresee the need of special rules with respect to non-conventional forms of disclosure.

Report Q167

In the name of the Bulgarian Group

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

- 1.1 According to the Bulgarian Patent Law determination of the novelty and the inventive step depends exclusively from the state of the art. The invention or utility model is new if it is not a part of the state of the art. The invention incorporates an inventive step when it is not the obvious result from the state of the art. There are not differences between prior art regarding novelty on one hand and inventive step on the other hand, with exception of the pending non-published applications. According to the Patent Law the pending applications which have not yet been published, but which will be subsequently published, affect the assessment on novelty only. The earlier secret applications and patents are excluded from the state of the art, because they will be not published. They may be considered as prior art disclosure in relation to later secret applications only with the consent of the Ministry of defence and the Ministry of internal affairs?
- 1.2 The Bulgarian Patent Law gives indications as to what is covered by the state of the art.
- 1.3 A Regulation for drawing up, filing and examination of patent applications is in force in Bulgaria, where criteria for disclosure the state of the art are given.

2. Criteria for disclosure

- 2.1 According to the Law the state of the art covers all that become generally accessible through written statement or oral description, usage or disclosure in any other manner. The Regulation for Drawing up, Filing and Examination of Patent Applications gives indications what constitute written disclosure, oral disclosure and disclosure by use. There are additional requirements in the above Regulation the oral disclosure to be supported by written document or other means which allows repeated reproduction. When this is a written document, the oral disclosure or exhibiting is included in the state of the art even if this document is published after the date of filing or the priority date.
- 2.2 The Law and the corresponding Regulation do not provide limitations of the time limit for prior art disclosure. It does not matter if a disclosure has been made recently or a long time ago. There are limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step.
- 2.3 According to the Bulgarian Patent Law the state of the art covers all that has become generally accessible in any point of the world. It does not make a difference if the disclosure has happened accidentally or intentionally. The Law does not determine the applicable law for judging whether a disclosure has occurred. There is not any practice on this matter in the Patent Office or in the Court.
- 2.4 The Bulgarian Patent Law provides special requirements for the disclosure with no effect on patentability. One-year grace period is provided when the disclosure is made by the inventor himself, or by a third person who has got the information from the inventor, or by the

Patent Office if the information is contained in an application filed by a third person who has got this information from the inventor, or if the information is contained in another application of the inventor, which should not have been disclosed by the Office. The Law does not provide special provisions for protecting exhibitions.

- 2.5 The Bulgarian Patent Law does not provide a definition of the public. There are no requirements with regard to the ability of the public to understand the information. The possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering is sufficient to constitute a disclosure. There are not general rules providing for the effect of confidentiality or implied confidentiality.

3. Disclosure through new media

As it has been mentioned above the Bulgarian Patent Law defines the state of the art to be disclosed in any manner. Consequently a paperless information, e.g. in an electronic network or through the internet, constitutes a sufficient disclosure to affect novelty or inventive step if the date of the disclosure is available. The Law and the Regulation thereof do not provide any specific requirements for the disclosure through new media.

Unfortunately the Bulgarian Patent Law and the City Court of Sofia have not any practice in determining the prior art disclosure through new media. That is why the Bulgarian National Group cannot submit a relevant information about the impact of the new media on the prior art disclosure.

4. Conclusion

The Bulgarian National AIPPI group welcomes the introduction of common definition or harmonization of definitions or standards of prior art disclosure. The Bulgarian National Group is of the opinion that no limitation of the means of disclosure must be specified. The disclosure of the state of the art must cover all that became generally accessible through written statement or oral description, usage or disclosure in any other manner. Specific requirements for different means of disclosure, including through new media, must be underlain. The question of dating of the disclosure must be specified for any means of disclosure. The Group is of the opinion that a special attention must be paid for the storage of the information through new media.

Report Q167

in the name of the Canadian Group
by Warren SPRIGINGS, Chairman*

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

a) *What is the effect of a prior art disclosure on novelty and inventive steps?*

A patent will not be granted (or a patent will be declared to be invalid) where a prior art disclosure, at the relevant time, has:

- (i) made the subject-matter of the claims available to the public in Canada or elsewhere (i.e. lack of novelty - s. 28.2 of the Canadian Patent Act).
- (ii) made the subject matter defined by a claim obvious (on the claim date) to a person skilled in the art or science to which it pertains (i.e. obviousness - s. 28.3 of the Canadian Patent Act).

b) *Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?*

Aside from timing issues, discussed below, a prior art disclosure that is citeable in respect of novelty is also be citeable in respect of obviousness.

However, prior art that is citeable in respect of novelty must disclose the subject-matter defined by a claim (s. 28.2). The Supreme Court of Canada has recently accepted the test for novelty as enunciated by Hugessen J.A. in *Beloit Canada Ltd. v. Valmet OY* (1986), 8 C.P.R. (3d) 289 (F.C.A.) at p. 297 as follows:

“One must, in effect, be able to look at a prior, single publication and find in it all the information which, for practical purposes, is needed to produce the claimed invention without the exercise of any inventive skill. The prior publication must contain so clear a direction that a skilled person reading and following it would in every case and without possibility of error be led to the claimed invention.” *Free World Trust v. Électro Santé Inc.*, [2000] S.C.J. No. 67 at par. 26.

Prior art that is citeable in respect of obviousness can be combined and, as such, does not have to contain all the information necessary to produce the claimed invention. The test for obviousness has been accepted as follows:

“The question to be answered is whether at the date of invention...an unimaginative skilled technician, in light of his general knowledge and the litera-

* Prepared with the assistance of Lisa Trabucco; Roger Bauman, George Murti (all of Hitchman & Sprigings) and Richard Naiberg and Julie Perrin (Goodmans).

ture and information on the subject available to him on that date, would have been led directly and without difficulty to [the] invention." *Beecham Canada Ltd. et al. v. Procter & Gamble Co.* 61 C.P.R. (2d) 1 at 27 (F.C.A.))

- c) *Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

Pending applications that have not yet been published affect the assessment of novelty in the following circumstances:

- (i) the subject matter defined by a claim has been disclosed in an application for a patent filed in Canada, by a person other than the applicant, prior to the priority date of the claim (s.28.2(c) of the Canadian Patent Act).
- (ii) The subject matter defined by a claim has been disclosed in a co-pending application that is filed in Canada, by a person other than the applicant, on or after the priority date of the claim. However, the priority date of the co-pending application must be earlier than the claim date of the claim (s.28.2(d) of the Canadian Patent Act).

Pending applications that have not yet been published do not affect the assessment of inventive step.

- 1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

No, there is no specific definition of what would constitute a prior art disclosure in the Canadian Patent Act. However, the Canadian Patent Act requires that to constitute a prior art disclosure, the prior art must be disclosed in such a manner that it became available to the public in Canada or elsewhere.

- 1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.*

The prior art itself must be "available to the public" before it will be considered to have been disclosed:

- (i) to qualify as "available to the public" a publication must (1) have become generally available without restriction, to members of the public and (2) the person or persons receiving the document, to be categorized as members of the public must have no special relationship with the author; the onus is on he who asserts it to establish the fact of publication. (*Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24 at 85 (F.C.T.D.))
- (ii) to qualify as "available to the public", a prior public use or sale of a product incorporating the invention must have been (1) made available without restriction to at least one member of the public (*Gibney et al. v. Ford Motor Co. of Canada Ltd.* (1967), 52 C.P.R. 140 (Ex. Ct.); and (2) the subject matter of the invention must have been capable of being derived (e.g. by observation or reverse engineering) from the product. (*Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd.* August 15, 2001) It is not necessary to show that the product was in fact dissected or reverse engineered (*Risi Stone Ltd. v. Groupe Permacon Inc.* (1995), 65 C.P.R. (3d) 2 at 22 (F.C.T.D.))

In assessing the relevance of prior art that is "available to the public", the courts have applied a "discoverability test". The prior art must be discoverable by a person skilled in the art conducting a "diligent search":

"It is clear that the knowledge this fictitious person is considered to possess consists of the general knowledge that the ordinary skilled workman would have had at the relevant time, as well as any information available to him or her at the time in publications, including patents, in other words prior art. Moreover, an objective test should be applied to determine whether the hypo-

thetical skilled workman could be reasonably assumed to have knowledge of such prior art.” *Procter & Gamble Co. v. Kimberly-Clark of Canada Ltd.* (1991), 40 C.P.R. (3d) 1 at 46 (F.C.T.D.)

2. Criteria for disclosure

2.1 Means of disclosure

a) *What are recognized means of disclosure?*

Recognized means of disclosure include: printed publications; oral publications; or public use (*Diversified Product Corp. v. Tye-Sil Corp.* (1991), 35 C.P.R. (3d) 350 (F.C.A.)) As discussed, in respect of Q. 1.1, the substance of the information disclosed is more significant to the courts than the means of disclosure.

b) *Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?*

The additional requirement for disclosure by use is that the subject matter of the claims must be identifiable from the use either by observation or analysis (i.e. reverse engineering). (*Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd.* August 15, 2001; *Risi Stone Ltd. v. Groupe Permacon Inc.* (1995), 65 C.P.R. (3d) 2 at 22 (F.C.T.D.))

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

The Canadian Patent Act contains the following time limits regarding the relevance of a prior art disclosure:

a) for purposes of novelty, prior art is only relevant where:

- (i) it was disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;
- (ii) it was disclosed before the claim date by a person not mentioned in paragraph (i) in such a manner that the subject-matter became available to the public in Canada or elsewhere;
- (iii) it was disclosed in an application for a patent filed in Canada by a person other than the applicant, and has a filing date that is before the claim date; or
- (iv) in an application (the “co-pending application”) for a patent that is filed in Canada by a person other than the applicant and has a filing date that is on or after the claim date.

b) for purposes of obviousness, prior art is only relevant where:

- (i) the information was disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (ii) the information was disclosed before the claim date by a person not mentioned in paragraph (i) in such a manner that the information became available to the public in Canada or elsewhere.

Except for these provisions, it does not matter if a disclosure has been made recently or a long time ago. However, the courts have given less evidentiary weight to old prior art that was never put into practice. (*Creations 2000 Inc. v. Canper Indus-*

2.3 *Place of disclosure*

a) *Is the place of disclosure relevant?*

For purposes of novelty and inventive step, under the Canadian Patent Act, a prior art disclosure is relevant regardless of the place it is disclosed. This is subject to exceptions regarding novelty in the context of previously filed applications in Canada (see Question 1.1).

b) *How is the place of disclosure determined?*

There are no guidelines for determining the place of disclosure. In any event, the place of disclosure should be determined as being the location of the persons viewing or receiving the prior art disclosure. Accordingly, there may be more than one location possible for a prior art disclosure (eg. radio broadcast, internet).

c) *Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?*

It does not make a difference if a disclosure has occurred accidentally as opposed to intentionally. A disclosure is a disclosure. If it were otherwise, it would make it impossible for a third party to determine the validity of a patent based on a prior art disclosure. The third party would never know if a disclosure had been accidental or intentional.

d) *Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?*

The applicable law for determining whether a disclosure has occurred is the law in which novelty and inventive step are assessed (i.e. Canada).

2.4 *Personal elements*

a) *What differences do the Groups observe with regard to the person who discloses the prior art?*

As set out in Question 1.1, the Canadian Patent Act provides for different grace periods in respect of novelty depending on whether the applicant (or a person who obtained knowledge, directly or indirectly from the applicant) or a third party discloses the subject matter of the claim.

b) *Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?*

The disclosure is not treated differently if the disclosing person was bound by a confidentiality agreement. A disclosure is a disclosure. The patentee's recourse is to seek damages from the individual who breached the confidentiality agreement. (Fox on Patents, 4th ed. Page 146).

c) *How are errors in the disclosed information treated?*

Errors in the disclosed information are not relevant. An error in the disclosed information is part of the prior art disclosure whether or not it is recognized by a person skilled in the art as being an error.

It is the information conveyed to a person skilled in the art by the prior art disclosure that is important and his understanding of the information.

2.5 *Recipient of the information*

a) *What requirements are there with regard to the ability to understand the information?*

The test applied for novelty and inventive step set out in Question 1.1 set out the requirements for the ability of an ordinary skilled worker in the art to understand the information.

- b) *Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?*

Disassembly of embodiments or reverse engineering would be sufficient to constitute a prior art disclosure (*Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd.* August 15, 2001) It is not necessary to show that the product was in fact dissected or reverse engineered (*Risi Stone Ltd. v. Groupe Permacon Inc.* (1995), 65 C.P.R. (3d) 2 at 22 (F.C.T.D.))

- c) *Are there general rules providing for the effect of confidentiality or implied confidentiality?*

A disclosure that is made subject to restrictions of confidentiality or implied confidentiality will not be citeable as a prior art disclosure. In defining a “publication” the courts have held that “there must be a general availability without restriction or putting it another way, there must be no inhibiting fetter so to make the concept of the invention unavailable to the public...”. (*Owens-Illinois Inc. et al. v. Koehring Waterous Ltd. et al.* (1978), 40 C.P.R. (2d) 72; affirmed 52 C.P.R. (2d) 1 (F.C.A.))

3. Disclosure through new media

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step?

There is no limitation on the nature of the prior art disclosure that could be relied on to affect novelty or inventive step. The mere fact that information has been disclosed in a communication on an electronic network does make the disclosure “available to the public”. The Courts have recognized oral disclosures as being sufficient for purposes of novelty or inventive step.

Are there specific requirements compared to other forms of disclosure?

The law has not identified any specific requirements that must be met before a prior art disclosure involving paperless information could be relied on for purposes of novelty or inventive step.

Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

The law has not identified any differences with regard to various forms of networks or other communications.

3.2 Questions of confidentiality

- a) *Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?*

In order for information to constitute a prior art disclosure, it must not have been disclosed (1) subject to restrictions; and (2) person or persons having a special relationship to the author of the publication.

As a result, information that has been encrypted would constitute a prior art disclosure where (1) it was disclosed to one or more individuals, if at least one individual is able to decrypt the information; (2) there are no restrictions associated with the dissemination of the information; and (3) the individuals do not have a special relationship with the author.

Furthermore, in order to constitute a prior art disclosure, the information must have been discoverable by means of a diligent search by a person skilled in the art. In other words, it must be demonstrated that the information would have been discovered by a person skilled in the art using the appropriate search engine or otherwise (e.g. knowledge of a particular website).

3.3 Place of disclosure

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

There are no requirements in Canada regarding the place of disclosure of a prior art disclosure for purposes of novelty or obviousness. In any event, information should be considered to have been disclosed in the place from which it can be accessed and not where the computer hosting the website is located.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

Aside from the timing requirements set out in 2.2 above, there are no requirements for the timing of information available through electronic means. However, with respect to duration, it would be advisable to require that the information was available through electronic means (e.g. on the internet) for a sufficient period of time to have permitted it to be: (1) located by a diligent search by a person skilled in the art; (2) reviewed; and (3) reproduced.

It would be advisable that there be some form of archiving procedure implemented to establish the date information was available on the internet or other electronic means. Whether or not this is practical is another matter.

3.5 *Questions of evidence*

a) *Who should have the burden of proof that a specific piece of information was disclosed on the internet?*

The internet should not have any different rules or requirements regarding the burden of proof for establishing oral disclosure or other types of disclosure for that matter. In Canada, the burden is on the party relying on the prior art disclosure.

It will be useful to recall that when, as here, prior knowledge or use is alleged, "evidence of this character should be subjected to the closest scrutiny" and "anyone claiming anticipation on that basis assumes a weighty burden": *Tye-Sil Corp. Ltd. V. Diversified Products Corp. et al.* (1991), 35 C.P.R. (3d) 350 at 363 (F.C.A.)

It would be an impossible burden for a patentee to prove the negative, namely that there was no such prior art disclosure.

b) *Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways?*

The courts have imposed a heavy burden on the party relying on prior knowledge or use. In a case, where the patentee was alleged to have disclosed the invention in a conversation to an individual, the court has found it preferable that disinterested witnesses testify before accepting that such a disclosure had been made (*Risi Stone Ltd. v. Groupe Permacon Inc.* (1995), 65 C.P.R. (3d) 2 at 22 (F.C.T.D.))

Disclosure on the internet does not require different rules than for other means of disclosure. It will simply be more difficult for the party relying on a prior art disclosure on the internet to establish the date of the publication and the nature of the publication than in other cases. For example, in the case of an oral disclosure, although the content of the disclosure is no more fixed than the disclosure on the internet, it is likely that the disclosure will be capable of being corroborated by more than one individual and that the date of disclosure is more readily corroborated.

c) *Should there be different levels of evidence for different ways of disclosure?*

There should not be different levels of evidence for the different ways of disclosure. Since the impact of the different ways of disclosure in terms of obviousness or novelty are the same, the different ways of disclosure should be established to same level of certainty or to the same burden of proof.

- d) *Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?*

No. Oral prior art disclosure is less tangible than a prior art disclosure through new media. The standard applied in establishing a prior art disclosure should be the same regardless of the kind of disclosure.

4. Conclusion/Summary

A prior art disclosure should include any disclosure that is available to the public anywhere in the world. Aside from timing issues, a prior art disclosure that is citeable in respect of novelty should also be citeable in respect of inventive step. Pending applications that have not yet been published should not have any effect on obviousness but should be citeable regarding novelty in first to file systems.

To qualify as a prior art disclosure the disclosure must be “available to the public”. In other words, it must (1) have become generally available without restriction to the members of the public; and (2) the person or persons receiving the document must have no special relationship to the author.

A prior art disclosure may consist of a printed publication, oral publication or public use. Prior art disclosure would include disclosure by new media such as the internet and these disclosures should be subject to the same evidentiary rules as other forms of disclosures such as oral disclosure. An accidental disclosure or a disclosure in breach of confidence are citeable prior art disclosures. A prior art disclosure also includes a disclosure of information that could be derived by disassembly or reverse engineering.

Résumé

Une divulgation d'art antérieur devrait inclure toute divulgation qui est disponible au public n'importe où à travers le monde. Mise à part la question d'âge, une divulgation antérieure qui peut être citée au niveau de la nouveauté devrait pouvoir également être citée au niveau de l'étape inventive. Des demandes en instance qui n'ont pas encore été publiées ne devraient avoir aucun effet sur l'évidence mais devraient pouvoir être citées en ce qui a trait à la nouveauté dans des systèmes de premiers déposants.

Afin de se qualifier en tant que divulgation antérieure, la divulgation doit être “disponible au public”. Autrement dit, (1) elle doit être devenue disponible de façon générale sans restriction aux membres du public; et (2) la ou les personnes recevant le document ne doit(vent) pas avoir de lien spécial à l'auteur.

Une divulgation d'art antérieur peut se composer d'une publication écrite, d'une publication orale ou d'un usage public. Des divulgations par de nouveaux médias comme l'internet feraient partie de la divulgation d'art antérieur, et devraient être exposés aux mêmes règles de preuve que d'autres formes de divulgations, par exemple la divulgation orale. Une divulgation accidentelle ou une divulgation en bris de confiance constitueraient des divulgations d'art antérieur qui pourraient être citées. Une divulgation d'art antérieur comprend également la divulgation d'information qui pourrait être dérivée par désassemblage ou par rétro-ingénierie.

Zusammenfassung

Eine Offenbarung des Standes der Technik sollte alle Offenbarungen, die der Öffentlichkeit weltweit zur Verfügung stehen, einschliessen. Abgesehen von zeitlichen Fragen sollte eine Offenbarung des Standes der Technik, die wegen Neuheit anführbar ist, auch wegen Erfindungshöhe anführbar sein. Anhängige Anmeldungen, die noch nicht veröffentlicht worden sind, sollten keinen Einfluss auf Offensichtlichkeit haben, sollten aber wegen Neuheit in ersten Hinterlegungssystemen anführbar sein.

Um als Stand der Technik in Betracht zu kommen, muss die Offenbarung "der Öffentlichkeit zur Verfügung stehen". Das heißt, (1) das Publikum muss allgemein unbeschränkt Zugang dazu haben und (2) die Person oder Personen, die die Dokumente erhalten, dürfen kein besonderes Verhältnis mit dem Urheber haben.

Eine Offenbarung des Standes der Technik kann aus einem schriftlichen Dokument, einer mündlichen Offenbarung oder aus öffentlicher Benutzung bestehen. Eine Offenbarung des Standes der Technik würde eine Offenbarung durch neue Medien wie zum Beispiel das Internet einschließen und diese Offenbarungen sollten denselben Beweisregeln unterworfen sein wie andere Offenbarungsformen z.B. mündliche Offenbarungen. Eine zufällige Offenbarung oder eine vertrauensbrüchige Offenbarung sind anführbare Offenbarungen des Standes der Technik. Eine Offenbarung des Standes der Technik umfasst auch eine Offenbarung von Informationen, die von einer Demontage oder *reverse engineering* ausgehen.

Report Q167

in the name of the Czech Group

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

The state of the art comprises everything disclosed to the public in writing, verbally, by use or otherwise prior to the date from which the rights of priority belongs to the applicant. The state of art is also contents of applications filed in the Czech Republic, which have an earlier priority, or PCT international applications or European applications, designating Czech Republic, provided they were published on or after the date from which the priority rights belong to the applicant. However, contents of such applications shall not be decisive for consideration of the inventive step. The disclosure of an application which took place not earlier than six months prior to the filing of the application shall not be considered as being part of the state of art if it was due to evident abuse in relation to the applicant or his predecessor in title and if the applicant has displayed the invention at an officially recognized international exhibition.

Report Q167

in the name of the Danish group
by Torsten NØRGAARD, Ejvind CHRISTIANSEN, and Pernille THORSBOE

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

Before going into details with any of the specific questions, we have the following general comments:

- a) Since the conclusions for utility models are the same as the conclusions for patents, we will hereinafter only deal with patents.
- b) It is important to notice that Denmark is a party to the European Patent Convention (EPC). The Danish Patent Law has been harmonized with EPC. The provisions in the Danish patent act concerning novelty and inventive step (§ 2) are not a direct translation of the analogous provisions in EPC (Art. 54 & 56). However, the Danish Patent Office has, on several occasions, expressed the view that they will comply with the general practice used by the European Patent Office (EPO) as stated in case law.

1.1.1 According to § 2 patents can be granted only for inventions which are new in relation to the state of the art prior to the filing date of the patent application and which, moreover, differ essentially therefrom.

1.1.2 There is, in principle, no difference between prior art regarding novelty on the one hand and inventive step on the other hand. [The Danish patent act (§ 2.4) has a provision corresponding to Art. 54 (5) EPC according to which the patentability of any known substance or composition for use in a method for treatment of the human and animal body by surgery or therapy and diagnostic methods practiced on the human or animal body, is not excluded if it was not known to use said substance or composition in any of said methods.]

According to § 2.2.2, the content of an earlier filed Danish patent application or an International or European patent application designating Denmark (§§ 29 & 82.2), which is made available to the public (§ 22) shall also be regarded as comprised in the state of the art with regard to novelty but not with regard to inventive step. This complies with Articles 56 and 54(3) EPC (with the difference that according to Art. 54(3), only European patent applications (and not national applications in the various EP countries) are dealt with). Hence, even though a prior Danish patent application cannot be cited during the procedure before EPO it can be cited against the Danish counterpart of the EP patent, for example, by re-examination vide § 53b. Due to the reduced costs and the improved legal certainty, we strongly favour a system where the relationship between two applications on the same or similar inven-

tions is decided on the basis of the filing dates of said applications compared with a system where the decision depends on the actual date of conceiving the two inventions and reduce them into practice.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Yes. The state of the art shall be held to comprise everything made available to the public by means of a written description, lecture, exploitation or in any other way vide § 2.2.1.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.*

Since Denmark will comply with EPC, reference can be made to the EPO guidelines, especially C, IV, 5 (as regards the application procedure), and D, V, 3 (as regards the opposition procedure).

2. **Criteria for disclosure**

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

2.1.1 The disclosure is not limited to any mean.

2.1.2 Theoretically, there is no difference between disclosure by written documents and other types of disclosure. However, in practice it may be difficult to determine what exactly was disclosed by an oral disclosure or disclosed by use. Also in this connection specific reference can be made to the EPO guidelines. For example, when a product has been put on the market, the composition thereof is known provided it could be analyzed and reproduced by a skilled art worker, vide EPO Guidelines D, V, 3.1.3.1, in fine. For an oral disclosure, specific reference is made to the EPO Guidelines D, V, 3.2.3.

2.1.3 The Danish patent law (§ 2 (5)) has a provision corresponding to Art. 55 (1) EPC concerning a disclosure, not earlier than 6 months from the filing date, which took place due to an evident abuse in relation to the applicant or if the invention was displayed on a special recognized exhibition, vide the Paris Convention and EPO Guidelines C, IV, 8.

It seems unfair if an inventor should loose patent protection in the case of evident abuse or display at certain exhibitions within a limited period of time.

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

2.2.1 It does not matter when the disclosure took place.

2.2.2 No. There are no such limits.

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? 4) Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

- 2.3.1 No. The place of disclosure is not relevant.
- 2.3.2 The question about determination of the place of disclosure seems irrelevant, vide answer 2.3.1.
- 2.3.3 Apart from the above provision concerning publication by evident abuse, accidental and intentional disclosures have the same impact.
- 2.3.4 The determination of whether a disclosure has occurred is to be made according to the Danish law.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

- 2.4.1 Apart from the above situation with publication by evident abuse it does not matter which person makes the disclosure public available.
- 2.4.2 Apart from the above situation with publication by evident abuse which only applies for a 6 months period of time from the filing date, the disclosure is not treated differently if the disclosing person was bound by a confidentiality agreement.
- 2.4.3 If a publication is meaningful to the skilled art worker it is valid as a citation in that form, even though it may contain errors. However, if there are obvious errors in a publication such obvious errors may be disregarded as a prior art disclosure. For example if some specific figures are mentioned in a basic publication and, obviously, those figures have been cited incorrectly in an abstract of said publication, the figures in the abstract are to be disregarded. A skilled art worker can make a declaration stating what a specific document teaches and absent contrary declarations, the Patent Office will use such an interpretation. It is, however, to be decided on a case-by-case basis whether the errors are obvious or not and accordingly can be disregarded.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

- 2.5.1 A printed publication gives that information which a skilled art worker can gain from it. Oral information is considered a disclosure if the person(s) getting the information do understand the information or are able to pass the information on to other, even though the person(s) first getting the information did not themselves understand the information.
- 2.5.2 Yes, vide EPO Guidelines D, V, 3.1.3.1. This is irrespectively of whether or not particular reasons can be identified for analyzing said composition or internal structure of said object.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the World-wide Web, chat groups or forums, e-mail and others?

Before going into details with any of the specific questions it is important to notice that for "disclosure through new media" there are no specific guidelines for European patent applications or for Danish patent applications. Since, in this field, there appears to be a big similarity with the Japanese Patent law and practice reference can be made to the Operational Guidelines on Treatment of Technical Information Disclosed on the Internet as Prior Art issued by JPPTO.

3.1.1 Yes. According to § 2.2.1, the state of the art comprises everything made available to the public in any way. Hence, a paperless information constitutes a sufficient disclosure to affect novelty or inventive step.

3.1.2 In principle, there are no specific requirements for the publication by a paperless information. In practice, however, there may be difficulties in determining whether it was made public available, what was published, and when it was published.

3.1.3 In connection with the various forms of networks or communications, some are available to the public other are not. Information can be considered as being available to the public if it is published on the internet, commercial databases, and mailing lists, its presence and location can be found by the public, and it is accessible by unspecified persons, even if there is a charge of access or the access to the internet or commercial database requires a pass word which can be acquired through a set, non-discriminating procedure. Usually, E mails are considered private and non-public correspondence.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

3.2.1 If the information is encrypted, it is not considered public available, unless a decoding tool is openly available through a set means (with or without a charge).

3.2.2 In many cases, a disclosure is not public available if access can only be made using a password. However, if the password can be acquired easily through a set, non-discriminating procedure, optionally with the payment of a fee the disclosure is public available. The payment requirement for getting a password is similar to the payment for buying a magazine. In order for a disclosure to be public available, it is not necessary that the disclosure can be found by a search engine. Generally, it is not a requirement for a disclosure to be public available that it can be found by a simple, systematic search, for example, in an index or a catalogue or archive.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

3.3.1 For the prosecution of a Danish application, it doesn't matter where the information was put on the internet.

3.3.2 The disclosure is a prior art disclosure even if a web-site can only be accessed in a certain place.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

3.4.1 In principle, a disclosure is a prior art disclosure, even if it were only public available for a short period of time. However, the information should need to appear on the

internet at least as long as it was necessary for the public to download or print the information.

- 3.4.2 There need not be archives for disclosures in order to make the disclosures prior art disclosures. When it comes to determining whether it was made public available, what was published, and when it was published, archives are highly desirable.

3.5 Questions of evidence

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

- 3.5.1 There is no general rule covering all situations. However, from the beginning, the opponent has the burden of proof. If the opponent can lift the burden of proof, the applicant gets the burden of proof. Generally, based upon the information available it is decided whether a disclosure is a prior art disclosure or not. In many cases, it is desirable to get a declaration from the person with authority or responsibility for the disclosure as to whether the disclosure were public available or not. If the Patent Authority will use a paperless information as a citation, they have the responsibility to prove the contents of the disclosure on the Internet before the filing date of the application.
- 3.5.2 No. In principle, the internet does not require rules different from those already existing for oral disclosure or the disclosure in other ways.
- 3.5.3 If a disclosure is dated, as a starting point, that date should be considered as being the date of publication unless the correctness of the date is disputed by the applicant or by any opponent. Even if there were no publication date on the web page, it could be cited provided a certificate concerning the contents and publication date was obtained from the publisher.
- 3.5.4 As a starting point, one shall disregard the possibility of the disclosure being manipulated. However, if it is claimed that there is a possibility that a manipulation has taken place, an investigation is needed.

4. Conclusion

After the discovery of cars, trains, aeroplanes, and telephones, it should be evident that a prior art disclosure shall have the same impact on novelty and inventive step, independent on where in the world it was made available to the public. After the development of electronic communication, this it even more evident.

Generally, we think that, in relation to the issues in question, it would be very adequate if all patent law and practice were harmonized with EPC. To a large extent this is already the case. For example, also in Japan.

Summary

The Danish Patent Law has been harmonized with EPC. The Danish Patent Office will comply with the general practice used by the European Patent Office (EPO). There is, in principle, no difference between prior art regarding novelty on the one hand and inventive step on the other hand. The state of the art shall be held to comprise everything made available to the public by means of a written description, lecture, or exploitation or in any other way. Theoretically, there is no difference between disclosure by written documents and other types of disclosure. It does not matter when

the disclosure took place. The place of disclosure is not relevant. If a publication is meaningful to the skilled art worker it is valid as a citation in that form, even though it may contain errors.

An earlier filed Danish patent application or an International or European patent application designating Denmark, which is made available to the public, shall also be regarded as comprised in the state of the art with regard to novelty but not with regard to inventive step. We strongly favour a system where the relationship between two applications on the same or similar inventions is decided on the basis of the filing dates of said applications compared with a system where the decision depends on the actual date of conceiving the two inventions and reduce them into practice.

The Danish patent law has a provision corresponding to Art. 55 (1) EPC concerning a disclosure, not earlier than 6 months from the filing date, which took place due to an evident abuse in relation to the applicant or if the invention was displayed on a special recognized exhibition.

Since, concerning paperless disclosures, there appears to be a big similarity with the Japanese Patent law and practice reference can be made to the Operational Guidelines on Treatment of Technical Information Disclosed on the Internet as Prior Art issued by JPPTO. Paperless information constitutes a sufficient disclosure to affect novelty or inventive step. In principle, there are no specific requirements for the publication by paperless information. Usually, E-mails are considered private and non-public available correspondence. If the paperless information is encrypted, it is not considered public available, unless a decoding tool is openly available through a set means (with or without a charge). In principle, a disclosure is a prior art disclosure, even if it were only public available for a short period of time. In principle, the internet does not require rules different from those already existing for public available oral disclosure or disclosures in other ways.

Generally, we think that, in relation to the issues in question, it would be very adequate if all patent law and practice were harmonized with EPC.

Report Q167

in the name of the Egyptian Group
by Hoda A. SERAGELDIN (Arab TMP Bureau, Saba & Co.)

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

Patents in Egypt are protected under the provisions of Law no. **132/1949** as amended. This law will remain in force until the process for harmonization of all IPR legislations in accordance with the TRIPS Agreement is ratified by the People's Assembly (the Parliament).

Utility models are not protected under the provisions of law no. **132/1949**. The new code for Intellectual Property Protection which is presently debated at the Parliament will extend protection to utility models for a period of seven years.

According to articles (**30-32**) of the Draft Law utility models will be submitted to the same regulations and acquire the same rights as Patents.

1. Determination of prior art

1.1 *What is the effect of prior art disclosure on novelty & inventive steps? Are there differences between prior art regarding novelty on the one hand & inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty & inventive step?*

The application will be rejected upon examination for lack of novelty if it is the subject matter of any prior patent and/or pending patent application.

The Egyptian Patent Office does not proceed with a thorough substantive examination thus there is no differentiation between assessment of novelty and inventive step.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Article **3** of the Patent Law no. **132/1949** has given a clear definition of what constitutes prior art disclosure :

"An invention shall not be considered partially or totally new in the two following cases:

- a) *If the invention had really been publicly used in Egypt, or if its description or drawing had appeared in publications published in Egypt during the **50** years preceding the date of the submission of the application for the patent, provided the description or the design published is sufficiently clear to enable experts to exploit it.*
- b) *If a patent had already been issued for an invention or part thereof to a person other than the inventor or to the person to whom his rights have devolved during the **50** years prior to the date of the presentation of the application for the patent, or if an*

application had already been made for a patent by another person for the same invention or part thereof during the said period."

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

Apart from what we stated above in **1.2**, the Examiners at the Patent Office proceed to a search via the internet for any prior art disclosure. Patent applications which have already been published by WIPO are automatically rejected.

2. Criteria for disclosure

2.1 *Means of disclosure*

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

It is mainly disclosure through written documents which is recognized by law and practice. Disclosure by use as well as oral disclosure have to be corroborated with written evidence (e.g. newspapers clippings, printed matter, etc.....).

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which is the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty & inventive step?

The time of disclosure is limited to a period of **50** years prior to the date of submission of the patent application.

See above in **1.2** article **3** of the Patent Law

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

According to the Patent Law no. **132/1949** still in force, the place of disclosure should be Egypt (see above in **1.2** article **3** of the Patent Law). Twenty years ago, the Examiner used to rely solely on the publications which reached the Patent Office in order to assess novelty and/or prior art disclosure. However, nowadays, any information published via the internet is considered as a prior art disclosure since it is available in Egypt.

The Patent Law no. **132/1949** provides a special clause for protection of inventions during exhibitions.

Article **52** of the Patent Law no. **132/1949** stipulates that:

"The executive regulations of this law shall embody provisions that warrant temporary protection of the inventions and industrial designs & models exhibited in national or international fairs that are held in Egypt or in one of the countries according Egypt similar treatment. The Minister of Commerce and Industry shall issue a decision determining these fairs"

Thus in such cases it would not be considered as prior art disclosure.

2.4 *Personal Elements*

What differences do the Groups observe with regards to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

It makes no difference if the piece of information was disclosed by the applicant himself or/by a third party.

The Patent Office will not recognize any confidentiality agreement, this is a matter which can only be settled in front of the Court as a breach of contract.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

According to article 3, the ability of the public to understand the information is a criteria for assessing prior art disclosure. Reverse engineering is not mentioned in Patent Law no.132/1949. The Draft Patent Law will allow reverse engineering for the purpose of scientific research only (article 11 of the Draft Law).

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

The Patent Office rejects a patent application for lack of novelty if it is published on the internet and thus available to the general public. This would not include chat group or e-mail. Electronic commerce is still being codified in Egypt, and no Court of law would accept electronic matters as evidence of use.

3.2 *Question of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

Same answer as in 2.4.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

As long as the website is accessible to the general public in Egypt, it is considered a place of disclosure.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

There are no specific requirements for the timing and the duration of the information available through electronic means. Archives are not necessary.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other way? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through the new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

As explained before, in Court cases, one has to provide a written document as evidence of prior art disclosure. There are no specific legislations or rules pertinent to this matter.

Conclusion

The Draft Law for protection of Intellectual Property which is presently being debated at the Parliament follows the standards established by the **TRIPS agreement**. Article **3** of the Draft Law on Patents includes a broader definition of novelty, as regards the time and place of disclosure. However, it does not address specifically disclosure through new media.

The Egyptian Group believes that as long as the information communicated to the public via the internet is easily accessible and retrievable, it should be considered as prior art disclosure in the assessment of novelty.

Moreover, this issue should be addressed in a specific legislation in order to enable a Court of law to assess properly lack of novelty.

Summary

Patents and Industrial Designs are protected in Egypt under law no. **132/1949** as amended. Utility Models are not protected under the provisions of law no. **132/1949**.

According to article **3** of the Egyptian Patent Law no. **132/1949** presently in force, an invention will be deemed as not novel if a patent has been issued or a patent application has been filed in Egypt by another party for the same invention or part thereof during the 50 years preceding the date of submission of the application. The patent application will also be rejected upon examination, if the invention is already in use in Egypt or has been published or disclosed in the media or via the internet in a manner which would enable an expert to exploit it.

Article **52** of the same law extends temporary protection to invention disclosed in international fairs that are held in Egypt or in one of the countries according Egypt similar treatment.

From this we can conclude that whilst novelty is a basic requirement for the patentability of an invention, it is still a relative concept limited in time (**50** years) and space (Egypt) .

The New Code for Protection of Intellectual Property, which is presently debated at Parliament, requires absolute novelty as a condition for patentability. The Draft Patent Act will also extend protection to utility models for a period of **7** years. The same requirements for absolute novelty will be applicable to Utility Models. However, the Draft Law does not address specifically disclosure through new media.

The Egyptian Group believes that disclosure through new media should be addressed in a specific legislation in order to enable a Court of law to assess properly lack of novelty.

Report Q167

in the name of the Finnish Group
by Kim FINNILÄ, Eva GREW, Annika HAKKILA, Anne HARMAALA, Mia HIMBERG,
Pia HJELT, Veli-Matti KÄRKKÄINEN, Mikko MANNER, Marja-Leena MANSALA,
Raili RINKINEN and Jyrki SIIVOLA

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

1. Determination of prior art

1.1 What is the effect of a prior art disclosure on novelty and inventive steps?

The effect is that patents may be granted only for inventions, which are new in relation to what was known before the filing date of the patent application and which also differ “essentially” therefrom. This applies also to utility models with the difference that the inventions, for which a utility model right is applied, must differ “clearly” from what was known earlier (*i.e.*, the threshold is lower than for patents).

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?

No, there are no differences between novelty and inventive step in this evaluation.

Do pending applications, which have not yet been published, affect the assessment of novelty and inventive step?

Yes, pending (1) Finnish patent applications and (2) Finnish utility model right applications, which are subsequently published, and also (3) EPC patent applications, which are published, in which Finland is designated and the designation fees have been paid and (4) international patent applications, which are pursued in Finland, are taken into account in the assessment of novelty of the later application but not in the assessment of inventive step of the later application.

1.2 Do the national laws give definitions or indications as to what constitutes a prior art disclosure?

Yes, according to the Finnish Patents Act everything made available to the public in writing, in lectures, by public use or otherwise shall be considered as prior art disclosure.

1.3 Which guidelines are used to determine whether a piece of prior art has been disclosed?

The Finnish Patent Rules and the Patent guidelines, which are issued by the National Board of Patents and Registration, give the basic definitions as to what constitutes a prior art disclosure.

According to the hierarchy of the legal norms in Finland, the above mentioned guidelines do not exceed the Constitution or law.

2. Criteria for disclosure

2.1 Means of disclosure

What are recognised means of disclosure?

As already stated above, all means of disclosure are recognised in Finland. In the Finnish National Report regarding Q 138 A, it was stated that the means of communication bear no

significance in determining whether or not an invention has been made available to the public for the anticipation purposes. This applies to both patents and utility model rights.

Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?

No, there are no additional requirements in this aspect. If there is any controversy arising from the fact whether the contents of an invention have already been disclosed, it creates a burden of proof.

If certain means of disclosure are not recognised either by law or in practice, what are the reasons?

As discussed above, all means of disclosure are recognised.

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago?

No, it does not matter.

Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

No, there are no limits as to time in respect of the estimation of novelty and inventive step.

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?

The place of disclosure is not relevant, *i.e.*, it does not affect novelty. There is no limitation regarding the actual place; thus, disclosure anywhere in the world in any language could constitute a novelty bar.

It does not make any difference whether the disclosure has happened accidentally as opposed to intentionally. Events of accidental disclosure are not regulated in Finland and such disclosure shall affect novelty in the same manner as intentional disclosure.

Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

The applicable law for determining whether a disclosure has occurred is the law of Finland.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art?

In principle there are no differences regarding the person who discloses the prior art. If the disclosure was a result of an evident abuse in relation to the applicant or his predecessor, the patent may be granted for inventions, which are made available to the public by such disclosure within six months preceding the filing date.

A patent may also be granted despite a disclosure if the applicant or his predecessor in title has displayed the invention at an official, officially recognised, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928.

Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

No, the disclosure is not treated differently if the disclosing person was bound by a confidentiality agreement.

How are errors in the disclosed information treated?

Errors in the disclosed information are to be treated *in casu*. An error in the disclosed material might have the effect that the invention has not lost its novelty, *i.e.*, due to the error the invention is not actually disclosed.

2.5 Recipient of the Information

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?

With regard to the ability to understand the information, the ability is appreciated from the point of view of the person skilled in the art, *i.e.*, the interpretation is based on the viewpoint of how the person skilled in the art would understand the content of the disclosure. Each disclosure is to be compared separately to the patent application. The relevant matter is the content of the disclosure and whether such content of the disclosure can be defined, not the recipient itself. It is also possible that a person might obtain information through additional steps, such as disassembly of embodiments or reverse engineering and this could constitute a novelty bar.

Are there general rules providing for the effect of confidentiality or implied confidentiality?

No, there are no general rules providing for the effect of confidentiality or implied confidentiality. However, these issues are defined in the legal praxis.

3. Disclosure through new media

3.1 General rules

Does a paperless information, e.g., in an electronic network or through the Internet, constitute a sufficient disclosure to affect novelty or inventive step?

Yes, under the Finnish Patents Act, the standard against which novelty is determined is absolute and objective. All information available to the public by any means anywhere in the world prior to the day upon which the patent application was filed is relevant. Therefore the medium via which the disclosure has been made is not a limiting factor when determining whether or not an invention has been made available for the public.

Are there specific requirements compared to other forms of disclosure?

No, the overall requirements presented in the previous sections apply to disclosure through new media also. Disclosure through new media could in some respects be compared with oral disclosure, as the problems associated with determining the timing and content of the disclosure are to a certain extent similar.

Are there differences with regard to various forms of networks or communications, such as the World-Wide Web, chat groups or forums, email and others?

There is no legislation, general rules or guidelines that would expressly address the issue of various forms of communications or networks. However, from a technical standpoint, networks can be controlled with regard to access and categorised based on the differences therein.

Firstly, the information may be available for viewing only, *i.e.*, one is not able to download it or alter it in any way. Secondly, it may be available for viewing and downloading, but not for alteration. And thirdly, it may be unrestricted in this respect. These practical differences that are achieved via various technical means may also make a difference when assessing the various aspects relating to a possible disclosure.

Distinction is commonly made between intranets, extranets and the Internet. Intranets are the internal networks of, for example, a company, a group of companies or research insti-

tute(s). The access to this type of network is usually by definition limited to the employees of the entity in question and might be compared to physical bulletin boards or a company newsletter, however, with the distinction that access and dissemination of the information available may be limited via technical means and the disclosing entity definitely has the possibility to control the dissemination of information.

Extranets are by definition also networks that are limited with regard to access. Usually extranets are used by a certain entity to communicate with its business partners, clients and other relevant reference groups. Access to extranets is commonly limited by use of passwords and other similar technical solutions.

Intranets and extranets commonly have administrators who maintain the network. These administrators are usually the only ones with the possibility to alter the content of the network at any given time. However, in principle only technical means set the limits to the users and these may vary greatly between different solutions.

The Internet and the www-solution are open to public for unrestricted viewing. Chat groups and forums are commonly regarded as public places of discussion. This is, however, dependent on the policy applied by the moderator or operator of the chat room in question. Also some www-sites may choose to limit the access thereto by passwords, payment requirements and such.

Basically, the same background solution and method of operation may only be used by a limited group of people to exchange confidential information about technological advances or by whoever on the web to discuss gardening. The difference is to be assessed on an ad-hoc basis and is dependent on the applicable technical and administrative restrictions.

Email offers addressed communications between network users. An email may be addressed to a single person or group of persons. It may be also addressed to an unspecified recipient or group of recipients. As the inviolability of privacy in mail and telephone communications is a constitutional right in Finland, interpersonal email are protected as well. However, group-emails might in some cases constitute substantial public disclosure. In some cases the employer may by virtue of the law be allowed to access the email communications of an employee and this might lead to a disclosure beyond the perimeters of private personal communications.

Also, the email may be addressed to an unspecified recipient such as info@company.com or other email addresses, which might further transfer the content of the email to a larger audience than what was originally intended by the sender. This type of email communications might warrant the interpretation of a public disclosure, provided that the recipient group fulfils the characteristics of "public". One specific characteristic of email is that it may be very easily circulated beyond the intended recipient(s). In the event a recipient further distributes the email, one must assess the circumstances surrounding the first email and evaluate whether this further distribution can be considered evident abuse as described earlier in the text.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted?

It may. Encryption can be achieved in numerous ways with varying levels of efficiency and reliability. As in principle any method of encryption is vulnerable to attacks on its integrity, it is questionable whether encryption may be considered a relevant factor. However, it may be used as evidence of the intent of the disclosing entity/person. If an encrypted message is sent to a predetermined recipient or a group of recipients and then someone other than a rightful recipient intercepts the message, decrypts it and disseminates its content to the public, the sender may claim that the disclosure to the public has been in fact evident abuse. Encryption may also be used as evidence of the obligation of confidentiality imposed on the recipient of the information.

Especially in the context of email, one can ask whether encryption should be relevant, as a regular email somewhat resembles a postcard and the encryption can be thought of to create an envelope around it to protect the message from the eyes of the public.

What relevance do passwords, search engines and payment requirements have?

Passwords - depending on the policy on basis of which they are granted - may have some significance in determining whether a disclosure has been available to the public or not. If anyone may via a free - or for a chargeable - subscription obtain the required password, the information may be regarded as publicly available.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the Internet?

In principle the geographical place of the disclosure is irrelevant as regards the question at hand. Therefore, information made available through the Internet may be considered available world-wide in this respect.

Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

As the place of disclosure is without legal relevance in this respect, a mere possibility of access should be sufficient for the disclosure to be considered publicly available.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means?

Yes, the timing of the disclosure has to be prior to the date of the filing of the application for the disclosure to be considered relevant. However, the duration of the availability of the information to the public is in principle not relevant here. Yet, in certain cases, a very short period of availability might render the disclosure not public, provided that the circumstances have been such that no chance of actually viewing the information has existed. Even so, generally there is no need for an actual viewing to have happened.

Are archives necessary or desirable?

Archives are means of evidence when using the disclosure in patenting procedure or patent litigation and, therefore, may be considered appropriate. However, due to the relative ease with which any digital content may be undetectably modified, the actual value of such archives depends greatly on their provider.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the Internet?

A party claiming that a disclosure has occurred on the Internet should be prepared to carry the burden of proof in that issue regardless of the party's role in any proceeding, whether it be patent litigation or administrative prosecution of the application. This means that the party should show that information fulfilling the criterion of relevant disclosure has been available on the Internet. The relevance of that possible prior art is another question, which needs to be assessed separately.

Does the Internet require rules different from those already existing for oral disclosure or the disclosure in other ways?

No, it does not. However, the existing rules should be applied with sufficient understanding of the context in which the disclosure is being made.

Should there be different levels of evidence for different ways of disclosure?

No, the principles regarding evidence and evidential value should continue to remain technology-neutral and therefore should not be altered due to new media methods of disclosure.

Regardless of the foregoing, the Group wishes to emphasise that an understanding of the underlying technical characteristics is of utmost importance in assessing these questions.

Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

As the manipulation of any information in digital form is relatively simple for any skilled professional, this should be taken into account when estimating the evidential value of any information regarding Internet disclosures. However, there are currently no specific rules for this kind of disclosure.

4. Conclusions

The Group expresses support to the current principles of prior art disclosure, but wishes to highlight the problematic interface between emerging new technologies and the established patent doctrine as well as express certain concerns with regard to evidential aspects of assessing disclosure through new media.

Firstly, as a matter of principle, all parties, including the patent officials and the courts, should try to ensure that they obtain a sufficient understanding of the nuances of digital technology in order to make fair decisions regarding the issues and the evidence presented before them.

Secondly, as the technical characteristics of information networks may enable malicious exploitation of the patent system through interpretation of its established rules and regulations, some practical measures to address these concerns may very well be in order.

By way of an example, the use of third party services for the purpose of storing and verifying Internet disclosures might have a positive effect on the evidential value of a certain alleged Internet disclosure. The third party might be able to provide the claimant with untampered and unbiased descriptions of the timing and content of information that was made available on the Internet by either the claimant or some other entity (involved in current proceedings or not).

The infinite possibilities to modify digital information undoubtedly present a challenge to both technical and legal personnel involved in various aspects of any patent system. However, the Group feels that this does not require a change in the rules applicable to judicial or administrative decision-making, neither regarding the assessment of novelty nor the evidential value of information presented.

Summary

In the Finnish patent system, the effect of a prior art disclosure is that patents may be granted only for inventions, which are new in relation to what was known before the filing date of the patent application and which also differ essentially therefrom.

The Finnish patent system is based on absolute and objective novelty. Neither the time of disclosure nor the place or the media of disclosure is relevant in assessing novelty. All information available to the public by any means anywhere in the world prior to the day upon which the patent application was filed is relevant.

The emergence of new technologies, through which disclosure may take place, might be considered to raise the possibility of abuse of the patent system.

The Group considers that it might be appropriate, for example, to create a praxis for the purpose of storing and verifying Internet disclosures. Such a third party service system could provide the parties (especially the person who claims that a disclosure has or has not taken place) with untampered and unbiased descriptions of the duration of disclosure and the content of information, which was made available on the Internet by the claimant or some other party.

The Group is of the opinion that the present patent system in assessing prior art disclosure should not be changed because of the existence of the Internet, but that attention should be paid especially to the possibility of abuse and measures to prevent it.

Résumé

Dans le régime de brevets finlandais, l'existence d'une divulgation de l'état de la technique a pour effet que les brevets ne peuvent être accordés que pour des inventions présentant un caractère de nouveauté au regard de ce qui était connu avant la date de dépôt de la demande de brevet, tout en introduisant par ailleurs une différence essentielle par rapport aux éléments antérieurement connus.

Le régime de brevets finlandais repose sur une notion de nouveauté absolue et objective. Ni le moment de la divulgation, ni le lieu ou le moyen par lequel s'opère cette divulgation ne sauraient être pris en compte pour apprécier le caractère de nouveauté d'une invention. Toutes informations dont peut disposer le public par quelque moyen que ce soit et en quelque endroit du monde que ce soit antérieurement au jour où est déposé de la demande de brevet sont pertinentes.

On peut considérer l'apparition de technologies nouvelle, susceptibles de servir de cadre à une divulgation, comme un facteur possible d'augmentation de l'usage abusif du régime de brevets.

Le Groupe considère qu'il y aurait lieu par exemple de créer un dispositif destiné à stocker et à vérifier les divulgations opérées sur Internet par des tiers. Ce type de service de consultation d'informations sur les tiers apporterait aux parties (en particulier à une personne affirmant qu'un cas de divulgation s'est effectivement produit, ou bien qu'il n'a pas eu lieu) des précisions fiables et impartiales sur la période pendant laquelle la divulgation a eu lieu ainsi que sur le contenu des informations qui auront été communiquées au public sur Internet par le demandeur ou toute autre partie.

Le Groupe estime que le régime de brevets actuel en matière d'appréciation de l'état de la technique ne doit pas faire l'objet de modifications du fait de l'Internet, mais qu'il y a lieu d'apporter une attention toute particulière à la possibilité d'utilisation abusive en la matière ainsi qu'aux mesures destinées à prévenir cet état de choses.

Zusammenfassung

Im finnischen Patentsystem hat die Offenlegung des Standes der Technik die Wirkung, dass Patente nur erteilt werden für Erfindungen die neu sind im Bezug auf das was vor dem Anmeldetag der Patentanmeldung bekannt war und denen gegenüber es also einen wesentlichen Unterschied gibt vom o.g..

Das finnische Patentsystem basiert auf dem Grundsatz der absoluten und objektiven Neuigkeit. Weder der Zeitpunkt der Erfindung noch der Ort oder das Medium der Erfindung hat Bedeutung für die Bestimmung der Neuigkeit. Jegliche Information, die zugänglich war für jedermann rund um die Welt bis hin zu dem Datum, wann der Patentantrag eingetragen wurde, ist von Bedeutung.

Das Aufkommen der neuen Technologien, wodurch die Anmeldung möglich ist, könnte zu Missbrauch des Patentsystems führen.

Die Gruppe sieht an, dass es sachlich wäre, eine Praxis für das Speichern und die Bestätigung von Daten im Internet durch dritte Parteien zu schaffen. Solch ein System von Service durch dritte Parteien könnte den Parteien (insbesondere der Person, die behauptet, dass eine Anmeldung stattgefunden hat/nicht hat) unveränderte neutrale Beschreibungen über die Dauer der Anmeldung und dem Inhalt der Daten, die der Kläger oder eine andere Partei im Internet zugänglich gemacht hat, anbieten.

Die Gruppe vertritt die Meinung dass das vorhandene Patentsystem, wo es die Pflicht, ältere/frühere Erfindungen anzumelden bestimmt, nicht verändert werden sollte aufgrund des Internets. Aber es muss speziell berücksichtigt werden, dass die Möglichkeit des Missbrauchs vorhanden ist und diesem vorzubeugen ist.

Rapport Q167

au nom du groupe français
par Serge BINN, Président. Jean-Paul DESOLNEUX, Florent GROS, Jean-Jacques MARTIN,
Bernard MICHARDIERE, Alain MICHELET, René MISRAHI, Denis MONEGIER du SORBIER

Les critères actuels de la divulgation de l'art antérieur pour l'appréciation des conditions de nouveauté et d'activité inventive

Remarques préalables

Avant de répondre aux questions, nous formulerons deux remarques:

1. Sur le plan du vocabulaire, nous n'utiliserons pas l'expression "*art antérieur*" qui peut prêter à confusion.

Nous utiliserons l'expression "*état de la technique*", qui figure dans la loi, pour désigner l'ensemble des informations techniques considérées comme divulguées à une date donnée. Nous utilisons par ailleurs le terme "*antériorité*" pour désigner une information technique particulière, divulguée ou non divulguée avant une date donnée.

En ce sens, une "antériorité" fait partie de l'état de la technique si elle a été divulguée à la date où l'état de la technique est pris en considération.

2. Les questions relatives à la divulgation d'une antériorité se posent en droit français dans le cadre des brevets français, mais également dans le cadre des brevets européens désignant la France.

Les brevets français sont délivrés sans examen de validité, et par conséquent l'organisme chargé de la délivrance (INPI) ne procède pas à un examen de la nouveauté et de l'activité inventive susceptible de soulever des questions de divulgation (sauf deux cas particuliers qui seront évoqués ci-après).

Il en résulte que, pour ce qui concerne les brevets français, ces questions ne peuvent se poser que devant les tribunaux français dans le cadre de l'appréciation de la validité des brevets.

Les brevets européens désignant la France sont délivrés par l'OEB dans le cadre de la Convention de Munich du 5 octobre 1973, qui prévoit un examen de la nouveauté et de l'activité inventive et, après délivrance, une procédure d'opposition.

Les questions relatives à la divulgation peuvent donc, en ce qui concerne les brevets européens désignant la France, se poser devant l'OEB au cours de la procédure de délivrance ou d'opposition, et devant les tribunaux français, lorsque leur validité est contestée, par exemple à l'occasion d'une procédure de contrefaçon.

Nous distinguerons donc, pour chacune des questions posées, les règles appliquées aux brevets français, et celles que l'on applique aux brevets européens désignant la France, étant observé que ces règles sont souvent identiques ou, à tout le moins, très proches.

1. Détermination de "l'art antérieur"

1.1 *Quel est l'effet de la divulgation d'un art antérieur sur la nouveauté et l'activité inventive? Existe-t-il des différences entre l'art antérieur concernant la nouveauté d'une part, et l'activité inventive, d'autre part? Les demandes en cours, qui n'ont pas encore été publiées, affectent-elles l'évaluation de la nouveauté et de l'activité inventive?*

1.1.1 Brevets français

- a) L'article L.611-11 du Code de la propriété intellectuelle (CPI) prévoit qu'une invention est considérée comme nouvelle si elle n'est pas comprise dans l'état de la technique.

En conséquence, la divulgation d'une antériorité identique à l'invention détruit la nouveauté de l'invention.

- b) L'article L.611-14 du CPI prévoit qu'une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d'une manière évidente de l'état de la technique.

En conséquence, la divulgation d'une antériorité peut détruire l'activité inventive de l'invention si celle-ci est évidente pour l'homme du métier, eu égard à l'antériorité divulguée éventuellement combinée à d'autres éléments de l'état de la technique.

- c) Selon l'article L.611-10 du CPI, l'invention dépourvue de nouveauté ou d'activité inventive n'est pas brevetable.

- d) L'état de la technique pris en compte pour l'appréciation de la nouveauté et de l'activité inventive est le même, à l'exception des demandes de brevet français et européens non publiées, qui sont prises en compte pour l'appréciation de la nouveauté et non de l'activité inventive.

1.1.2 Brevets européens

Les règles applicables aux brevets européens désignant la France sont identiques. Les articles L.611-11 et L.611-14 ci-dessus visés du CPI reproduisent les textes des articles 54 et 56 de la Convention de Munich.

1.2 *Les lois nationales donnent-elles des définitions ou indications sur ce qui constitue une divulgation de l'art antérieur?*

L'article L.611-11 du CPI et l'article 54 de la Convention de Munich ne donnent pas une définition de la divulgation, mais de "l'état de la technique", ce qui revient au même, car l'état de la technique contient toutes les informations tenues pour divulguées. L'état de la technique est constitué "par tout ce qui a été rendu accessible au public avant la date de dépôt de la demande de brevet par une description écrite ou orale, un usage ou tout autre moyen".

Par conséquent, divulguer une information technique consiste, selon la loi française et la Convention de Munich, à la rendre accessible au public par une description écrite ou orale, un usage ou tout autre moyen.

1.3 *Quelles sont les directives utilisées pour déterminer si un élément d'art antérieur a été divulgué? Cette question vise les directives autres que celles énoncées par la loi qui ont été établies dans les différents pays pour déterminer une divulgation.*

- 1.3.1 En ce qui concerne les brevets français, les tribunaux n'appliquent aucune directive. Ils appliquent la loi, telle qu'elle est interprétée par la jurisprudence.

L'INPI, dans les deux cas où il peut être amené à apprécier la validité d'un brevet (rejet pour absence de nouveauté manifeste - art. L.612-12 7°, et réduction éven-

tuelle des taxes - art. L.612-20) ne se réfère à aucune directive publiée. Il applique, comme les tribunaux la jurisprudence française et celle de l'OEB.

- 1.3.2 Pour ce qui concerne les brevets européens, l'OEB dispose de directives d'examen. Les directives applicables à la question de la divulgation sont les directives CIV5 pour la nouveauté et l'état de la technique, et CIV8 pour les divulgations non opposables.

Les tribunaux français, lorsqu'ils ont à connaître de la validité des brevets européens désignant la France, appliquent les mêmes règles que pour les brevets français.

2. Critères pour la divulgation

2.1 Moyens de divulgation

Quels sont les moyens reconnus de divulgation? Existe-t-il des exigences supplémentaires pour certains types de divulgations, tels que la divulgation orale ou la divulgation par l'usage, par rapport à la divulgation par le biais de documents écrits? Si certains moyens de divulgation ne sont pas reconnus par la loi ou par la pratique, quelles en sont les raisons?

Comme on l'a vu ci-dessus, la loi française et la Convention de Munich n'excluent aucun moyen de divulgation puisqu'au contraire, les deux textes prévoient que la divulgation peut être opérée par "tout autre moyen".

Chaque moyen de divulgation peut poser des problèmes particuliers sur le plan de la preuve, mais dès lors que la divulgation est établie, elle a les mêmes effets, quel que soit le moyen par lequel elle a été réalisée.

2.2 Date de divulgation

Est-il important qu'une divulgation ait été faite récemment ou depuis longtemps déjà? Existe-t-il des limites au-delà desquelles la publication d'une information, bien qu'elle constitue une divulgation de l'art antérieur, n'est plus pertinente pour l'évaluation de la nouveauté et de l'activité inventive?

La loi française et la Convention de Munich ne font aucune distinction entre les divulgations récentes et les divulgations anciennes. Toute antériorité divulguée fait partie de l'état de la technique quelle que soit la date de la divulgation.

On peut observer cependant que l'ancienneté des antériorités invoquées peut avoir une influence sur l'appréciation de l'évidence de l'invention, dans le cadre de la détermination de l'activité inventive.

2.3 Lieu de la divulgation

Le lieu de la divulgation est-il pertinent? Comment déterminer le lieu de divulgation? Importe-t-il que la divulgation ait eu lieu dans ce pays par accident ou qu'elle ait eu lieu de façon intentionnelle? Quelle est la législation applicable pour déterminer si une divulgation a eu lieu (la législation du pays dans lequel l'information a été divulguée, ou la législation du pays dans lequel la nouveauté et l'activité inventive sont évaluées)?

La loi française et la Convention de Munich ne font aucune distinction relativement au lieu de la divulgation.

Toute antériorité divulguée fait partie de l'état de la technique, quel que soit le lieu de la divulgation.

2.4 Eléments personnel

Quelles sont les différences observées par les Groupes à l'égard de la personne qui divulgue l'art antérieur? La divulgation est-elle traitée différemment si l'auteur de la divulgation était lié par un accord de confidentialité? Comment sont traitées les erreurs dans les informations divulguées?

2.4.1 Selon l'article L.611-13 du CPI, et l'article 55 de la Convention de Munich, la divulgation n'est pas prise en considération si elle a été réalisée par l'inventeur ou son prédécesseur en droit, moins de 6 mois avant la date du dépôt du brevet, par une présentation dans une exposition officielle ou officiellement reconnue au sens de la convention concernant les expositions internationales signée à Paris le 22 novembre 1928.

2.4.2 Selon les mêmes textes, la divulgation n'est pas prise en compte si elle a été réalisée par un tiers dans les 6 mois précédant la date du dépôt de la demande de brevet, dans le cadre d'un abus évident à l'égard de l'inventeur ou de son prédécesseur en droit.

Selon la jurisprudence, l'abus peut consister, par exemple, dans le fait de divulguer dans l'intention de nuire une invention communiquée par l'inventeur sous la condition du secret.

2.4.3 La communication de l'invention par une personne liée au secret est une divulgation.

Cette divulgation peut être considérée comme inopposable si elle a été réalisée moins de 6 mois avant le dépôt du brevet, ainsi qu'il a été indiqué ci-dessus.

Si cette condition de délai n'est pas remplie, l'invention est considérée comme divulguée, l'inventeur disposant éventuellement d'une action en dommages et intérêts à l'encontre de l'auteur de la divulgation.

2.4.4 Il n'existe pas, à la connaissance du Groupe Français, de jurisprudence française relative aux erreurs dans les informations divulguées.

En revanche, l'OEB, dans le cadre de la délivrance des brevets européens, considère généralement qu'une information erronée ne fait pas partie de l'état de la technique, lorsqu'il apparaît évident pour l'homme du métier qu'il s'agit d'une erreur (T89/87, T77/87, T591/90).

En revanche, l'information rectifiée peut faire partie de l'état de la technique.

Par ailleurs, la publication par erreur d'une demande de brevet avant la date prévue ne constitue pas nécessairement un abus à l'égard du demandeur.

Par conséquent, une telle divulgation pourra être opposable (T585/92).

2.5 *Bénéficiaire de l'information*

Quelles sont les exigences à l'égard de l'aptitude à comprendre les informations? Est-ce que la possibilité qu'une personne puisse obtenir les informations par des étapes supplémentaires, telles que le démontage de modes de réalisation ou une procédure de construction à l'envers (reverse engineering), suffisent à constituer une divulgation? Existe-t-il des règles générales couvrant l'effet de confidentialité ou la confidentialité implicite?

2.5.1 Aptitude à comprendre les informations

L'information n'est considérée comme divulguée, tant en droit français que dans le cadre de la Convention de Munich, que si la divulgation est suffisamment explicite pour qu'un homme du métier puisse la mettre en œuvre.

La divulgation est réalisée même s'il est nécessaire de procéder à des analyses et à une procédure de "reverse engineering" pour avoir connaissance des informations divulguées.

Dans un tel cas, la divulgation est réalisée même si l'homme du métier n'avait aucune raison d'effectuer l'analyse (T406/86).

D'une manière générale, les tribunaux français et l'OEB considèrent une information comme divulguée lorsqu'elle a été rendue accessible au public, sans qu'il soit nécessaire de démontrer que le public y a eu effectivement accès.

Il suffit donc qu'une seule personne ait eu la possibilité théorique d'y accéder, pour que cette information soit considérée comme divulguée, même s'il est établi que personne, en fait, n'a eu accès à l'information.

Cette conception très sévère pour l'inventeur est fortement ancrée dans le droit français et l'OEB, après quelques hésitations, s'y est finalement rallié (T381/87 et T444/88).

2.5.2 Règles générales relatives à la confidentialité

En droit français, comme dans le cadre de la Convention de Munich, la communication d'une information à une personne tenue à une obligation de confidentialité n'est pas une divulgation.

L'obligation de confidentialité peut résulter d'un contrat exprès. Elle peut également résulter de la qualité de la personne qui reçoit l'information (fonctionnaire, salarié, collaborateur).

Il faut souligner, à cet égard, que la jurisprudence française accepte de manière assez libérale l'obligation de confidentialité.

3. Divulgarion par les nouveaux médias

Le Groupe Français n'a pas connaissance de jurisprudence française relative aux questions de divulgation par les nouveaux médias. Il n'a pas non plus connaissance de décisions de l'OEB relatives à ces questions ou de directives particulières.

Le Groupe Français répondra donc aux questions ci-après en recherchant dans quelle mesure les règles qui s'appliquent aux divulgations par les moyens classiques peuvent également s'appliquer aux nouveaux médias.

3.1 Règles générales

Des informations sans support papier, par exemple dans un réseau électronique ou à travers Internet, constituent-elles une divulgation suffisante susceptible d'affecter la nouveauté ou l'activité inventive? Existe-t-il des exigences spécifiques par rapport à d'autres formes de divulgation? Existe-t-il des différences à l'égard de différentes formes de réseaux ou de communications telles que la « toile » mondiale, les groupes de discussion ou les forums, le courrier électronique et autres?

3.1.1 Comme les textes français et européens prennent en considération tous moyens de divulgation, y compris une divulgation orale, il est clair qu'une diffusion sans support papier dans un réseau électronique constitue en principe une divulgation ayant les mêmes effets qu'une divulgation par un moyen classique, sans exigence particulière.

3.1.2 Une distinction entre les différentes formes de réseaux serait sans doute opérée relativement au problème de l'accessibilité.

Ainsi, il est probable que le courrier électronique serait traité comme une correspondance privée, c'est-à-dire que l'information transmise serait considérée comme divulguée ou non selon les règles applicables pour déterminer si le destinataire est tenu ou non à une obligation de confidentialité.

En revanche, la communication sur les sites web serait considérée comme publique, de même que les groupes et les forums de discussion (sauf si des règles particulières ont été fixées pour en autoriser l'accès).

3.2 *Problèmes de confidentialité*

Cela fait-il une différence si les informations sont cryptées? Quelle pertinence ont les exigences relatives aux mots de passe, aux moteurs de recherche et aux paiements sécurisés?

3.2.1 Si une information est communiquée de manière cryptée, seul le destinataire peut y accéder. Cette situation ne modifie en rien l'application des règles classiques: l'information sera considérée comme divulguée ou non selon les obligations éventuelles de confidentialité du destinataire.

Si un tiers accède à une information qui ne lui est pas destinée, cryptée ou non, et la divulgue, la règle classique relative à la divulgation abusive pourra éventuellement s'appliquer.

3.2.2 Si l'accès à l'information nécessite la détention d'un mot de passe, les mêmes règles s'appliqueront eu égard aux détenteurs du mot de passe.

3.2.3 Selon la conception de l'accessibilité théorique ci-dessus évoquée, qui est celle des tribunaux français et de l'OEB, il est clair qu'une information accessible sur un réseau, avec ou sans moteur de recherche, sera considérée comme divulguée, même si en fait personne n'y a eu accès. Il suffira que l'accès ait été théoriquement possible, pour que la divulgation soit considérée comme réalisée.

3.3 *Lieu de la divulgation*

Quel est le lieu de la divulgation si les informations sont mises sur Internet? Le simple fait qu'un site web puisse être accessible en un certain endroit suffit-il pour une divulgation dans cet endroit ou doit-il y avoir des conditions ou exigences supplémentaires?

La question du lieu de la divulgation d'une information communiquée sur un réseau ne se posera jamais en France, puisqu'il n'est fait aucune différence selon le lieu de la communication.

3.4 *Date de la divulgation*

Existe-t-il certaines exigences quant à la date et la durée des informations disponibles par les moyens électroniques? Des archives sont-elles nécessaires ou souhaitables?

Selon la conception de l'accessibilité théorique, la durée de la communication sur le réseau n'aura aucune importance. Il en va de même de la date de la communication puisque les communications anciennes sont prises en compte de la même manière que les communications récentes.

La nécessité éventuelle d'archives relève des problèmes relatifs à la preuve qui sont traités ci-après.

3.5 *Problèmes de preuve*

Qui doit avoir la charge de la preuve qu'une information spécifique a été divulguée sur Internet? Est-ce qu'Internet nécessite des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens, Doit-il exister différents niveaux de preuve pour différents modes de divulgation? La manipulation potentielle d'informations divulguées par les nouveaux médias exige-t-elle des normes différentes pour la reconnaissance de cette divulgation, et y a-t-il des règles spécifiques pour ce type de divulgation?

3.5.1 Le Groupe Français rappellera tout d'abord les règles applicables à la preuve de la divulgation, selon le droit français et la Convention de Munich.

Les questions relatives à la divulgation étant des questions de fait, les tribunaux français appliquent les règles relatives à la preuve des faits.

Pour l'essentiel, ces règles reposent sur deux principes: la charge de la preuve d'un fait repose sur celui qui l'invoque, et la preuve d'un fait peut être rapportée par tous moyens (écrits, témoignages, faisceaux d'indices).

Par conséquent, c'est celui qui invoque une divulgation qui devra démontrer le contenu et la date de la divulgation.

En revanche, il appartiendra, le cas échéant, au breveté de démontrer que ceux qui ont eu connaissance de l'information n'avaient pas les capacités de la comprendre ou étaient liés par une obligation de confidentialité.

Pour ce qui concerne les moyens de preuve, les tribunaux français privilégient les preuves écrites, mais ils admettent également les témoignages, sous forme d'attestations écrites, et les faisceaux d'indices.

En pratique, les tribunaux français sont très exigeants en matière de preuve d'une divulgation et ils n'admettront de prendre en compte une antériorité comme destructrice de nouveauté ou d'activité inventive que s'ils ont une quasi-certitude quant à son contenu, sa date et son accessibilité.

Les règles appliquées par l'OEB en la matière sont très similaires, avec une importance plus grande accordée aux témoignages.

3.5.2 Ces règles sont transposables sans difficulté aux divulgations réalisées sur les nouveaux médias, à condition de prendre correctement en compte leur spécificité.

Cela signifie que pour chaque divulgation de ce type, il faudra rechercher soigneusement si les faits invoqués sont établis de manière certaine, en tenant compte des particularités techniques qu'ils impliquent.

A titre d'exemple, il est clair qu'une simple impression d'écran, même datée, n'est en aucune manière une preuve de la date et du contenu d'une divulgation, alors même qu'une telle copie se présente sous la forme d'un écrit.

Mais les particularités techniques relatives aux divulgations réalisées sur les nouveaux moyens de communication ne requièrent nullement une modification des règles de preuve appliquées aux divulgations classiques.

Notamment, les règles actuellement appliquées relatives à la charge de la preuve et au niveau d'exigence permettent de résoudre les problèmes spécifiques liés aux particularités techniques de ces nouveaux moyens.

Conclusion

1. Le Groupe Français a exposé les règles de fond et les règles de preuve qui sont actuellement appliquées aux divulgations par les tribunaux français, et les règles très similaires qui sont appliquées par l'Office Européen des Brevets, dans le cadre de la Convention de Munich.

Ces règles reposent sur un certain nombre de principes que l'on peut résumer de la manière suivante:

- toute information communiquée **en tout lieu et à toute époque** est une divulgation susceptible de détruire la nouveauté ou l'activité inventive ;
- l'accessibilité **théorique** suffit pour que la divulgation soit réalisée ;
- seule est admise une divulgation établie de manière **certaine** quant à sa date et sa consistance.

2. Ces règles réalisent un équilibre raisonnable entre les intérêts du breveté et ceux des tiers, puisqu'elles sont favorables au breveté sur le plan de la preuve de la divulgation, dont la charge repose essentiellement sur les tiers, et elles sont plutôt favorables aux tiers pour ce qui concerne le lieu, la date et l'accessibilité de la divulgation.

De plus, ces règles ont le mérite de la simplicité, et le contentieux qu'elles suscitent, relativement peu abondant, ne soulève pas de problèmes majeurs.

Il en est notamment ainsi de "*l'accessibilité théorique*", dont la preuve soulève évidemment beaucoup moins de difficultés que celle de l'accessibilité effective.

3. Du fait même de leur simplicité, les règles actuellement appliquées aux divulgations classiques peuvent s'appliquer sans difficulté, et de manière satisfaisante, aux nouveaux moyens de communication.

Il en est ainsi pour les règles de preuve (voir ci-dessus), mais il en est ainsi également pour les règles de fond.

En particulier, la règle selon laquelle la divulgation peut être réalisée en tout lieu et à toute époque évite un grand nombre de problèmes particulièrement difficiles à résoudre dans le cas d'informations diffusées sur un réseau électronique.

Il en est de même de la règle de l'accessibilité théorique dont la mise en œuvre, eu égard à l'information diffusée sur un réseau, est beaucoup plus facile que ne le serait la mise en œuvre d'un système fondé sur l'accès effectif.

4. Pour toutes ces raisons, le Groupe Français estime que les règles actuellement appliquées en France et à l'OEB sont satisfaisantes, et qu'elles peuvent permettre de résoudre sans modifications, les problèmes spécifiques visés par les nouveaux moyens de communication.
5. Le Groupe Français estime également que les principes généraux sur lesquels ces règles reposent pourraient servir de lignes directrices dans l'optique d'une harmonisation.

Résumé

1. Détermination de "*l'art antérieur*"

Selon le droit français et la Convention de Munich, pour qu'une invention soit considérée comme nouvelle, elle ne doit pas être comprise dans l'état de la technique, l'état de la technique étant l'ensemble des informations techniques considérées comme divulguées à une date donnée.

Une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d'une manière évidente de l'état de la technique. L'invention dépourvue de nouveauté ou d'activité inventive n'est pas brevetable.

En ce qui concerne les brevets français, les tribunaux n'appliquent aucune directive. Ils appliquent la loi, telle qu'elle est interprétée par la jurisprudence.

Pour les brevets européens, l'OEB dispose de directives d'examen. Les tribunaux français, lorsqu'ils ont à connaître de la validité des brevets européens désignant la France, appliquent les mêmes règles que pour les brevets français.

2. Critères pour la divulgation

2.1 Moyens de divulgation

La loi française et la Convention de Munich n'excluent aucun moyen de divulgation puisqu'au contraire, les deux textes prévoient que la divulgation peut être opérée par tout moyen.

Chaque moyen de divulgation peut poser des problèmes particuliers sur le plan de la preuve, mais dès lors que la divulgation est établie, elle a les mêmes effets, quel que soit le moyen par lequel elle a été réalisée.

2.2 *Date et lieu de divulgation*

La loi française et la Convention de Munich ne font aucune distinction entre les divulgations récentes et les divulgations anciennes.

Elles ne font aucune distinction relativement au lieu de la divulgation.

2.3 *Éléments personnels*

Selon la loi française et la Convention de Munich, la divulgation n'est pas prise en considération si elle a été réalisée par l'inventeur ou son prédécesseur en droit, moins de 6 mois avant la date du dépôt du brevet, par une présentation dans une exposition officielle ou officiellement reconnue.

La divulgation n'est pas prise en compte si elle a été réalisée par un tiers dans les 6 mois précédant la date du dépôt de la demande de brevet, dans le cadre d'un abus évident à l'égard de l'inventeur ou de son prédécesseur en droit.

La communication de l'invention par une personne liée au secret est une divulgation. Cette divulgation peut être considérée comme inopposable si elle a été réalisée moins de 6 mois avant le dépôt du brevet.

Si cette condition de délai n'est pas remplie, l'invention est considérée comme divulguée, l'inventeur disposant éventuellement d'une action en dommages et intérêts à l'encontre de l'auteur de la divulgation.

Il n'existe pas, à la connaissance du Groupe Français, de jurisprudence française relative aux erreurs dans les informations divulguées.

En revanche, l'OEB, dans le cadre de la délivrance des brevets européens, considère généralement qu'une information erronée ne fait pas partie de l'état de la technique, lorsqu'il apparaît évident pour l'homme du métier qu'il s'agit d'une erreur.

2.4 *Bénéficiaire de l'information*

L'information n'est considérée comme divulguée, tant en droit français que dans le cadre de la Convention de Munich, que si la divulgation est suffisamment explicite pour qu'un homme du métier puisse la mettre en œuvre. La divulgation est réalisée même s'il est nécessaire de procéder à des analyses et à une procédure de « *reverse engineering* » pour avoir connaissance des informations divulguées.

D'une manière générale, les tribunaux français et l'OEB appliquent une conception d'accessibilité théorique, et donc considèrent une information comme divulguée lorsqu'elle a été rendue accessible au public, sans qu'il soit nécessaire de démontrer que le public y a eu effectivement accès.

En droit français, comme dans le cadre de la Convention de Munich, la communication d'une information à une personne tenue à une obligation de confidentialité n'est pas une divulgation.

3. Divulgarion par les nouveaux médias

Le Groupe Français n'a pas connaissance de jurisprudence française relative aux questions de divulgation par les nouveaux médias. Il n'a pas non plus connaissance de décisions de l'OEB relatives à ces questions ou de directives particulières.

3.1 Règles générales

Comme les textes français et européens prennent en considération tous moyens de divulgation, y compris une divulgation orale, il est clair qu'une diffusion sans support papier dans un réseau électronique constitue en principe une divulgation ayant les mêmes effets qu'une divulgation par un moyen classique, sans exigence particulière.

Une distinction entre les différentes formes de réseaux serait sans doute opérée relativement au problème de l'accessibilité comme par exemple le courrier électronique ou les sites web.

3.2 Problèmes de confidentialité

Pour les informations communiquées de manière cryptée auxquelles seul le destinataire peut accéder, ou nécessitant la détention d'un mot de passe, elle seront considérées comme divulguées ou non selon les obligations éventuelles de confidentialité du destinataire.

Si un tiers accède à une information qui ne lui est pas destinée, cryptée ou non, ou dont l'accès nécessite un mot de passe, et la divulgue, la règle classique relative à la divulgation abusive pourra éventuellement s'appliquer.

Selon le principe de l'accessibilité théorique, il est clair qu'une information accessible sur un réseau, avec ou sans moteur de recherche, sera considérée comme divulguée, même si en fait personne n'y a eu accès. Il suffira que l'accès ait été théoriquement possible, pour que la divulgation soit considérée comme réalisée.

3.3 Lieu et date de la divulgation

La question du lieu de la divulgation d'une information communiquée sur un réseau ne se posera jamais en France, puisqu'il n'est fait aucune différence selon le lieu de la communication.

Conformément à l'accessibilité théorique, la durée de la communication sur le réseau n'aura aucune importance.

3.4 Problèmes de preuve

Les questions relatives à la divulgation étant des questions de fait, les tribunaux français appliquent les règles relatives à la preuve des faits, qui reposent sur deux principes: la charge de la preuve d'un fait repose sur celui qui l'invoque, et la preuve d'un fait peut être rapportée par tous moyens.

Ces règles sont transposables sans difficulté aux divulgations réalisées sur les nouveaux médias, à condition de prendre correctement en compte leur spécificité. Il faudra donc rechercher soigneusement si les faits invoqués sont établis de manière certaine, en tenant compte des particularités techniques qu'ils impliquent.

Conclusion

Le Groupe français est d'avis que les règles actuellement appliquées en France et devant l'OEB sont satisfaisantes et peuvent être transférées sans difficulté aux nouveaux moyens de communication.

Il en est ainsi tant pour les règles de preuve que pour les règles de fond.

En particulier, la règle selon laquelle la divulgation est réalisée en tout lieu et à toute époque, et la règle de l'accessibilité théorique, évitant un grand nombre de problèmes difficiles à résoudre dans le cas d'informations diffusées sur un réseau électronique.

Summary

1. Determination of prior art

According to French and European law, for an invention to be considered new, it must not be included in the state of the art (every technical information considered to be disclosed at a certain date).

An invention is considered as involving an inventive step if, for a person skilled in the art, it is not obvious from the state of the art. An invention deprived of novelty or inventive step cannot be patented.

Concerning French patent, courts do not apply any guidelines. They apply the law, as interpreted by case law.

For European patents, the EPO does have guidelines. French courts, when they determining the validity of European patents designating France, apply the same rules as for French patents.

2. Criteria for disclosure

2.1 Means of disclosure

French law and the Munich Convention do not exclude any means of disclosure, since on the contrary, both texts provide that disclosure made in any way.

Each mean of disclosure may cause specific problems with regard to evidence, but as soon as disclosure has been established, it has the same effect, whatever mean by which it was made.

2.2 Time and place of disclosure

French law and the Munich Convention do not make any distinction between recent and old disclosure.

They do not distinguish between places of disclosure.

2.3 Personal elements

According to French and the Munich Convention, disclosure is not taken into consideration if it was made by the applicant or legal predecessor, less than 6 months before the filing of the patent application, by displaying it at an official or officially recognized at an international exhibition.

The disclosure is not taken into account if it was made by a third party within 6 months preceding the patent filing date, as an evident abuse in relation to the applicant or his legal predecessor.

The communication of the invention by a person bound to secrecy is a disclosure. The state of the art may not be affected if the disclosure was made less than 6 months prior to the filing of the patent.

If this time period is not met, the invention is considered to have been disclosed, with the applicant eventually being able to sue the author of the disclosure for damages.

To the knowledge of the French Group, there is not any case law regarding errors in disclosed information.

However, the EPO, when granting European patents, does not consider that incorrect information is part of the state of the art, when it seems obvious to a person skilled in the art, that it is an error.

2.4 *Recipient of the information*

The information is considered disclosed, in French law as well as the Munich Convention, only if the disclosure is sufficiently explicit so that a person skilled in the art could implement it. The disclosure is made even if it is necessary to analyze it and to do “reverse engineering” to gain knowledge of the disclosed information.

Generally, French courts and the EPO apply a theoretical accessibility conception, and thus consider that an information has been disclosed when it is accessible to the public without having to prove that the public actually accessed it.

In French law, as well as in the Munich Convention, communication of information to a person bound by confidentiality is not a disclosure, though French case law accepts in a liberal manner the obligation of confidentiality.

3. **Disclosure through new media**

The French Group does not have any knowledge of French case law regarding questions of disclosure through new media. It also has no knowledge of decisions made by the OPE regarding these questions or specific guidelines.

3.1 *General rules*

As French and European texts take into consideration any means of disclosure, including oral disclosure, it seems clear that broadcast on an electronic network should create a disclosure with the same effects as disclosure through typical means, without particular requirements.

One distinction between the different kinds of networks would have to do with the issue of accessibility, such as electronic mail or web sites.

3.2 *Questions of confidentiality*

For information communicated through means of encryption or with a password, it should be considered as disclosed or not depending on potential obligations of confidentiality of the person it is addressed to.

If a third party accesses information not addressed to him, encrypted or not, or whose access necessitates a password, and discloses it, the classical rule regarding abusive disclosure may eventually apply.

Regarding theoretical accessibility, it is clear that information that is accessible on a network, with or without a search engine, shall be considered disclosed, even if in fact no one had accessed it. It is sufficient that access was theoretically possible, for the disclosure to be considered made.

3.3 *Place and timing of disclosure*

The place of disclosure of information communicated on a network will never be an issue in France, because it makes no difference where the communication took place.

In accordance with theoretical accessibility, the timing of the communication is not important.

3.4 *Questions of evidence*

Questions regarding disclosure being questions of fact, French courts apply rules of evidence, which rest on two principles: the burden of proof rests on who invokes it, and proof of a fact may be established through any means.

These rules may be transposed without difficulty to disclosures through new media, so long as their specificity is correctly taken into account. It will be necessary to carefully examine if the facts have been established with certainty, by taking into account the technical specifications involved.

Conclusion

The French group believes that the rules being applied in France and before the EPO are satisfactory and may be transferred without problem to new means of communication.

This applies to rules of evidence as well as rules of content.

Especially the rule according to which disclosure may be done in any place and at any time, and the rule of theoretical accessibility, avoiding numerous problems that would have to be resolved should information be broadcast on electronic networks.

Bericht Q167

im Namen der Deutschen Landesgruppe
von Martin FÄHNDRICH¹ und Stephan FREISCHEM²

Gegenwärtige Standards für Offenbarungen im Stand der Technik bei der Beurteilung der Voraussetzungen der Neuheit und der Erfindungshöhe

Einleitung

In Deutschland werden technische Schutzrechte zur Zeit nach drei verschiedenen gesetzlichen Regelungen auf Neuheit und Erfindungshöhe geprüft. Zum einen prüft das Europäische Patentamt europäische Patentanmeldungen, deren geographischer Schutzbereich Deutschland umfassen kann, auf Neuheit und Erfindungshöhe nach den Regeln des Europäischen Patentübereinkommens (EPÜ). Zum anderen prüft das Deutsche Patent- und Markenamt nationale Patentanmeldungen auf Neuheit und Erfindungshöhe nach den Regeln des deutschen Patentgesetzes (PatG). Schließlich werden deutsche Gebrauchsmuster nach den Regeln des deutschen Gebrauchsmustergesetzes (GebrMG) hinsichtlich ihrer Neuheit und Erfindungshöhe beurteilt.

Das deutsche Patentgesetz und das Europäische Patentübereinkommen sind vom Gesetzeswortlaut weitgehend aneinander angeglichen. Es verbleiben jedoch Abweichungen in der Rechtsprechung der deutschen und der europäischen Behörden. Das Gebrauchsmustergesetz stimmt in vielen Punkten mit dem deutschen Patentgesetz überein, weicht in einigen Punkten in Bezug auf den Stand der Technik jedoch bewusst von den Patentgesetzen ab.

Dieser Bericht folgt der Reihenfolge der Fragen in den Arbeitsrichtlinien für die Landesgruppenberichte. Fragen dieser Richtlinien sind als Überschriften angeführt. Abschnitte des vorliegenden Berichts, die sich auf das deutsche Patentgesetz beziehen sind mit "PatG" gekennzeichnet. Abschnitte des vorliegenden Berichts, die sich auf das europäische Patentübereinkommen beziehen sind mit "EPÜ" gekennzeichnet. Abschnitte, die sich auf das Gebrauchsmustergesetz beziehen sind mit "GebrMG" gekennzeichnet. Abschnitte ohne besondere Kennzeichnung beziehen sich auf alle drei Schutzrechtsarten.

1. Bestimmung des Standes der Technik

1.1 *Welchen Effekt hat die Veröffentlichung eines Standes der Technik auf Neuheit und Erfindungshöhe?*

EPÜ, PatG und GebrMG

Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört.³ Folglich führt eine Veröffentlichung aus dem Stand der Technik, der sämtliche Merkmale einer Erfindung zu entnehmen sind, dazu, dass die Schutzvoraussetzung der Neuheit nicht gegeben ist.

EPÜ und PatG

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit (inventive step) beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt.⁴

¹ Dr., Rechtsanwalt in Düsseldorf

² Dipl.-Ing., Patentanwalt in Köln

³ EPÜ Art. 54 (1); PatG § 3 (1), Satz 1, GebrMG § 3 (1)

⁴ EPÜ Art. 56; PatG § 4

Folglich fehlt die Patentierungsvoraussetzung der erfinderischen Tätigkeit, wenn ein öffentlich zugänglicher Stand der Technik existiert, aus dem sich sämtliche Merkmale einer Erfindung in naheliegender Weise ergeben.

GebrMG

Nach §1 des GebrMG werden als Gebrauchsmuster Erfindungen geschützt, die neu sind, auf einem erfinderischen Schritt beruhen und gewerblich anwendbar sind. Somit ist der erfinderische Schritt eine Voraussetzung für die Schutzfähigkeit des Gebrauchsmusters.

Dabei ist für den Gebrauchsmusterschutz nur ein geringeres Maß an erfinderischer Leistung verlangt als für den Patentschutz⁵. Der Begriff des erfinderischen Schrittes aus dem Gebrauchsmustergesetz ist nicht mit dem Begriff "inventive step" aus dem Europäischen Patentübereinkommen in englischer Sprache gleichzusetzen.

1.1.1 Gibt es Unterschiede zwischen dem Stand der Technik in bezug auf Neuheit einerseits und Erfindungshöhe andererseits?

PatG und EPÜ

Grundsätzlich umfasst der Stand der Technik alle Kenntnisse, die vor dem für den Zeitrang der Anmeldung maßgeblichen Tag durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise der Öffentlichkeit zugänglich gemacht worden sind.⁶

Als Stand der Technik gilt auch der Inhalt bestimmter Patentanmeldungen mit älterem Zeitrang in der ursprünglich eingereichten Fassung, die erst an oder nach dem für den Zeitrang der jüngeren Anmeldung maßgeblichen Tag veröffentlicht worden sind.⁷ Dieser nachveröffentlichte Stand der Technik wurde aufgrund des Verbots der Doppelpatentierung eingeführt.

Der nachveröffentlichte Stand der Technik umfasst bei Europäischen Patentanmeldungen:

- europäische Patentanmeldungen, in Bezug auf die Vertragsstaaten, für die die Benennungsgebühren wirksam entrichtet werden⁸;
- internationale Patentanmeldungen nach dem Patentrechtsabkommen, für die das Europäische Patentamt Bestimmungsamt ist, die dem Europäischen Patentamt in einer seiner Amtssprachen zugeleitet wird und für die der Anmelder die regionale Anmeldegebühr gezahlt hat, in Bezug auf die Vertragsstaaten, für die in der europäischen regionalen Phase die Benennungsgebühren wirksam entrichtet werden;⁹
- Deutsche Patentanmeldungen, wobei diese nicht im Prüfungsverfahren vor dem Europäischen Patentamt, aber in einem Nichtigkeitsverfahren vor dem Bundespatentgericht berücksichtigt werden können¹⁰

Der nachveröffentlichte Stand der Technik umfasst bei nationalen deutschen Patentanmeldungen:

- nationale deutsche Patentanmeldungen;
- Europäische Patentanmeldungen, sofern Deutschland bei deren Veröffentlichung benannt ist;

⁵ Bühring, Gebrauchsmustergesetz, 5. Auflage, § 3, Rdn. 43; Benkard, Patentgesetz, 9. Auflage, § 1 GebrMG, Rdn. 25

⁶ EPÜ Art. 54 (2) i.V.m Art. 89; PatG § 3 (1), Satz 2

⁷ EPÜ Art. 54 (3) i.V.m Art. 89 und Art. 158; PatG § 3 (2)

⁸ EPÜ Art. 54 (3) i.V.m R. 23a

⁹ EPÜ Art. 158 (1) und (2) i.v.m Art. 54 (3)

¹⁰ EPÜ Art. 139 Abs 2 EPÜ i.V.m Patg § 3 (2) Nr. 1 und Art. 54 (3)

- Internationale Patentanmeldungen nach dem Patentreuearbeitsvertrag, wenn das Deutsche Patent- und Markenamt Bestimmungsamt ist;

Wird der Zeitrang des nachveröffentlichten Standes der Technik durch einen Prioritätsanspruch vor den Anmeldetag der jüngeren Anmeldung verschoben, gilt ihr Inhalt nur in dem Umfang als Stand der Technik, in dem er nicht über die Fassung der Voranmeldung hinausgeht.

Gehören zum Stand der Technik auch nachveröffentlichten Unterlagen, so werden diese bei der Beurteilung der erfinderischen Tätigkeit nicht in Betracht gezogen.¹¹

GebrMG

Der Stand der Technik in bezug auf die Neuheit stimmt mit dem Stand der Technik in bezug auf die Erfindungshöhe überein.

1.1.2 Beeinflussen abhängige Anmeldungen, die noch nicht veröffentlicht sind, die Beurteilung von Neuheit und Erfindungshöhe?

PatG und EPÜ

Gemäß den vorangehenden Ausführungen werden abhängige, unveröffentlichte Patentanmeldungen in gesetzlich definiertem Umfang als Stand der Technik bei der Beurteilung der Neuheit berücksichtigt. Bei der Beurteilung der Erfindungshöhe werden sie nicht in Betracht gezogen.

GebrMG

Anhängige Anmeldungen, die noch nicht veröffentlicht sind, werden nicht bei der Beurteilung von Neuheit und Erfindungshöhe eines Gebrauchsmusters als Stand der Technik berücksichtigt. Ist der Gegenstand eines Gebrauchsmusters bereits auf Grund einer früheren Patent- oder Gebrauchsmusteranmeldung geschützt, wird der Gebrauchsmusterschutz nicht begründet und es besteht ein Lösungsanspruch gegen das jüngere Gebrauchsmuster¹².

1.2 Enthalten die nationalen Rechte Definitionen oder Hinweise darauf, worin eine Offenbarung des Standes der Technik besteht?

PatG und EPÜ

Der Stand der Technik umfasst alle Kenntnisse, die durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise der Öffentlichkeit zugänglich gemacht worden ist.¹³

Als Stand der Technik gilt auch der Inhalt bestimmter Patentanmeldungen in der ursprünglich eingereichten Fassung, deren Zeitrang vor dem Zeitrang der zu beurteilenden Anmeldung liegt und die erst an oder nach diesem Tag veröffentlicht worden sind.¹⁴

Eine Offenbarung der Erfindung bleibt bei der Beurteilung der Neuheit außer Betracht, wenn sie nicht früher als 6 Monate vor der Einreichung der Anmeldung erfolgt ist und

- a) unmittelbar oder mittelbar auf einen offensichtlichen Missbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers zurückgeht oder
- b) unmittelbar oder mittelbar auf die Tatsache zurückgeht, dass der Anmelder oder sein Rechtsvorgänger die Erfindung auf amtlichen oder amtlich anerkannten Ausstellungen im Sinne des am 22. November 1928 in Paris unterzeichneten

¹¹ EPÜ Art. 56 Satz 2; PatG § 4 Satz 2

¹² GebrMG §§ 13 Abs. 1 i.V.m 15 Abs. 2 Nr. 2

¹³ EPÜ Art. 54 (2) i.V.m Art. 89; PatG § 3 (1), Satz 2

¹⁴ EPÜ Art. 54 (3); PatG § 3 (2)

Abkommens über internationale Ausstellungen zur Schau gestellt hat und der Anmelder darauf hinweist und dies durch eine Bescheinigung belegt.¹⁵

GebrMG

Der Stand der Technik umfasst alle Kenntnisse, die vor dem für den Zeitrang der Anmeldung maßgeblichen Tag durch schriftliche Beschreibung oder durch eine im Geltungsbereich des Gebrauchsmustergesetzes erfolgte Benutzung der Öffentlichkeit zugänglich gemacht worden sind. Eine innerhalb von sechs Monaten vor dem für den Zeitrang der Anmeldung maßgeblichen Tag erfolgte Beschreibung oder Benutzung bleibt außer Betracht, wenn sie auf der Ausarbeitung des Anmelders oder seines Rechtsvorgängers beruht¹⁶.

- 1.3 *Welche Regeln werden angewandt, um zu beurteilen, ob ein bestimmter Stand der Technik offenbart worden ist? (Diese Frage zielt auf Richtlinien, die nicht schon in Gesetzen enthalten sind und die in den einzelnen Ländern zur Beurteilung einer Offenbarung entwickelt wurden.)*

EPÜ

Aufbauend auf den oben erwähnten gesetzlichen Grundlagen enthalten die **Richtlinien für die Prüfung im Europäischen Patentamt**¹⁷ (nachfolgend kurz RiLi) detaillierte Ausführungen über die Voraussetzungen für eine Offenbarung durch den Stand der Technik sowie die Beurteilung der Neuheit und Erfindungshöhe im Lichte dieser Offenbarung. Diese Ausführungen werden fortlaufend unter Berücksichtigungen der Rechtsprechung der Beschwerdekammern des EPA fortlaufend aktualisiert.

RiLi Teil C (Sachprüfung) Kapitel IV Abschnitte 5 bis 9 erläutern detailliert die Offenbarungsvoraussetzungen und Beurteilungsrichtlinien insbesondere für druckschriftlichen Stand der Technik.

RiLi Teil D (Einspruchsverfahren) Kapitel V Abschnitt 3 erläutert detailliert die Offenbarungsvoraussetzungen für nicht-druckschriftlichen Stand der Technik, d.h. Offenbarung durch mündliche Beschreibung, durch Benutzung oder in sonstiger Weise.

Eine Besonderheit des Europäischen Patentrechts ergibt sich aus der Rechtsprechung¹⁸ der Großen Beschwerdekammer des Europäischen Patentamts. Demnach gilt auch eine Veröffentlichung der Anmeldung, deren Priorität beansprucht wird, als bei der Beurteilung der Neuheit und Erfindungshöhe zu berücksichtigender Stand der Technik, wenn der Patentanspruch der späteren europäischen Patentanmeldung gegenüber der Prioritätsanmeldung zusätzliche Merkmale enthält. Das EPA begründet seine Entscheidung damit, dass es sich wegen der zusätzlichen Elemente nicht mehr um dieselbe Erfindung handle und der Prioritätsanspruch daher unwirksam werde. Nach bisheriger Praxis wurde davon ausgegangen, dass in einem solchen Fall den mit der Prioritätsanmeldung übereinstimmenden Merkmalen der Zeitrang der Prioritätsanmeldung und den neuen Merkmalen der Zeitrang der jüngeren Anmeldung zukam.

PatG

Zur Beurteilung der Erfindungshöhe durch die Prüfer des DPMA machen die Prüfungsrichtlinien¹⁹ recht allgemeine Ausführungen. Darüber hinausgehende Einzelfallregelungen werden durch die Rechtsprechung getroffen, welche in den Patent- und Gebrauchsmusterrechts-Kommentaren dokumentiert ist.

¹⁵ EPÜ Art. 55 (1) a); PatG §3 Abs. 4 Nr. 1

¹⁶ GebrMG § 3 (1)

¹⁷ Richtlinien für die Prüfung im Europäischen Patentamt,
http://www.european-patent-office.org/legal/gui_lines/index_d.htm

¹⁸ G3/93, AEPA 1995, S. 18, bestätigt durch G2/98

¹⁹ Prüfungsrichtlinien des DPMA Abschnitt 3.3.2.4.2,
http://www.dpma.de/formulare/p2796_w8.doc

GebrMG

Eine amtliche Prüfung der Neuheit und Erfindungshöhe findet beim Gebrauchsmuster nicht statt²⁰. Folglich existieren auch keine amtlichen Richtlinien für die Prüfung dieser Schutzvoraussetzungen. Die Beurteilung erfolgt in Anlehnung an die aus dem Patentrecht bekannten Regeln unter Berücksichtigung der Rechtsprechung.

2. Kriterien für die Offenbarung

2.1 Wege der Offenbarung

2.1.1 Welches sind anerkannte Wege der Offenbarung?

EPÜ und PatG

Nach dem Gesetz sind alle Wege der Offenbarung anerkannt. Das Gesetz nennt die Offenbarung durch schriftliche und mündliche Beschreibung, durch Benutzung und in sonstiger Weise²¹.

Als Offenbarung durch schriftliche Beschreibung sind anerkannt OS, AS, PS des In- und Auslandes, der Akteneinsicht zugänglicher Inhalt von Patentanmeldungen²², ausgelegte Unterlagen deutscher²³ und ausländischer²⁴ Patentanmeldungen sowie Unterlagen eingetragener Gebrauchsmuster²⁵ gegenüber nach dem 7.8.53 beim DPA eingereichten Anmeldungen, alle Sprachwerke iSd § 2 I Nr. 1 UrhG, Bücher, Zeitschriften, Zeichnungen (auch isoliert und ohne erklärenden Text²⁶), Schaltbilder, Diagramme, Manuskripte, Kataloge, Prospekte, Briefe, Reklame, Hektographien, Fotokopien, Lichtbilder, Lichtpausen, (Mikro)Filme, Filmnegative, Fotos, in einem Prozess eingereichte Schriftsätze²⁷, Firmenschriften²⁸, Werbeprospekte²⁹, Betriebshandbücher (Manuals)³⁰, abstracts³¹.

Mündliche Beschreibungen können sein: Vorträge³², Vorlesungen, Reden, Gespräche oder Erläuterungen z.B. bei Werksbesichtigungen, Führungen, Messen, Radio- und Fernsehsendungen, Werbeveranstaltungen, mündliche Erörterungen eines Problems zwischen beteiligten Firmen.

Als Offenbarung durch Benutzung sind anerkannt die Ausstellung in einem Museum³³, einer Kunstgewerbeschule³⁴, einer Leistungsschau³⁵, einer Messe; Vorführung zu Demonstrationszwecken³⁶, Wiedergabe in einer Fernsehsendung, Feilhalten des Gegenstandes, Anbieten zum Kauf³⁷, auch wenn der Gegenstand noch nicht hergestellt worden ist³⁸, Übersenden von Zeichnungen an zwei verschiedene Empfänger³⁹ sowie bei

20 § 8 (1) GebrMG

21 Art. 54 Abs. 2 EPÜ, § 3 Abs. 1 PatG

22 BGH Schulte-Kartei PatG 4.1 Nr. 71 Warenregal

23 Vgl PA GrSen BI **53**, 336; BGH BI **55**, 300 Zwischenstecker II; **57**, 293 Schleudergardine

24 BGH BI **63**, 244 Trockenschleuder

25 Vgl PA GrSen BI **53**, 336; BGH BI **55**, 300 Zwischenstecker II; **57**, 293 Schleudergardine

26 BPatGE **15**, 12, 14; **14**, 23, 27; **24**, 177; EPOA T 204/83 ABI **85**, 310, Venturi

27 BPatGE **28**, 22 = GRUR **86**, 269

28 BPatGE **30**, 40 = BI **89**, 163; **32**, 109 = BI 91, 349

29 BPatGE **32**, 109 = BI **91**, 349

30 BPatGE **33**, 18 = BI **92**, 431

31 T 77/87 ABI **90**, 280; T 160/92 ABI **95**, 35

32 Vgl BPatGE **16**, 96 = BI **74**, 323

33 BGH BI **56**, 121 Handschuh; **62**, 164 Fischereifahrzeug; **65**, 94 Bierabfüllung; BPatGE **3**, 167, 169, **16**, 96

34 BGH BI **56**, 121 Handschuh; **62**, 164 Fischereifahrzeug; **65**, 94 Bierabfüllung; BPatGE **3**, 167, 169; **16**, 96

35 BGH GRUR **70**, 358, 359 rSp Heißläuferdetektor; BPatGE **3**, 167, 169

36 PatBI **34**, 28

37 BGH BI **62**, 311, 313 ISp Blitzlichtgerät

38 BGH BI **59**, 127 Heißpreßplatte

Verfahren die Lieferung einer Vorrichtung zur Durchführung eines Verfahrens, wenn dieses aus ihr unmittelbar erkennbar ist⁴⁰; der Vertrieb der Erzeugnisse, wenn aus ihnen das bei ihrer Herstellung angewendete Verfahren entnehmbar ist⁴¹; Lichtbildervortrag vor Fachleuten⁴²; mündliche Erörterung anhand von dabei angefertigten Skizzen und Zeichnungen⁴³.

Eine Offenbarung auf sonstige Weise kann erfolgen durch Aufzeichnungen auf Bild- oder Tonträgern (Schallplatte, Tonband, Filme, Videokassette, magnetische Aufzeichnung), Fernsehsendungen, Informationen auf Lochkarten, Festlegungen zur Steuerung von Schreibautomaten oder automatischen Setzmaschinen, Einspeicherung in frei abfragbare Datenanlagen.

- 2.1.2 *Gibt es zusätzliche Erfordernisse für bestimmte Arten der Offenbarung, die mündliche Offenbarung oder die Offenbarung durch Benutzung im Vergleich zur Offenbarung durch schriftliche Dokumente?*

EPÜ und PatG

Zusätzliche Erfordernisse für bestimmte Arten der Offenbarung bestehen nach EPÜ und PatG nicht. Die Offenbarungsmittel sind grundsätzlich gleichwertig⁴⁴.

Für alle Formen der Offenbarung gilt gleichermaßen: Eine technische Lehre ist dann der Öffentlichkeit zugänglich gemacht, wenn eine nicht beschränkte Anzahl von verständigen Personen von ihr Kenntnis erlangen kann. Eine differenzierende Betrachtung ist lediglich bei der Feststellung der tatsächlichen Umstände der jeweiligen Offenbarung geboten.

GebrMG

Nach dem deutschen GebrMG ist der bei der Prüfung auf Neuheit und Erfindungshöhe zu berücksichtigende Stand der Technik eingeschränkt. Zum Stand der Technik zählt nur, was durch schriftliche Beschreibung oder durch eine im Inland erfolgte Benutzung offenbart wird.

- 2.1.3 *Was sind die Gründe, falls bestimmte Wege der Offenbarung durch Gesetz oder Praxis nicht anerkannt werden?*

GebrMG

Dem Gesetzgeber erschien es insbesondere im Hinblick auf die Kurzlebigkeit des Gebrauchsmusters nicht geboten, die mündliche Beschreibung als Stand der Technik einzuführen⁴⁵.

- 2.2 *Zeit der Offenbarung*

- 2.2.1 *Macht es einen Unterschied, ob die Offenbarung erst kürzlich oder vor einer langen Zeit erfolgt ist?*

EPÜ und PatG

Der Zeitpunkt der Kundgebung ist ohne Belang, sofern er vor dem für den Zeitrang der Anmeldung maßgeblichen Tag liegt (vgl. Abschnitt 1.2). Auch ein nur zeitweise zugänglicher Gegenstand gehört ab der ersten Offenbarung für alle Zeit zum Stand der Technik⁴⁶.

GebrMG

39 BGH BI **62**, 164 Fischereifahrzeug

40 BGH BI **65**, 94 Bierabfüllung

41 PA Mitt **38**, 148 u. 173; **64**, 72

42 PA Mitt **37**, 210

43 AA für § 2 PatG 68: BPatG BI **86**, 25

44 BPatGE 15, 12, 15f

45 BT-Ds. 10/3903 S. 20

46 BGHZ 95, 162 - Methylomonas

Für deutsche Gebrauchsmuster bleiben innerhalb von sechs Monaten vor dem für den Zeitrang der Anmeldung maßgeblichen Tag erfolgte Beschreibung oder Benutzung außer Betracht, wenn sie auf der Ausarbeitung des Anmelders oder seines Rechtsvorgängers beruht⁴⁷.

2.2.2 *Gibt es Grenzen, jenseits derer die Veröffentlichung einer Information, ob schon sie eine Offenbarung des Standes der Technik begründen könnte, nicht länger als relevant für die Beurteilung der Neuheit und der Erfindungshöhe angesehen wird?*

Nein. Unabhängig davon, ob eine Veröffentlichung bereits vor sehr langer Zeit erfolgte, ist sie für Neuheit und erfinderische Tätigkeit zu berücksichtigen. Eine lange Zeitspanne zwischen der Veröffentlichung und der nun zu prüfenden Anmeldung kann aber ein Indiz für erfinderische Tätigkeit darstellen.⁴⁸

2.3 *Ort der Offenbarung*

2.3.1 *Ist der Ort der Offenbarung relevant?*

EPÜ und PatG

Der Ort der Offenbarung ist nicht relevant.

GebrMG

Im Hinblick auf deutsche Gebrauchsmuster ist der Ort einer offenkundigen Vorbenutzung relevant. Nur Benutzungen im Inland zählen zum Stand der Technik.

2.3.2 *Wie wird der Ort der Offenbarung bestimmt?*

Unter welchen Voraussetzungen eine Benutzung als im Inland erfolgt anzusehen ist, ist in der Rechtsprechung nicht mit Blick auf die Frage der Zugehörigkeit zum Stand der Technik behandelt worden.

Im Zusammenhang mit der Frage, ob eine Handlung als inländische Benutzung und damit als Patentverletzung gilt, liegt hingegen umfangreiche Rechtsprechung vor. Als Benutzung im Inland wird auch das Anbieten eines patentgeschützten Gegenstandes angesehen. Dabei wird als Inlandshandlung angesehen sowohl das Anbieten eines im Ausland befindlichen Gegenstands vom Inland aus⁴⁹ als auch ein Angebot, bei dem nur der Zugang im Inland stattfindet⁵⁰.

2.3.3 *Macht es einen Unterschied, ob die Offenbarung in einem bestimmten Land zufällig oder gewollt erfolgt ist?*

Es ist allein die objektive Zugänglichkeit maßgeblich. Ob eine Offenbarung zufällig oder gewollt erfolgt, spielt keine Rolle⁵¹. Bei zufälligen Verlautbarungen ist lediglich die Frage des tatsächlichen Inhalts der Offenbarung besonders sorgfältig zu prüfen⁵².

2.3.4 *Welches Recht ist anwendbar, um zu beurteilen, ob eine Offenbarung stattgefunden hat (das Recht des Landes, in dem die Information offenbart wurde, oder das Recht des Landes, in dem Neuheit und Erfindungshöhe zu beurteilen sind)?*

Bei der Beurteilung, ob eine Offenbarung stattgefunden hat, ist das Recht des Landes relevant, in dem die Frage der Neuheit bzw. Erfindungshöhe zu beurteilen ist.

2.4 *Persönliche Elemente*

2.4.1 *Welche Unterschiede stellen die Gruppen im Hinblick auf die Person fest, die den Stand der Technik veröffentlicht?*

⁴⁷ § 3 Abs. 1 Satz 3 GebrMG

⁴⁸ EPA T 271/84 AB 87, 405; BGH-GRUR 1962, 290-Brieftaubenreisekabine

⁴⁹ LG Düsseldorf GRUR 1970, 550, 551

⁵⁰ Benkert/Bruchhausen, 9. Aufl., § 9, Rdn. 11

⁵¹ EPA T 601/92 RBK 1995, 15

⁵² EPA T 208/88 Abl. EPA 1992 = GRUR Int. 1992, 282 Wachstumsregulation

EPÜ und PatG

Auf die Person des Offenbarenden kommt es nicht an, soweit nicht der Ausnahmefall eines offensichtlichen Mißbrauchs vorliegt⁵³. Insbesondere stehen Offenbarungen durch den Anmelder oder seinen Rechtsvorgänger den Offenbarungen Dritter gleich.

GebrMG

Die Neuheitsschonfrist für Veröffentlichungen innerhalb von sechs Monaten vor dem Anmeldetag greift nur dann ein, wenn die Beschreibung oder Benutzung auf der Ausarbeitung des Anmelders oder seines Rechtsvorgängers beruht⁵⁴.

- 2.4.2 *Wird eine Veröffentlichung anders behandelt, wenn die offenbarende Person durch eine Geheimhaltungsabrede gebunden war?*

EPÜ und PatG

Nur für den Ausnahmefall einer auf einen offensichtlichen Missbrauch zum Nachteil des Anmelders zurückgehenden Offenbarung gilt eine Neuheitsschonfrist von sechs Monaten⁵⁵.

Die Rechtsprechung des Bundesgerichtshofes lässt es für die Anerkennung eines offensichtlichen Missbrauchs genügen, wenn die Preisgabe an die Öffentlichkeit oder die Anmeldung zum Patent durch den Dritten objektiv erkennbar rechtswidrig ist⁵⁶.

Das Europäische Patentamt stellt an das Eingreifen dieser Regelung strengere Anforderungen. Eine bloße Fahrlässigkeit oder Verletzung einer Geheimhaltungspflicht genügt nicht, sondern es ist Absicht des Handelnden erforderlich⁵⁷.

- 2.4.3 *Wie werden Irrtümer in der offenbarten Information behandelt?*

Ob eine Offenbarung auf Irrtümern beruht, ist irrelevant. Entscheidend für den Offenbarungsgehalt ist, was der Durchschnittsfachmann einer Veröffentlichung entnimmt. Ist die Lehre nicht verständlich, kann sie nicht zum Stand der Technik zählen⁵⁸.

- 2.5 *Empfänger der Information*

EPÜ, PatG und GebrMG

- 2.5.1 *Welche Erfordernisse gibt es im Hinblick auf die Fähigkeit zum Verständnis der Information?*

Eine technische Lehre ist dann offenbart, wenn dritte Sachverständige die objektive Möglichkeit haben, von der neuheitsschädlichen Tatsache so Kenntnis zu nehmen, dass sie das Wesen der Erfindung erkennen und mit ihrem Fachwissen die technische Lehre ausführen können⁵⁹. Haben nur Personen Zugang, die nicht in der Lage sind, die technischen Zusammenhänge zu erfassen, liegt keine Offenbarung vor⁶⁰.

- 2.5.2 *Reicht die Möglichkeit, dass eine Person Informationen durch zusätzliche Maßnahmen wie etwa Demontage von Vorrichtungen oder reverse engineering erhält, aus, um eine Offenbarung zu begründen?*

Informationen über die Zusammensetzung oder innere Struktur eines Erzeugnisses werden der Öffentlichkeit zugänglich gemacht, wenn der Fachmann unter Verwendung bekannter Analysetechniken unmittelbaren, eindeutigen Zugang zu ihnen hatte. Auf

53 Busse/Keukenschrijver § 3 Rn 84

54 § 3 Abs. 1 Satz 3 GebrMG

55 § 3 Abs. 4 Nr. 1 PatG, Art. 55 Abs. 1 lit. a EPÜ

56 BGH GRUR 1989, 33 - Schlauchfolie

57 EPA T 436/92 RBK 1995, 22

58 BGH GRUR 1995, 330, 331 - Elektrische Steckverbindung

59 BPatGE 34, 38, 40 = GRUR 1994, 107

60 EPA T 877/90 EPOR 1993, 6 - T-cell growth factor

Wahrscheinlichkeit der Analyse und erforderlichen Aufwand kommt es dabei nach der Rechtsprechung des Bundesgerichtshofs nicht an⁶¹. Das Europäische Patentamt sieht die innere Struktur eines Mikrochips als nicht offenbart an, wenn die Ermittlung zwar technisch möglich ist, aber nach der Lebenserfahrung, insbesondere aus Kosten-Nutzen-Erwägungen, nicht erfolgt sein kann⁶².

Fehlt es an einer weitergehenden Untersuchungsmöglichkeit, etwa bei Ausstellungsstücken, ist nur das offenkundig, was ohne die weitergehende Untersuchung erkennbar ist⁶³.

2.5.3 Gibt es allgemeine Regeln im Hinblick auf Vertraulichkeit oder stillschweigend vereinbarte Vertraulichkeit?

Eine relevante Offenbarung ist nicht gegeben, wenn nur ein nach Zweckbestimmung eingegrenzter Personenkreis Zugang zu einer technischen Lehre erhält⁶⁴.

Ohne Geheimhaltungspflicht ist idR davon auszugehen, dass der Berechtigte durch ein Angebot oder eine Lieferung die Kenntnis von der Erfindung der Öffentlichkeit preisgibt und die jedenfalls nicht fernliegende Möglichkeit eröffnet, dass jeder beliebige Dritte von ihr Kenntnis nehmen kann⁶⁵. Offenkundigkeit scheidet ferner aus, wenn zwar keine Geheimhaltungspflicht begründet wurde, aber nach der Lebenserfahrung zu erwarten war, dass der nicht zur Geheimhaltung verpflichtete Dritte trotzdem, z.B. wegen eines eigenen geschäftlichen Geheimhaltungsinteresses, die Benutzungshandlung tatsächlich geheimhalten werde⁶⁶.

Eine Geheimhaltungsverpflichtung kann auch konkludent begründet werden⁶⁷.

3. Offenbarung durch neue Medien

3.1 Allgemeine Regeln

3.1.1 Bewirkt eine papierlose Information, z.B. in einem elektronischen Netzwerk oder über das Internet, eine ausreichende Offenbarung, um Neuheit oder Erfindungshöhe zu beeinflussen?

PatG und EPÜ

Eine papierlose Information ist im Hinblick auf Patente (PatG und EPÜ) eine ausreichende Offenbarung. Zum Stand der Technik gehören auch Offenbarungen "auf sonstige Weise". Jedenfalls darunter fallen auch papierlose Offenbarungen. Dementsprechend werden Veröffentlichungen im Internet oder in Online Datenbanken bei der Beurteilung der Neuheit und der Erfindungshöhe grundsätzlich berücksichtigt, wie die Prüfer und Richter an den für Deutschland zuständigen Behörden und Gerichten (EPA, DPMA und BPatG) bestätigt haben.

GebraMG

Im Hinblick auf Gebrauchsmuster umfasst der Stand der Technik nur schriftliche Beschreibungen und Benutzungen im Inland. Sonstige Offenbarungen werden nicht berücksichtigt. Daher ist die Frage relevant, ob eine "papierlose Information" als schriftliche Beschreibung, Benutzung oder als Offenbarung auf sonstige Weise anzusehen ist. In der Vergangenheit wurde die Einspeicherung in frei abfragbare Datenanlagen als Veröffentlichung auf sonstige Weise angesehen. Diese Rechtsprechung bezog sich nicht

⁶¹ EPA T 952/92 AbI EPA 1995, 755 - Vorbenutzung

⁶² EPA T 461/88 ABI EPA 1993, 295 = GRUR Int 1993, 689 - Mikrochip

⁶³ BGH GRUR 1998, 382, 386 - Schere

⁶⁴ EPA T 300/86 RBK 1989, 25 - TV receiver

⁶⁵ BGH GRUR 1996, 747 - Lichtbogen-Plasma-Beschichtungssystem

⁶⁶ BGH GRUR 1966, 484 - Pfennigabsatz; BPatG Mitt. 1988, 207, 210 - Weitergabe zur klinischen Erprobung

⁶⁷ BGHZ 136, 40 = GRUR 1997, 892, 894 - Leiterplattennutzen; EPA T 1085/92 - elektrische Maschine mit kleiner Leistung

auf Veröffentlichungen im Internet. Die Frage, ob eine Internetveröffentlichung eine schriftliche Beschreibung, eine Benutzungshandlung oder eine sonstige Veröffentlichung ist, ist bislang nicht entschieden worden.

3.1.2 *Gibt es im Vergleich mit anderen Arten der Offenbarung spezifische Erfordernisse?*

Spezifische Erfordernisse für ONLINE-Veröffentlichungen sind nicht bekannt. Es werden die allgemeinen Kriterien angewandt, das heißt, zum maßgeblichen Zeitpunkt müssen Mitglieder der Öffentlichkeit von den Informationen Kenntnis erhalten können, die nicht zur Geheimhaltung verpflichtet waren und deshalb diese Kenntnis frei verwerten oder verbreiten können.

3.1.3 *Bestehen Unterschiede im Hinblick auf verschiedene Formen der Netzwerke oder der Kommunikation, wie etwa das World-Wide-Web, Chat-Groups, Forums, E-Mail oder andere?*

Die Unterschiede zwischen den verschiedenen Kommunikationsformen wie WWW, Chat-Groups, Forums, E-Mails etc. ergeben sich in Abwesenheit besonderer Regelungen aus den allgemeinen Kriterien. Private Dialoge (wie z.B. private e-mails) gelten demnach nicht als Offenbarung gegenüber Dritten. Dabei dürfte allein die technische Möglichkeit für die Mitarbeiter eines e-mail-Providers, e-mails in dem System des Providers zu betrachten, nicht ausreichen, um deren Inhalt öffentlich zugänglich zu machen. Grundsätzlich dürften - wie bei herkömmlichen Kommunikationsformen auch - nur die Kommunikationsformen als öffentlich gelten, bei denen der Mitteilende die Informationen der Öffentlichkeit, also solchen Personen zugänglich macht, die keine Veranlassung dazu haben, die Information vertraulich zu behandeln. Die theoretische Möglichkeit, unter Bruch der Vertraulichkeit (ähnlich Bruch des Post- oder Telefongeheimnisses) Wissen über eine Information zu erlangen und nach außen zu tragen, macht diese Information nicht öffentlich.

3.2 *Fragen der Vertraulichkeit*

3.2.1 *Macht es einen Unterschied, wenn die Information verschlüsselt ist? Welche Relevanz besitzen Passwörter, Suchmaschinen und die Gebührenpflichtigkeit von Informationen?*

Auch diese Frage ist in Abwesenheit besonderer Regelungen nach den allgemeinen Kriterien für den Stand der Technik zu beurteilen. Dabei dürfte eine private Sender/Empfänger-Kommunikation über das Internet (e-mail) grundsätzlich gegenüber Dritten nicht öffentlich sein.

Eine passwortgeschützte oder verschlüsselte Information dürfte nicht öffentlich zugänglich sein, sofern das Passwort nur einem begrenzten und zur Vertraulichkeit verpflichteten Personenkreis zugänglich ist. Dies gilt auch, wenn die Information unter einer URL über das Internet abrufbar ist.

Gebührenpflicht dürfte nach den allgemeinen Kriterien keine Rolle spielen, da es auch außerhalb des Internet irrelevant ist, ob eine Information kostenlos zugänglich war oder ob der Erwerb von Informationsmitteln (z.B. Fachbuch oder Fachzeitschrift) zur Erlangung der Information erforderlich ist.

Die Aufnahme eines Internet-Dokuments in eine Suchmaschine ist ein wesentliches Indiz für die Offenkundigkeit des Dokuments. Die Aufnahme eines Dokuments in eine Suchmaschine ist aber keine unbedingte Voraussetzung für seine Offenkundigkeit. Der Inhalt vielgelesener Internet-Homepages (z.B. von Tageszeitungen, Radio- und Fernsehsendern wie WWW.CNN.COM oder Internet-Anbietern wie WWW.AOL.COM) ist oft nur kurze Zeit (wenige Stunden) online, so dass er nicht in eine Suchmaschine aufgenommen wird. Gleichwohl wird er von vielen Personen gelesen, so dass seine Offenkundigkeit unzweifelhaft ist.

3.3 *Ort der Offenbarung*

3.3.1 *Welches ist der Ort der Offenbarung, wenn eine Information in das Internet eingestellt wird?*

EPÜ und PatG

Gemäß dem EPÜ und dem PatG ist der Ort der Offenbarung unerheblich. Die Frage des Ortes einer Offenbarung wird daher im deutschen und europäischen Patentrecht nicht gestellt werden.

GebraMG

Der Stand der Technik umfasst nach dem Gebrauchsmusterrecht alle Kenntnisse, die ortsunabhängig durch schriftliche Beschreibung oder durch eine im Geltungsbereich des Gebrauchsmustergesetzes erfolgte Benutzung der Öffentlichkeit zugänglich gemacht worden sind. Falls die Rechtsprechung über das Internet verbreitete Informationen einer schriftlichen Beschreibung gleichstellt, ist die Frage des Ortes der Offenbarung unerheblich. Nur bei einer Offenbarung durch Benutzung kommt es auf den Ort der Offenbarung an. Eine Benutzung unter Einstellen von Informationen in das Internet kann vorliegen, wenn ein Gegenstand im Internet angeboten wird. Ein Anbieten vom Ausland ins Inland ist im Zusammenhang mit der Frage der Patentverletzung als eine Patentbenutzung im Inland angesehen worden. Ein solches Anbieten wird von den deutschen Gerichten auch dann als relevant angesehen, wenn der Server, in den die Informationen eingestellt werden, im Ausland steht.

3.4 Zeitpunkt der Offenbarung

3.4.1 Gibt es bestimmte Erfordernisse für den Zeitpunkt und die Dauerhaftigkeit der Information, die durch elektronische Mittel verfügbar ist?

Da es - mit Ausnahme der Vorrangigkeit (vor dem Zeitrang der Anmeldung) - keine allgemeinen Anforderungen an den Zeitpunkt und die Dauerhaftigkeit der den Stand der Technik bildenden Informationen gibt, sind solche auch nicht in bezug auf Internetpublikationen zu erkennen. Es gelten die in Abschnitt 2.2 beschriebenen Regeln.

3.4.2 Sind Archive notwendig oder wünschenswert?

Archive sind selbstverständlich wünschenswert, um die Beweisführung über die Frage, ob eine bestimmte Information vorveröffentlicht ist, zu ermöglichen oder zu erleichtern. Zur Erhöhung der Dauerhaftigkeit einer Information ist ein Archiv nicht erforderlich. Es ist zu erwarten, dass Archive nur aufgrund privater Initiative einzelner Internet-Anbieter erstellt werden und die Mehrzahl der Informationen nicht archiviert wird.

3.5 Fragen der Beweisführung

3.5.1 Wer sollte die Beweislast dafür tragen, dass eine bestimmte Information über das Internet offenbart wurde?

In den einseitigen Prüfungsverfahren vor dem Deutschen Patent- und Markenamt und vor dem Europäischen Patentamt gilt der Amtsermittlungsgrundsatz. Das prüfende Amt muss nach diesem Grundsatz den entgegenstehenden Stand der Technik ermitteln und im Zweifel den Beweis erbringen, dass dieser vor dem relevanten Zeitpunkt veröffentlicht wurde.

In den zweiseitigen Verfahren (Einspruchsverfahren, Nichtigkeitsverfahren) vor dem Deutschen Patent- und Markenamt und vor dem Europäischen Patentamt gilt darüber hinaus der Beibringungsgrundsatz. Demnach trägt die den Widerruf des Schutzrechts beantragende Partei die Beweislast für die tatsächlichen Voraussetzungen der ihr günstigen Rechtsnorm. Der Einsprechende/Nichtigkeitskläger muß somit im Zweifel den Beweis erbringen, daß ein bestimmter Stand der Technik vor dem relevanten Zeitpunkt veröffentlicht wurde.

In Abwesenheit besonderer Regelungen für Internet-Stand der Technik gelten diese Grundsätze auch hierfür.

Diese Beweislastverteilung hat sich in der Praxis bewährt und sollte beibehalten werden.

3.5.2 Erfordert das Internet Regeln, die sich von den schon bestehenden Regeln für die mündliche Offenbarung oder die Offenbarung auf anderem Wege unterscheiden?

Bis heute wurden **keine** besonderen Regeln für das Internet eingeführt, die sich von den schon bestehenden Regeln für die schriftliche und mündliche Offenbarung oder die Offenbarung auf anderem Wege unterscheiden. Es sind allerdings auch bei den zuständigen Behörden noch keine Fälle zur Entscheidung gekommen, deren Ausgang allein von einem Stand der Technik aus dem Internet abhing. Bisher ist also nicht das Erfordernis neuer Regeln zu erkennen.

Die meisten denkbaren und in der Praxis auftretenden Fragestellungen, insbesondere bezüglich der Anerkennung von Internet-Dokumenten als schriftlicher Beschreibung und der Beweisbarkeit der Vorveröffentlichung eines Internet-Dokuments können erforderlichenfalls durch die Rechtsprechung auf der Grundlage existierender Gesetze entschieden werden.

3.5.3 *Sollte es unterschiedliche Grade des Beweises für verschiedene Wege der Offenbarung geben?*

Unterschiedliche Grade des Beweises für verschiedene Wege der Offenbarung sind abzulehnen, da sie die Rechtssicherheit beeinträchtigen. Die Anforderungen an die Beweisführung sollte unabhängig von dem Publikationsmedium grundsätzlich einheitlich sein.

3.5.4 *Erfordert die potentielle Manipulation von Informationen, die durch neue Medien offenbart wurden, unterschiedliche Maßstäbe für die Anerkennung solcher Offenbarungen und gibt es für diese Art von Offenbarungen spezifische Regeln?*

Die potentielle Manipulation von Informationen, die durch neue Medien offenbart wurden, erleichtern es, die Glaubwürdigkeit einer Veröffentlichung in Zweifel zu ziehen. Aufgrund der einfachen Manipulierbarkeit muss jeder Zweifel an einem Ausdruck (Hardcopy) eines Internet-Dokuments berücksichtigt und durch weitere, konventionelle Beweise wie z.B. eine Zeugenaussage beseitigt werden. Die Beweisführung zur Verifikation einer Internetveröffentlichung sollte sich aber nicht grundsätzlich von der Beweisführung zur Verifikation anderer, konventioneller Veröffentlichungen unterscheiden.

4. **Schlussbemerkung**

Eine internationale Vereinheitlichung des Begriffs des Standes der Technik ist äußerst wünschenswert. Auf diese Weise wird verhindert, dass für die gleiche Erfindung regional unterschiedliche Schutzmöglichkeiten entstehen.

Die allgemeine Definition des Standes der Technik, die uns aus dem deutschen und europäischen Patentrecht geläufig ist, eignet sich gut als Grundlage für die Harmonisierung des Begriffs des Standes der Technik

Der Stand der Technik umfasst alle Informationen, die vor dem für den Zeitrang der Anmeldung maßgeblichen Tag durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise der Öffentlichkeit zugänglich gemacht worden sind.

Ein ähnlicher Wortlaut wurde bereits durch das **Standing Committee on the Law of Patents** der WIPO als Harmonisierungsvorschlag gewählt.

Es ist insbesondere wünschenswert, dass die Zugehörigkeit einer Offenbarung zum Stand der Technik nicht davon abhängig gemacht wird, an welchem Ort und auf welche Weise die Offenbarung erfolgt ist. Derartige Differenzierungen vermindern die Rechtssicherheit und benachteiligten die in einzelnen Ländern ansässigen Wirtschaftsteilnehmer.

Diesen Vorgaben genügen das Deutsche und Europäische Patentrecht bereits. Das deutsche Gebrauchsmusterrecht genügt dem insoweit nicht, als zwischen verschiedenen Arten und Orten der Offenbarung differenziert wird.

Sachgerechte Gründe für eine Differenzierung sind nicht ersichtlich. Dies wird insbesondere im Zusammenhang mit dem Internet offenbar. Nimmt man an, dass der Begriff "schriftliche Beschreibung" Internet-Informationen nicht erfasst, werden die über das wahrscheinlich in der Zukunft für die Wissensvermittlung bedeutendste Medium weitergegebenen Kenntnisse vom Stand der Technik ausgenommen. Dies wird dazu führen, dass in erheblichem Umfang Schutzrechte ungerechtfertigt erteilt werden, die keine Innovation mehr darstellen. Dies hemmt die Wirtschaftstätigkeit.

Ebenfalls ist eine internationale Vereinheitlichung einer Neuheitsschonfrist, innerhalb der ein Erfinder seine Erfindung vor der Anmeldung veröffentlichen darf, wünschenswert. Die Abschaffung der Neuheitsschonfrist durch das EPÜ macht in der Praxis den Schutz bestimmter Entwicklungen durch ein Patent äußerst schwierig. Eine international einheitliche Neuheitsschonfrist beseitigt die Nachteile der Anmelder aus den Ländern, die keine Neuheitsschonfrist einräumen. In Anlehnung an einen von dem **Standing Committee on the Law of Patents** der WIPO gemachten Vorschlag⁶⁸ wäre folgender Wortlaut geeignet:

Der Stand der Technik umfasst keine Informationen, welche in einem Zeitraum von 12 Monaten vor dem für den Zeitrang der Anmeldung maßgeblichen Tag der Öffentlichkeit zugänglich gemacht wurden, wenn sie auf der Ausarbeitung des Anmelders oder seines Rechtsvorgängers beruht.

Die Aberkennung der Priorität durch das Europäische Patentämtern in den Fällen, in denen der Anspruch des Europäischen Patents ein über die Offenbarung der Prioritätsanmeldung hinausgehendes Merkmal aufweist, scheint aus Sicht der Anmelder bedenklich. Die alternative Lösung, in einem Anspruch den verschiedenen Merkmalen unterschiedliche Prioritäten zukommen zu lassen erfüllt die Anforderungen des üblichen Entwicklungsablaufs und der Möglichkeit der Veränderung und Verbesserung des Anmeldegegenstandes nach der ersten Anmeldung besser.

In Bezug auf Internet-Veröffentlichungen hat sich bisher kein Bedarf für besondere Regeln gezeigt. Die meisten Fragen zu Internet-Veröffentlichungen scheinen Tatsachenfragen zu sein und mit dem existierenden Regelwerk durch die Rechtsprechung lösbar zu sein.

Zusammenfassung

Nach dem deutschen Patentgesetz und dem Europäischen Patentübereinkommen umfasst der Stand der Technik alle Kenntnisse, die durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise der Öffentlichkeit zugänglich gemacht worden sind. Enthält eine Veröffentlichung aus dem Stand der Technik sämtliche Merkmale einer Erfindung, fehlt die Schutzvoraussetzung der Neuheit. Ist eine Erfindung dem Fachmann durch den Stand der Technik nahegelegt, fehlt ihr die Schutzvoraussetzung der erfinderischen Tätigkeit.

Um Doppelpatentierungen zu vermeiden, wird dem Stand der Technik auch der Inhalt älterer Patentanmeldungen zugerechnet, die nach dem Prioritätstag oder Anmeldetag einer jüngeren Anmeldung veröffentlicht wurden, soweit beide Anmeldungen das gleiche geografische Gebiet betreffen. Dieser nachveröffentlichte Stand der Technik wird bei der Prüfung der Erfindungshöhe nicht berücksichtigt.

Die Rechtsprechung der deutschen und europäischen Patentbehörden und insbesondere die Richtlinien für die Prüfung im Europäischen Patentamt bieten umfangreiche Regeln für tatsächliche und rechtliche Fragen zur Beurteilung des Standes der Technik.

Über das Internet verbreitete Veröffentlichungen werden grundsätzlich von den deutschen und den europäischen Behörden als Stand der Technik anerkannt. Es existieren keine besonderen Regeln für die Beurteilung von Internet-Veröffentlichungen. Internet-Veröffentlichungen dürften ohne

⁶⁸ SCP5/2, DRAFT SUBSTANTIVE PATENT LAW TREATY, URL: r:\publish\scforum\en\documents\session_5\doc\scp5_2.doc

weiteres mit dem bestehenden Regelwerk für die Beurteilung des Standes der Technik beurteilbar sein. Wegen der Schnelligkeit des Internets und der Manipulierbarkeit digitaler Dokumente wird es im Einzelfall schwer fallen, die Authentizität einer Internet-Veröffentlichung zu beweisen.

Nach deutschem Gebrauchsmusterrecht umfasst der Stand der Technik nur schriftliche Beschreibungen und Benutzung im Inland. Daher wären Internet-Veröffentlichungen nur relevant, wenn sie als schriftliche Beschreibung oder Benutzung im Inland anerkannt würden.

Summary

According to the German Patent Act and the European Patent Convention, the state of the art comprises all knowledge made available to the public by means of written or oral descriptions, by use or in any other way. If a state of the art publication contains all features of an invention, the protection requirement of novelty is no longer fulfilled. If an invention is made obvious to a person skilled in the art by a prior art, it lacks the protection requirement of inventive step.

In order to avoid multiple patenting, the state of the art is held to also comprise the content of earlier patent applications published after the priority date or application date of a later application, in as far as both applications are directed to the same geographical territory. This "post-published" state of the art is not to be considered on examining the inventive step.

The jurisdiction of the German and European patent authorities and especially the guidelines for examination in the European Patent Office comprise numerous rules concerning factual and legal aspects of the assessment of the state of the art.

Publications made available via the Internet are generally accepted as state of the art by the German and European authorities. There are no special rules for the assessment of Internet publications. Internet publications can be readily handled with the existing set of rules for the assessment of the state of the art. Due to the quick changes of the Internet and the easy manipulation of digital documents, it may be difficult in some cases to prove the authenticity of an Internet publication.

According to German Utility Model Law, the state of the art only comprises written descriptions or prior use in the territory of Germany. Thus, Internet publications would only be relevant if they were accepted as written descriptions or prior use within the territory of Germany.

Résumé

Selon la loi allemande sur les brevets et la Convention sur le Brevet Européen, l'état de la technique est constitué par tout ce qui a été rendu accessible au public, par une description écrite ou orale, un usage ou tout autre moyen. Si une publication comprise dans l'état de la technique comprend toutes les caractéristiques d'une invention, la condition de nouveauté requise pour la brevetabilité n'est plus remplie. Si une invention découle d'une manière évidente de l'art antérieur, elle ne remplit pas la condition d'activité inventive, condition de brevetabilité.

Pour éviter une double protection, le contenu des demandes antérieures de brevet, publiées après la date de priorité ou la date de dépôt d'une demande postérieure, est considéré comme compris dans l'état de la technique, pour autant que les deux demandes couvrent le même territoire géographique. Cet état de la technique "post-publié" n'est pas pris en considération pour l'examen de l'activité inventive.

La jurisprudence des autorités de brevets allemandes et européennes, et tout particulièrement les directives concernant l'examen à l'Office Européen des Brevets, proposent de nombreuses règles en ce qui concernent les questions de fait et de droit relatives à l'appréciation de l'état de la technique.

Les publications diffusées sur l'Internet sont généralement reconnues par les autorités allemandes et européennes comme étant comprises dans l'état de la technique. Il n'existe pas de règles spéciales pour apprécier les publications diffusées sur Internet. Les publications via Internet pourront être appréciées, tout simplement, selon les règles déjà existantes pour l'appréciation de l'état de la technique. Les changements rapides se produisant sur l'Internet et la possibilité de manipulation de documents numériques rendent parfois difficiles la preuve de l'authenticité d'une publication via Internet.

Selon la loi allemande sur les modèles d'utilité, l'état de la technique comprend uniquement des descriptions écrites et un usage dans le territoire allemand. Par conséquent, une publication via Internet ne sera pertinente que si elle est reconnue comme une publication écrite ou un usage dans le territoire allemand.

Report Q167

in the name of the Hungarian Group
by Marcell KERESZTY (Head of the Working Committee), Dr. Attila MÁNDI,
Imre MOLNÁR, Lajos NÉMETH, Dr. Tivadar PALÁGYI, Dr. István POLGÁR
and Dr. Éva SOMFAI

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

Prior art disclosures can be detrimental as to novelty and/or inventive step.

An invention shall be considered novel only if it does not form part of the prior art in a single item thereof. An invention shall be considered to involve an inventive step only if it is not obvious to a person skilled in the art.

Both the Hungarian Act No. XXXIII of 1995 on the Protection of Inventions by Patents (in the following referred to as HPA) and the Hungarian Act No. XXXVIII of 1991 on the Protection of Utility Models (in the following referred to as HUMA) follow the so called "whole contents approach". Consequently, applications which have not yet been published can affect the assessment of novelty but do not affect that of inventive step. The content of any national patent application or utility model application - or of any application being equivalent to a national filing - having an earlier date of priority shall also be considered as comprised in the prior art, provided that it was published or announced in the course of the application procedure at a date following the date of priority. The content of such an application published under an international treaty shall only be considered as comprised in the prior art if the Hungarian translation of the application has been filed in compliance with the relevant legal provisions. However, these earlier applications shall not be taken into consideration when assessing the inventive step [HPA Art. 2(3) and Art. 4(2); HUMA Art. 2(3) and Art. 3(2)]

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Concerning patents, the state of the art comprises everything made available to the public by means of a written description or oral communication, by use, or in any other way, before the date of priority. The term "use" means public use. Thus, in the case of patents no limiting definition is given as to what constitutes a prior art disclosure [HPA Art. 2(2)].

However, concerning utility models, the state of the art comprises everything made available to the public by means of a written description or by use in the country before the date of priority. In this case a public use in a foreign country and an oral disclosure do not constitute a prior art disclosure [HUMA Art. 2(2)].

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

In principle, a piece of prior art has been disclosed if it has been made accessible to anybody.

Examples and explanations for this principle are given in the examination guidelines of the Hungarian Patent Office published under the title "Guidelines for patent prosecution".

2. Criteria for disclosure

2.1 Means of disclosure

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

For patents, disclosure is not limited to certain types thereof. It includes written, oral, use or any other kind of disclosure, for example disclosure on the internet. For utility models, disclosure is limited to written disclosure and domestic use.

There are no additional requirements for certain types of disclosure.

In the case of utility models, oral disclosure and foreign use are not recognized forms of prior art disclosure, i.e. a so called "relative novelty" is required as in most of the countries where utility model protection exists, for example in Germany.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

A piece of information constituting a prior art disclosure is relevant for the assessment of novelty and inventive step independently from the date of disclosure.

2.3 Place of disclosure

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

In the case of patents, the place of disclosure is not relevant. In the case of utility models, foreign use does not constitute a prior art disclosure. There is no difference if the disclosure has happened accidentally. The place of disclosure and the fact whether a disclosure has occurred are determined by means of evidences. The Hungarian law is applicable for determining whether a disclosure has occurred.

2.4 Personal elements

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

In the case of patents, there is no difference if a piece of information is disclosed by the applicant or by a third person. However, a disclosure is treated differently if it was the result of an abuse of the rights of the applicant or his predecessor in title, for example the disclosing person was bound by a confidentiality agreement. For this situation a grace period of six months is provided for [HPA Art. 3(a)].

Concerning utility models, a grace period of six months is provided for in the case when the prior art disclosure was made by, or with the consent of, the applicant or his predecessor in title [HUMA Art. 2(4)].

There is no clear practice in Hungary for treating errors in the disclosed information. The Hungarian Group is of the opinion that in assessing novelty or inventive step, the disclosed information should be taken into account as the person skilled in the art would have understood it at the date of priority. Errors in the disclosed information should be treated according to this principle.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

A prior art disclosure is a piece of information which shall be understandable for a person skilled in the art without undue burden or experimentation. If the additional steps can be carried out without undue burden or experimentation, the possibility to obtain the information is sufficient to constitute a disclosure.

For the effect of confidentiality or implied confidentiality a grace period is provided for. The provisions concerning the grace period shall be applied if the prior art disclosure was the result of an abuse of the rights of the applicant or his predecessor in title [HPA Art. 3(a)].

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

Public electronic information constitutes a sufficient disclosure to affect novelty or inventive step. In the practice of the Hungarian Patent Office, the term "written description" is construed broad enough to include computer or machine readable information stored in an electronic memory, on magnetic media or in optical devices. No specific requirements are to be met compared to other forms of disclosure.

In the various forms of networks or communications, the test to determine "public availability" or "public accessibility" to the information concerned should be the same as the test applicable to other types of disclosures. Therefore, it should be considered in connection with all specific circumstances of each single case. The information disclosed in public communications, such as the Worldwide Web, chat groups, forums, publicly distributed e-mails and others should form part of the prior art. However, a private e-mail, regardless of being encrypted or not, should not be regarded as prior art.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

The Hungarian Group considers that passwords and encryption are relevant criteria. The key factor for the determination is whether the password or the decryption tool is available to the public without any limitation or discrimination.

If a search by a search engine provides a piece of information, the latter should be considered a public one.

The content of a web site that requires payment for access should be considered publicly disclosed if the access through payment is available to any person.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

The place of disclosure is where the information put on the internet can be accessed. This practically means that an information put on the internet is disclosed in all countries in which the information is accessible, without any additional conditions or requirements.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

Due to the absence of experience and legal precedents, it is not clear at present, what requirements are for the timing and duration of the disclosure on the internet.

Concerning the timing and duration of a prior art disclosure, the Hungarian Group is of the opinion that the information should appear long enough before the priority date on the internet so that it could be available to the public. The sufficient duration of appearance on the internet should be determined on a case by case basis. The information should appear on the internet at least as long as it was necessary for the public to download or print the information.

The Hungarian Group considers that archives are desirable for providing evidences for disclosures on the internet.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

The person who states that a specific piece of information was disclosed on the internet should have the burden of proof.

The level of proof for internet disclosures should basically not be different from that established for paper publications. The Hungarian Group is not aware of any specific requirements for evidencing in an internet disclosure case. However, the potential manipulation of information disclosed through new media requires more definite standards for the recognition of such disclosure.

Summary

Prior art disclosures can be detrimental as to novelty and/or inventive step. In the case of patents no limiting definition is given as to what constitutes a prior art disclosure. However, in the case of utility models, public use in a foreign country and oral disclosure do not constitute a prior art disclosure.

A prior art disclosure is a piece of information which shall be understandable for a person skilled in the art without undue burden or experimentation.

Public electronic information constitutes a sufficient disclosure to affect novelty or inventive step. In the various forms of networks or communications, the test to determine "public availability" or "public accessibility" to the information concerned should be the same as the test applicable to other types of disclosure.

The level of proof for internet disclosures should basically not be different from that established for paper publications. However, the potential manipulation of information disclosed through new media requires more definite standards for the recognition of such disclosure.

Résumé

Des exposés de l'état de la technique peuvent être nuisibles à la nouveauté et/ou au niveau inventif. Dans le cas des brevets il n'existe pas de définition limitative de ce qui constitue un exposé de l'état de la technique. Néanmoins, dans le cas des modèles d'utilité, l'usage public dans un pays étranger et un exposé oral ne constituent pas un exposé de l'état de la technique.

Un exposé de l'état de la technique est une information qui sera compréhensible pour une personne versée dans l'art sans expérimentations ni efforts excessifs.

Une information publiée par voie électronique constitue un exposé suffisant pour affecter la nouveauté ou le niveau inventif. Dans les différentes formes de réseaux de communications l'épreuve servant à déterminer "la disponibilité publique" ou "l'accessibilité publique" de l'information concernée sera la même que l'épreuve applicable aux autres types d'exposés.

Le niveau des preuves pour les exposés sur internet ne devra pas être différent en principe du niveau établi pour les publications sur papier. Néanmoins, la manipulation potentielle des informations exposées au moyen des nouveaux médias exige une meilleure définition des standards visant à la constatation d'un tel exposé.

Zusammenfassung

Offenbarungen des Standes der Technik können sowohl neuheitsschädlich sein, wie auch die Erfindungshöhe zerstören. Im Falle von Patenten kann einer Offenbarung des Standes der Technik keine einschränkende Definition gegeben werden. Bei Gebrauchsmustern gehört jedoch eine öffentliche Inbenutzungnahme und orale Offenbarung im Ausland nicht dem Stande der Technik an.

Die Offenbarung des Standes der Technik ist ein Stück Information, welches vom Fachmann ohne übermäßig belastende Experimentierung verstanden werden kann.

Die öffentliche elektronische Information stellt eine ausreichende Offenbarung zur Beeinflussung der Neuheit und der Erfindungshöhe dar. In verschiedenen Formen der Netzwerke und Kommunikationen soll zur Bestimmung der "öffentlichen Erreichbarkeit" und "öffentlichen Zugänglichkeit" einer Information derselbe Test verwendet werden, wie für andere Type der Offenbarung.

Das Beweisniveau für die auf Internet veröffentlichten Offenbarungen soll von den Normen, welche für die auf Papier gedruckten Veröffentlichungen verwendet werden, nicht verschieden sein. Die potentielle Manipulation der durch die neuen Medien veröffentlichten Informationen macht jedoch eine bessere und klarere Bestimmung des Standards für die Anerkennung solcher Offenbarungen erforderlich.

Report Q167

in the name of the Indian Group
by Dr. Rajeshkumar H. ACHARYA

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of Prior Art

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps?*

In fact, the definition of invention itself states that the invention must be new. The novelty in the alleged invention is an essential pre-requisite for obtaining a patent. As well u/s 25(1)(e) of the Indian Patents Act 1970 the question whether the invention claimed is obvious and clearly does not involve any inventive step be decided having regard to prior publication or prior user. There is a similar ground of revocation, u/s 64(1)(f) of the Indian Patents Act 1970 obviousness and lack of inventive step is a ground for revocation of patent.

- *Are there differences between prior art regarding novelty on the one hand and inventive step on other hand?*

The word “obviousness” as against “novelty” and “inventive step” are antithesis. What is obvious cannot be inventive and what is inventive cannot be obvious.

- *Do pending applications, which have not yet been published, affect the assessment of novelty and inventive step?*

Yes, u/s. 13 of the Indian Patents Act 1970 the examiner makes investigation to ascertain whether any claim made in the complete specification in a patent application of a matter either in a patent specification or in any other document published in India or elsewhere Sections 14 and 15 empower the controller to refuse an application on the ground that the invention is not new. In fact, the definition of invention itself states that the invention must be new. Thus novelty in the alleged invention is an essential prerequisite for obtaining a patent grant under the Act. Section 64(1)(e) provides a ground for revocation based on lack of novelty. It is also details the facts to be taken into consideration in determining lack of novelty or anticipation. Section 29 to 34 lay down under what circumstances prior publication or prior or prior user does not continue anticipation. Lack of novelty referred to as anticipation. An analogous ground is also available for opposing the grant u/s. 25(1)(d) of the Indian Patents Act 1970.

1.2 *Do the national laws give definition or indications as to what constitutes a prior art disclosures?*

No, there is no definitions of prior art disclosure is given in the Indian Patent Law. But, u/s. 25(1)(e) of the Indian Patents Act 1970 of the Indian Patents Act 1970 the question whether the invention claimed is obvious and clearly does not involve any inventive step be decided having regard prior publication or prior user. There is a similar ground of revocation u/s. 64(1)(f) of the Indian Patents Act 1970 obviousness and lack of inventive step is ground for revocation of a patent. Thus, prior publication or prior user constitutes prior art disclosure.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

Guidelines for determination of this question can be gathered by making comparison between the claims made by the patentee and prior document is equal in practical utility to that imported in the patentee's claims.

The process of comparison can be chalked out:

1. First step is to construe the prior document as at the date of its publication, in accordance with the normal principals of construction, taking account of surrounding circumstances, but excluding the benefit of hindsight.
2. The next step is to compare the disclosure in each prior document separately with the disclosure in the patentee's claim, construed in accordance with the principles set out earlier.
3. The final step is to ask whether, on making the comparison, the prior document discloses the same invention as that disclosed in the "clear and unmistakable directions" in the prior publication, when carried out by the skilled workmen would "inevitably" result to something beings made or done which, if the patentee's claims were valid, would constitute an infringement.

2. Criteria for disclosure

2.1 *What are recognized means of disclosure has to be such as to enable the public to make or obtain the invention? For this recognized means areas under;*

- *Oral publications:* If the public once becomes possessed of an invention, by any means whatsoever, no subsequent patent for it can be granted either to the true or any other person; for the public cannot be deprived of the rights to use the invention and patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he would give.
- *Publication through books or documents;* an invention may have become "Publicity known" through documents or books published prior to the date of the patent. It is not necessary that the invention should be used by the public as well as known to the public by the description in a work which has been publicity circulated, or in a specification duly enrolled, it avoids the patent, though it is not shown that it ever was actually put in use.
- *Publication of photographs:* The publication of the photograph of a machine may constitute anticipation. Where the question of anticipation depends upon the inference to be drawn from photographic illustration of the machine, evidence is necessary to show what the eye of the man with appropriate engineering skill and experience would see in the photograph. The photograph must be looked at through the eyes of the typical address of the specification the kind of persons who would be expected to make a machine of the kind.

Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure by use, when compared to disclosure through written documents?

Oral disclosure and disclosure by use are also recognized means of disclosure.

If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

A matter may be made available to the public by its use publicity, oral disclosure or through documents is basic concept of disclosure. So above question does not arise.

2.2 *Time of disclosure*

- *Does it matter if a disclosure has been made recently or a long time ago?*

Yes, u/s. 13 of the Indian Patents Act 1970 disclosures must be by previous publication and by prior claim.

- *Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?*

Yes, u/s. 31 of the Indian Patents Act 1970, if the application for the patent is made by the true and first inventor or a person deriving title from him not later than Six months after the opening of the exhibition or readings or publication of the paper as the case may be, shall not be deemed to have been anticipated.

2.3 *Place of disclosure*

- *Is the place of disclosure relevant?*

Yes.

- *How is the place of disclosure determined?*

The place of disclosure will be determined among the following documents u/s. 13(1) and 13(2) of the Indian Patents Act;

- i) Specifications filed in pursuance of application for patent made in India on or after 1st January 1912, but before the date of filing of the applicant's complete specification. This will cover all specifications filed during the relevant period, which have been published that is, advertised in the gazette after acceptance of the complete specification. Thus, the search will extend to these applications, which have been abandoned after advertisement, but not those abandoned before advertisement.
- ii) Any documents, other than those mentioned in Section 13(1), published in India or elsewhere, before the date of filing of the applicant's complete specification.

This will cover foreign specifications, whether published in India or not, and textbooks and periodicals published anywhere relating to the art in question, the only limitation being that they should be published before the date of filing of the applicant's complete specification.

- *Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?*

Yes, where the prior user alleged was not intentional but was purely accidental then prior use is not established.

- *Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step assessed)?*

The Law of the country in which the information was disclosed shall be applicable law for determining whether a disclosure has occurred.

2.4 *Personal elements*

- *What differences do the Groups observe with regard to the person who discloses the prior art?*

Section 25(1) expressly provides that only a "person interested" may oppose an application for a patent. Section - 2(1)(t) states that a person "interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates. This definition is not exhaustive and would appear to be capable of liberal interpretation.

- *Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?*

Yes, if the communication is made by a person bounded by confidentiality agreement does not ensure to the benefit of the public and therefore it is no disclosure.

- *How are errors in the disclosed information treated?*

Any erroneous statement in a specification amounting to a false suggestion may invalidate the patent, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describes several processes combinations of machinery and affirms that each will produce a certain result, which is the object of the patent and someone of the processes of combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would be at once observed by an ordinary workman.

2.5 Recipient of information

- *What requirements are there with regard to the ability to understand the information?*

Where prior disclosure is relied upon, it is necessary to point a clear and specific disclosure of something, which can be fairly stated to be the invention of the patentee. If it is something, which is said to belike the patentee's invention, there should be a description of its use and the manner in which the patentee intends it to be used. It is not open to take a packet of some process of putting a puzzle together, produce what is said to be a disclosure in the nature of combination of the various elements which have been contained in the prior documents.

- *Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?*

Yes, Possible. But to establish anticipation based on what was known before the priority date of the claim it must be shown "that in some prior publication there is to be found information about the alleged invention equal for the purposes of practical utility to that given by the patent.

- *Are there general rules providing for the effect of confidentiality or implied confidentiality?*

Yes, the provisions for secrecy are made u/s. 35 to 42 of the Indian patent law.

3. Disclosure through new media

3.1 General rules

- *Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to effect novelty or inventive step?*

Yes, it is settled law that if the public once becomes possessed of an invention by any means whatsoever, no subsequent patent for it can be granted either to the true of first inventor himself or any other person.

- *Are there specific requirements compared to other forms of disclosure?*

No, the question whether there has been prior publication, the answer is had the information been communicated to any member of the public who was free in law or equity to use it as he pleased, if so, the information, of course, had been given to a member of the public then it becomes disclosure.

- *Are there differences with regard to various forms of network or communications, such as the worldwide web, groups or forms, e-mail and others?*

No, the state of art comprised all matter, which had been made available to the public by written, or oral description by use or in any other way. The matter must be result of clear and unmistakable directions, which enable the public to produce the claimed product. The prior disclosure must have made the invention claimed in the patent available to the public but does not necessarily have to identify it. The fact that the public did not know how the process works or what is the product produced is irrelevant. Although nobody had known that the product existed it had still formed part of the state of art.

3.2 Questions of Confidentiality

- *Does it make a difference if the information is encrypted?*

Encryption is a relevant criteria. The key factor for determination is whether encryption tool was available to the public without any limitation or discrimination.

- *What relevance does passwords, search engines and payment requirement?*

Password protection is a relevant criteria. The Key factor for the determination was whether the password was available to the public without any limitation or discrimination. Ability to search by search engines, the information on the Internet can be considered as prior art were met. The website that requires payment for access can be considered prior art if the access through payment was available to any person.

3.3 Place of disclosure

- *What is the place of disclosure if information is put on the Internet?*

The place of the website can be considered as the place of disclosure for the information put on the Internet.

- *Is the mere fact that a website can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?*

The information disclosed on the Internet constitutes prior art, where such disclosure met general requirements on prior art. However, efforts should be made to harmonized the general definition of prior art in a manner that would be also applicable to the information disclosed on the Internet, or at least that general principals should be established first, and then a special treatment of Internet related issues could be discussed later, if necessary.

3.4 Timing of disclosure

- *Are there certain requirements for the timing and the duration of information available through electronic means?*

Yes, the duration of the disclosure of the information should appear on the electronic means long enough so that it could be available to the public or not is determined in the same way as prior art in relation to other means. Therefore, the sufficient duration of appearance on the electronic means could be determined on a case by disclosure is important element the time and publication date on the print out must be there.

- *Are archives necessary or desirable?*

Archives are necessary.

3.5 Questions of evidence

- *The fact that information on the Internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or who should have the burden of proof that a specific piece of information was disclosed on the Internet?*

The Office has the responsibility to prove the contents of the disclosure on the Internet on or before the filing date of the application, which would constitute prior art.

- *Does the Internet require rules different from those already existing for oral disclosure or the disclosure in other ways?*

A matter may be made available to the public by its use publicity by oral disclosure or by written document or by any means is the basic concept of the disclosure the internet does not require different rules.

- *Should there be different levels of evidence for different ways of disclosure?*

As to prove that the matter is made available to the public by its use publicity by oral, written or any other means, the levels of evidence may be different.

- *Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?*

The invention made available to the public by oral, or written or by any other means is the basic concept of the disclosure. There are no rules of present of disclosure. Same way there is no necessity for recognition of disclosure through new media.

Summary

The Indian Patents Law does not define prior art disclosure, but indications are there to decide the prior art disclosure. The novelty and inventive step are the pre-requisites for the grant of the patents. The introduction of common definition or harmonization of definitions or standards of prior art disclosure is necessary. We are of the opinion that no limitation of the means of disclosure must be specified. The disclosure of the state of art must cover all that become generally accessible through written statement or oral description, usage or disclosure in any other manner. Specific requirements for different means of disclosure, including through new media may be underlined.

Report Q167

in the name of the Israeli Group
by Tal BAND and Dr. Yehuda LIVNEH

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive steps?*

An invention is deemed to be novel unless it has been published in Israel or abroad prior to the application date. An inventive step is a step, which does not appear obvious to an average man skilled in the art, in light of the information published in Israel or abroad, prior to the application date. There are no differences between the formal requirements from prior art regarding novelty and inventive step. As to the contents of the disclosure, in general, novelty can be challenged if **one** prior art disclosure contains **all** the features of the invention. Obviousness or lack of inventive step can be proven by combining several prior art disclosures (where it is obvious to combine them together). Pending, earlier filed applications and not yet published, do not affect novelty nor obviousness; however a patent is only granted to the first to validly apply for it. The Registrar of Patents will defer examination of a later filed application until the examination of the first application is complete. If the first filed application matures to a patent it will be considered when examining the later filed application.

1.2 *Do the national laws give definitions of indications as to what constitutes a prior art disclosure?*

Under the Israeli Patents Law, prior art disclosure will be considered as such if it is published anywhere in the world by written, visual, audible or any other means if an average man skilled in the art can carry it out in accordance with the details thus made known. It will also be considered prior art if it has been presented or demonstrated publicly by exploitation or exhibition and an average man skilled in the art can carry the invention out in accordance with the details thus made known (prior use).

The Israeli Patents Law provides that certain disclosures will not affect the patentability of the invention:

- 1) If it is proved that the matter published was obtained from the owner of the invention or his predecessor in title and was published without his consent, and if the patent application was filed within a reasonable time after the publication became known to the application; or
- 2) if the publication was by the owner of the invention or his predecessor, in an industrial or agricultural exhibition in Israel or in a recognised exhibition in one of the Convention States, of which official notice was given to the Registrar before its opening, on condition that the patent application was submitted within six months after the exhibition opened;

- 3) publication was by way of a lecture by the inventor before a scientific society, on condition that the Registrar was given notice of the lecture before it was delivered and that the patent application is filed within six months after the aforesaid publication.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.*

No formal guidelines for determining whether prior art has been disclosed. Under the Patents Law the Patent Office may and in fact requests the applicant to submit all reference cited by patent examination authorities in other countries when examining a corresponding patent application for the same invention in those countries.

In general, there is no need to prove that someone actually saw the publication of the prior art. It is sufficient to prove that the publication was accessible to relevant public.

2. **Criteria for disclosure**

2.1 *Means of disclosure*

What are recognised means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognised either by law or in practice, what are the reasons?

All means of disclosure are recognised as disclosure. There is no differentiation between oral or written disclosure. Disclosure by use is explicitly mentioned in the Israeli Patents Law. There are no differences in requirements for any type of disclosure.

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

There is no formal relevance to the time of the disclosure, as long as it occurs prior to the date of the application or, where applicable, to the priority date. Of course the applicant may argue that if the disclosure was made a long time before his invention, and still no one besides him has made the invention, then that proves that the disclosure does not teach the average man skilled in the art how to carry out the invention.

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

The place of disclosure is irrelevant as long as it is accessible to the relevant public. The disclosure is considered a prior art whether it took place in Israel or abroad.

The question whether a disclosure has occurred will be determined by the Israeli law.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

The right of the owner of an invention to be granted a patent shall not be affected by publication if it is proved that the matter published was obtained from the owner of the invention or his predecessor and was published without his consent, and if the patent application was filed within a reasonable time after the publication became known to the applicant.

The patentability of an invention will not be affected if the publication was by the owner of the invention or his predecessor in title in one of the following ways:

- I) display at an industrial or agricultural exhibition in Israel or at a recognised exhibition in one of the Convention States, of which official notice was given to the Registrar before its opening;
- II) publication of a description of the invention at the time of a said exhibition;
- III) use of the invention for the purposes of the exhibition and at the place of the exhibition;
- IV) the publication was by use of the invention, even without its owners' consent, at the time of the exhibition, at the place of the exhibition or outside it,

on condition that the patent application was submitted within six months after the exhibition opened.

Similarly, publication by way of a lecture by the inventor before a scientific society or by way of publication of such a lecture in the official transactions of the society will not prejudice the grant of a patent, provided that the Registrar had been given notice of the lecture before it was given and that the patent application is filed within six months after publication of the aforesaid.

A disclosure of the invention under conditions of confidentiality will not be considered a disclosure that affects the patentability of the invention.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

The prior art is examined through the eyes of an average man skilled in the art. Hence, if the disclosure enables an average man skilled in the art to make the invention according to the particulars of the disclosure or if the invention seems obvious in the light of the disclosure, the invention will not be novel or it will be considered obvious.

Hence, the disclosed information must be understandable by the average man skilled in the art.

It is our opinion that if an average man skilled in the art can obtain the information through additional steps, such as disassembly of embodiments or reverse engineering, such information may possibly be considered as prior art.

In general, a disclosure of the invention under conditions of confidentiality will not be considered a disclosure that affects the patentability of the invention. Nevertheless, if an invention was disclosed to the entire relevant industry under conditions of confidentiality (e.g. disclosure of an invention in the military field to the relevant public under conditions of confidentiality), such disclosure may still affect the patentability of the invention. In some circumstances, the courts recognized the existence of implied confidentiality.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various

forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

There are no laws specifically relating to disclosure through the new media. Each disclosure in the new media will be examined in the light of the general rules of disclosure.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

If it can be proven that the information was accessible and understandable to the average man skilled in the art, such information may be considered prior art. It is our opinion (not based on any case law, but on analysis of the Israeli Law) that encrypted information will not be considered prior art, unless the relevant public is aware of the information and knows how to decipher the text.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

The place of disclosure is irrelevant as long as it is accessible by the average man skilled in the art. The disclosure is considered prior art whether it took place in Israel or abroad.

3.4 *Timing of disclosure.*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

This question has not yet been addressed in Israeli case law or statutes.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

The burden of proof to prove the existence of any prior art is on the party who argues that the patent is invalid or argues that the invention has no patentability.

As yet, there is no specific case law in Israel regarding disclosure on the internet.

Report Q167

in the name of the Italian Group
by Gianfranco DRAGOTTI, Bruno MURACA, Silvano ADORNO
and Francesco Paolo VATTI

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

Italian Patent law has been revised in 1979 in order to harmonize it with the European Patent Convention and, apart from some minor differences, the main features thereof, particularly as regards patentability requisites, correspond to the principles set forth in EPC.

As regards novelty, the terms thereof are set forth in the article 14 of the Italian patent law, wherein it is stated that the state of the art to be taken into consideration for the assessment of the novelty consists of all what has been made **available to the public** either in the territory of the State or abroad before the filing date of the patent application, by means of a written or oral description, by use or by any other means.

According to the Italian law, an Italian patent application shall be made available to the public 18 months after the filing date¹; however, the application is not printed but only made available at the library of the Italian Patent and Trademark Office (hereinafter ITPTO), and any one interested thereto shall have the right to make copies. This fact is not important as regards the Italian approach in considering a prior reference in affecting the novelty: the fact that a prior reference is not printed but only available for reading and/or copying is not relevant in case it does affect the novelty of a later filed application.

Novelty is an absolute requisite and, apart from some cases of prior disclosures which cannot affect the novelty of an invention², a disclosure shall be considered as prejudicial for the novelty if the possibility is afforded that the related information becomes available for an undetermined number of individuals. Even if the disclosure is directed to only one person, but in absence of whatever confidentiality restriction and with a potential possibility of propagation of the information to others, it will be considered as prejudicial for the novelty of a later filed patent application.

On the contrary if the disclosure is directed to people bound to confidentiality, it shall not be considered as possibly affecting the novelty of a later filed patent application even if the number of the recipients is undetermined.

1. Determination of prior art

1.1 Prior art disclosure does affect both novelty and inventive merit of later filed patent applications, but as regards novelty also the contents of patent applications filed earlier but made available to the public later than the filing date of the patent application under consideration can be opposed, whereas it does not hold true as regards inventive step.

¹ Unless the Applicant has stated, upon filing the application, his willingness to have the application immediately available to the public, in which case the availability shall take place 90 days after the filing date.

² These cases include (according to art.15 of Italian patent law) the disclosure occurring owing to an evident abuse against the applicant or his predecessor and the disclosure occurring in exhibitions, either official or officially recognised under the Paris Convention of 22 November 1922.

- 1.2 Articles 14 and 15 of Italian patent law (corresponding quite identically to articles 54 and 55 of EPC) define the state of the art which can be cited against a patent application and thus what constitutes a prior art disclosure.
 - 1.3 In Italy no examination on the merits of patent applications is carried out by ITPTO, and the patents are granted after an examination aiming to assess whether the formal requirements are met and whether the claimed invention is patentable according to the Italian law (namely does not fall among the unpatentable subjects). The examination on the merits is in fact carried out if and when the patent is challenged for nullity before an Italian Court, the latter being entitled to judge whether the patent is valid or not. According to the doctrine and case law, novelty must be assessed by comparing the object of the patent or patent application, namely of the claims, and the known and applicable state of the art. Even in the case that all the elements of the claimed invention are isolately known, whereby they should be combined through an a posteriori reconstruction to get the claimed invention, the novelty is not destroyed (this recombination being possibly applicable in the judgement of the inventive step). It is still disputable whether prior art comprising elements equivalent either in strict sense or in broad sense to the claimed ones may affect the novelty. According to the mostly accepted case law, elements strictly equivalent to the claimed ones may affect the novelty, it being not held true for those only broadly equivalent.
- 2. Criteria for disclosure**
- 2.1 Article 14 of Italian patent law as a matter of fact includes "written or oral description, use or any other means" as regards form of disclosure which concur to establish the state of the art applicable for assessing both novelty and inventive step. A disclosure through internet is not specifically mentioned nor it has been dealt with to date in case law. However according to the opinion of Italian Group a disclosure through internet should be considered as encompassed by the general wording of the law and thus applicable in determining the state of the art. The general principle for determining whether a disclosure does or does not affect the novelty is whether the information resulting from the disclosure is sufficiently complete to lead a person skilled in the art to carry out the later claimed invention: otherwise stated the novelty of an invention is affected if the previous disclosure affords the possibility of carrying out the invention.
 - 2.2 According to the Italian law as well as the case law no limits exist as regards the time at which the prior disclosure took place, in order to have it validly opposable for the novelty and inventive step issues. The only point which might be relevant is whether at the time the disclosure occurred proper and adequate means were known to carry out the later invention.
 - 2.3 Italian law and case law do not consider any limit about the place where the disclosure took place. The only issue of interest might be that of the possible confidentiality of the disclosure, since in that case the disclosure is not considered as validly opposable as regards both novelty and inventive merit. Moreover the law applicable to determine whether a validly opposable disclosure occurred is the Italian one, no matter about the law of the country wherein the disclosure occurred.
 - 2.4 Italian law does not make any difference about the fact that the disclosure was made by the applicant or by a third person, apart from the case of evident abuse against the applicant or his predecessor. If the disclosing person was bound by a confidentiality agreement the disclosure shall not be considered as applicable as regards novelty of a later filed application. No grace period is foreseen by the Italian law and, as regards the disclosure in exhibitions, only those which took place in exhibitions acknowledged by the Paris Convention of 1922 are taken into account. Errors of the disclosure shall be taken into consideration if affecting the content of the information, otherwise they are no longer prejudicial for the novelty.
 - 2.5 According to the doctrine and case law public is meant as an undetermined number of persons, which might be also a limited number of persons if the potential further spreading of the disclosure to others exists. If the disclosure is directed to a limited number of persons,

lacking any confidentiality restriction and, if these persons are capable of understanding the content of the disclosure or are capable of transferring the disclosure as such to third parties capable of understanding its content, the disclosure is considered as addressed to the public in the sense meant by the law. If the disclosure takes place through the exhibition of an item consisting of or incorporating the invention, (provided that it can be understood by merely looking at the item), it is validly opposable as prior art. Likewise the selling of an item consisting or including the invention, and the latter can be understood either directly or by dismounting the item, the disclosure is also validly opposable as prior art. As regards confidentiality or implied confidentiality the conditions foreseen by the Guidelines for Examination of European patent Applications hold true.

3. Disclosure through new media

3.1 Generally speaking the disclosure taking place through a paperless information, such as that spread off through internet, should be considered as validly opposable as prior art, but problems might exist:

- (i) the information on internet normally remains available for a short time and later on it may be impossible to find out even trace thereof;
- (ii) the source of the information is not certain unless it is accompanied by a properly identifying piece of information.

In all cases these problems are to be solved by those looking for a prior disclosure and if the certainty of the date and source of the prior disclosure cannot be given, then it cannot be considered as prior art in the sense of the Italian law.

3.2 If the information is encrypted this fact entails a difference in the sense that seemingly this information should not be considered a disclosure available to the public as taught by the law. Likewise the accessibility to the information subjected to a password or the like should not be considered a disclosure available to the public, unless the password is provided by third parties which might disclose it to anyone asking for, even under payment of a fee.

3.3 No limit exists as regards the place of disclosure, which in the case of the "new media" sometimes is not geographically defined.

3.4 The aspect of the timing has been already dealt with before. Nevertheless archives would be desirable, as an auxiliary means.

3.5 As already noted the fact that the information disclosed through internet may not be permanent raises problems of availability thereof as evidence of a prior disclosure of an invention. The opinion of the Italian Group is that special rules for internet would not be justified, because in that case special rules or provisions should be adopted for all cases in which the evidence of the prior disclosure may get lost in the long run. Any one shall remember when in the past alcohol based copying machines were used to make copies of documents, but the printed information was irremediably fading out and lastly disappearing in the time. Likewise some disclosures took place by having the information embodied in objects or machines which after a more or less long time got destroyed. In both these cases the loss of the information as prior disclosure was accepted. On the contrary the possible manipulation of information spread off through internet would require as above mentioned some measures to get a warranty of their authenticity.

4. Conclusion

The meaning of the word "disclosure" per se does not raise doubts and for this reason in the laws of every country it is used to indicate the way of making available to the public information which afterwards should be no longer the subject of a patent monopoly. Differences exist from country to country as regards the way in which the disclosure took place, the time at which it occurred and the like, and the Italian Group would welcome any effort to come to common standards as regards these aspects.

In this connection it is the opinion of the Italian Group that it would be proper if AIPPI would start studying this question since fruitful contributions from all countries of the world would be available.

As regards the specific problems connected with the disclosure taking place through the "new media" Italian Group is of the opinion that, likewise any new issue, no special rules should be established, but the existing general rules should apply also to this way of disclosure.

Résumé

Le mot "description" en soi ne donne pas de doute et, pour cette raison, est utilisé dans la loi des tout les nations pour indiquer comment sont publiées les renseignements qui, après, ne peuvent plus être objet d'un monopole de brevet. Il y a de différences entre les Pays pour ce qui regard la façon selon laquelle une description a lieu, le temps où a eu lieu et le groupe italien est heureux de tous les efforts pour obtenir des standards communs pour ce qui regard ces aspects.

A ça est liée l'opinion du groupe italien que serait bien que l'AIPPI commence à étudier ce problème, parce que contributions fructueuses seraient disponibles par toutes les nations.

Pour ce qui regard les problèmes particuliers liés avec des descriptions qui ont lieu par les "nouveaux moyens", le groupe italien est d'avis que, comme pour toutes les nouveautés, pas de nouvelles règles doivent être établies, mais les règles générales doivent valoir même pour cette façon de description.

Zusammenfassung

Die Bedeutung des Wortes "Beschreibung" ist an sich zweifelsohne, weshalb es im Gesetz jedes Landes benutzt wird, um auf den Weg hinzuweisen, Informationen zu veröffentlichen, die demnach keinen Gegenstand eines Patentschutz bilden dürfen. Unterschiede existieren zwischen den Ländern darüber, wie eine Beschreibung stattfindet, der Zeitpunkt, in dem sie passiert ist und dgl. Und die italienische Gruppe begrüsst jede Bemühung, um gemeinsame Standards zu diesen Tatsachen zu finden.

In dieser Verbindung ist die Meinung der italienischen Gruppe, dass es richtig wäre, falls AIPPI dieses Problem handeln würde, da ertragreiche Beiträge von allen Ländern in der Welt zur Verfügung wären.

Über die besonderen mit den durch die sogenannten "neue Mitteln" stattfindenden Beschreibungen verbundenen Probleme ist die Meinung der italienischen Gruppe, dass wie mit jeder Neuheit, keine neue Regel vorgesehen werden soll, sondern die existierenden generellen Regeln sollen auch für solche Beschreibungen gelten.

Report Q167

in the name of the Japanese Group

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of Prior Art

1.1 What is the effect of a prior art disclosure on novelty and inventive steps?

In accordance with Japanese Patent Law, a prior art disclosure is used as basic material for the assessment of novelty and inventive step. If a claimed invention in a patent application is the same as the invention disclosed in a prior art, the invention lacks novelty and if the claimed invention could, on the basis of the prior art, easily have been made by a person with ordinary skill in the art to which the invention pertains, such invention lacks inventive step.

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?

There are differences between prior art regarding novelty and inventive step. The technical field of the prior art regarding novelty is the same as that of the claimed invention but the technical field of prior art regarding inventive step is not necessarily the same as that of the claimed invention.

Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

A pending application which has not yet been published, but will be published later, affects only the novelty of an application filed after the pending application unless either the applicant(s) or invention(s) of the two applications is the same. If the inventors or the applicant are the same in two applications, the conflict will be solved not by the relationship with prior art but by the first-to-file principle.

1.2 Do the national laws give definitions or indications as to what constitutes a prior art disclosure?

Japanese Patent Law Article 29 defines that the following materials constitute a prior art disclosure:

- 1) Inventions which were publicly known in Japan or elsewhere prior to the filing of the patent application;
- 2) Inventions which were publicly worked in Japan or elsewhere prior to the filing of the patent application; and
- 3) Inventions which were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the patent application. Japanese patent law further defines that where a claimed invention in a patent application is identical to an invention disclosed in other application which was filed earlier than the patent application and laid-open to the public later, a patent shall not be granted for such an invention provided that inventor(s) or applicant(s) are not the same in the two applications.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

According to the patent law, an invention becomes a “prior art” if, prior to filing a patent application, the invention has been (1) publicly known (2) publicly worked or (3) described in a publication or on the internet.

These criteria are interpreted as follows.

As for “prior to filing”, the exact moment of the filing of a patent application is considered. Theoretically, a public announcement of an invention made in a morning can be a novelty bar to an application filed in the afternoon on the same day.

“Publicly known” means that the content of the invention is known to an unspecified person who has no secrecy obligation to the invention.

“Publicly worked” means that the invention was put into practice under the circumstance that the content of the invention was publicly known or that the invention was likely to be publicly known.

“Work the invention” means, in the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing or offering for assignment or lease of the product. In the case of an invention of a process, “work the invention” means acts of using the process.

“Publication” means an information transmitting medium such as a paper document or drawing which was copied or reproduced for the purpose of distribution and disclosure to the public. An electric recording medium such as CDROM on which information is electrically fixed should be included in the “publication”. A secrecy document with no distribution purpose or minutes of legal proceedings would not be a “publication”. If the unspecified general public has accessibility to a document, it is a published document even if it is a fact that no one has actually read the document. A case law says that the document which was printed and bound for publication but has not yet been dispatched or still in the publishers warehouse is not the “published document”.

“An invention described in a published document” is the invention grasped from the matter directly described in the document and the matter which is not clearly described but is deemed to be actually described. “The matter which is not clearly described but is deemed to be actually described” is what is elicited from the matter actually described in consideration of the common technical knowledge at the time of the distribution of the document.

Before the recent amendment of the Japanese patent law considering the ease of verification, only the novelty based on the published document was judged on worldwide basis and “publicly known and worked invention” was limited to the fact took place only in Japan. The law, however was amended in 1999 and the absolute novelty (while maintains Article 30 providing exceptions to lack of novelty of the invention, i.e. 6 months grace period) has been applied to the applications filed on or after January 1, 2001.

2. Criteria for disclosure

2.1 *Means of disclosure*

What are recognized means of disclosure?

There is no specific limitation to the means of disclosure. Any disclosure by means of oral statement, use of the invention, written document and the internet are recognized as disclosure.

Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?

In the cases of oral disclosure and use, it is necessary that the disclosure was made in public in a manner that the content of the invention was clearly understood. Convincing evidence such as paper memo recording tape etc. should support the fact of disclosure. The

disclosure must be beyond the secrecy state. In other words, it is necessary that the disclosure was made to a third person who does not have a secrecy obligation to the invention.

If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

Either by law or in practice, there are no means for disclosure which are not recognized as disclosure.

2.2 *Time of disclosure*

Does it matter if a disclosure has been made recently or a long time ago?

The timing of the disclosure does not matter.

Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step.

There is no such a limit beyond which a disclosure of prior art information is no longer relevant for the assessment of novelty and inventive step.

2.3 *Place of disclosure*

Is the place of disclosure relevant?

Because the current law adopts absolute novelty, regardless of the means of disclosure, the place of disclosure is not relevant to lack of novelty and inventive step.

How is the place of disclosure determined?

There is no necessity of determining the place of disclosure.

Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?

There is no difference if the disclosure was made by accident or intentional.

Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

It is the law of the country in which novelty and inventive step are assessed (i.e. Japanese law).

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art?

In the case that the disclosure of an information is made prior to filing a patent application, there is no difference if the disclosure is made by the IPR applicant or third person. Though the responsible person of the disclosure influences the grace-period, it is not the subject of the current question.

Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

Even if the disclosing person was bound by a confidentiality agreement, the disclosure to a third person who is not bound by the confidentiality agreement is not handled differently.

How are errors in the disclosed information treated?

Basically, what is disclosed in a document is understood as it is. However, if what the correction should be is self-evidently clear, the error should be handled as corrected. A case law says that incorrect information should not be used as an evidence for judging a novelty

if a skilled person in the art cannot easily tell the true description or the ordinary skilled person can only tell that the description is incorrect.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information?

Basically, the ability to understand the information does not matter. When a product based on an invention is put into a state in which the content of the invention can be recognized by unspecified third person, the invention loses its novelty even if the content of the invention was not known in fact to the public. However, as far as the public secrecy is maintained, the novelty of the invention is not lost if a third person who accessed the invention are those who apparently cannot understand the invention.

Is the possibility that a person might obtain the information through additional steps such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?

We observe that the answer to this question is case-by-case. In the case that additional steps required for the disassembly of embodiments or the reverse engineering are simple and well-known to the ordinary skilled person in the art, the invention would lose the novelty. On the other hand, the novelty of the invention would not be lost when the embodiment is destroyed and the invention can not be understood by the disassemble or reverse engineering.

Are there general rules providing for the effect of confidentiality or implied confidentiality?

The disclosure bound by a confidentiality agreement does not comprise the loss of novelty. However, the invention loses the novelty once a person who has been bound by the confidentiality agreement is released from the agreement. Also, a case law says that the implicit confidentiality agreement includes a state that keeping the secrecy is implicitly required and expected in accordance with the social standard or business practice.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step?

A recording medium such as CD-ROM on which an information is electrically recorded is handled as "the published document" in Japan. The information sent via one-way information transmission such as TV would be "publicly known". The revised Japanese patent law defines that the information obtained only by interactive communication, e.g. the internet, constitutes the novelty bar.

Are there specific requirements compared to other forms of disclosure?

As will be explained later, special considerations are required to evaluate the disclosure through new media in light of the different accessibilities to the information, likelihood of deletion or revision of the information.

Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

It is believed that the information loses the novelty if it is accessible to the public. For example, e-mail would not be accessible to the public because it is usually used for mere communication between private individuals. However, e-mail communications by so-called "mailing list" would be publicly accessible information because the e-mails are dispatched to unspecified registered individuals.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted?

Except that an unspecified person is entitled to obtain a tool or key for decryption, the encrypted information is not the publicly accessible information.

What relevance do passwords, search engines and payment requirements have?

The web site that requires a password is publicly accessible as far as an unspecified person may obtain the password.

Only a web-site the URL of which is obtainable by any unspecified person is “publicly accessible.” If the URL of a web-site is registered on a search engine, the web-site would be publicly accessible because the internet users may reach the site by using, for example, key-word search on the search engine. Similarly, a web-site linked by another web-site which is accessible by any unspecified person would also be “publicly accessible”.

The payment requirement, i.e. if the web-site is pay-site or free-site, does not affect the “public accessibility” judgement.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet?

The information which is available to the public through electric telecommunication lines not only in Japan but also in elsewhere in the world affect the novelty. We observe that the “place of disclosure” is not the place where server computer is located but the place from which the data is accessible.

Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

Based on the absolute novelty criteria, the information which is accessible to the public from anywhere in the world affect the novelty under the Japanese patent law.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means?

The information disclosed on the internet for a very short time is not the publicly accessible information. The duration of the information must be long enough. We believe that the duration of the time should be evaluated not only by the time but also other factors such as the accessibility of the web-site. There is no requirement as for the timing of accessibility to the information.

Are archives necessary or desirable?

For novelty evaluation purposes, the archive of cited information is not required. The JPO examination guideline requires that the electric information should be printed in a paper document if the examiner wishes to cite it.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet?

In the PTO prosecution, the burden of proof that a specific piece of information was disclosed on the internet is basically on the examiner who is going to cite the information. The examination guideline requires that the examiner has to study the likelihood of manipulation of the information disclosed on the internet, i.e. content of the information and uploading date of the information, and the information can be cited only when the examiner is convinced that the possibility of manipulation of the information is very slight. If the applicant raises a question about the reliability of the content of the information or the uploaded date, the examiner has to study the possibility of manipulation and if he/she any longer cannot be convinced of the credibility of the information, the information should be withdrawn from the evidence.

Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways?

Considering the fact that the permanency of the information on the internet is quite low compared to, for example, the paper document, the cited information is printed out and preserved with necessary information for assuring its credibility.

Should there be different levels of evidence for different ways of disclosure?

In accordance with the ways of disclosure and the source of the information, the levels of required evidence would differ.

Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

To minimize the possibility of manipulation of the information obtained via new media, the JPO examination guideline sets out following criteria.

- i) Information on the web-site of an official or quasi-official organization which is not likely to be manipulated is presumed to be the original.
- ii) If the examiner is not confident of the originality, i.e. possible manipulation of the content the web-site, he/she may contact the responsible party of the web-site to confirm the reliability of the information.
- iii) Once the examiner decides to cite the information on the internet, he/she prints out the information and inscribes necessary information such as name of the examiner, time and date of the access and URL of the web-site onto the printed document.
- iv) The paperless information cited in the Office Action etc. are thereafter stored in the data base of the patent-related document in the Japanese Patent Office.

Summary

The Japanese Patent Law classifies the prior art into three categories, i.e. publicly known invention, publicly worked invention and the invention described in a distributed publication. The geographical standard for the novelty has been widened to the world basis (absolute novelty) by the 1999 amendment. The amendment also introduced a new novelty criteria "the invention available through internet".

The invention identical to what is disclosed by the prior art lacks the novelty and the invention that could have been easily made by a skilled person in the art lacks the inventive step.

A pending application that has not yet been published is the prior art to the application filed later. The earlier filed applications, however, can not be the basis of the inventive step. If co-pending applications are filed by the same applicant or the same inventor, the problem is solved not by the question of the prior art but by the double patenting or first-to-file principle.

The Japanese Patent Office has issued a guideline for handling the information available through internet but various questions that have not yet been solved are pointed out with respect to the prior art available only through the internet.

The group observes that the current Japanese Patent Law provides one of the most advanced criteria for the prior art disclosure but there are various questions to be solved by the practical experiences and case laws.

Résumé

Le droit des brevets japonais divise l'art antérieur en trois catégories: les inventions de notoriété publique, les inventions utilisées et les inventions présentées dans une publication imprimée. La norme géographique de la nouveauté a été élargie à l'échelle mondiale (nouveauté absolue) avec l'amendement de 1999. Cet amendement a également introduit un nouveau critère de nouveauté, à savoir celui "d'invention disponible sur Internet".

L'invention conforme à l'art antérieur ne satisfait pas au critère de nouveauté et l'invention qui aurait pu être facilement découverte par un homme du métier ne satisfait pas au critère d'étape inventive.

Une demande en attente qui n'a pas encore été publiée constitue l'art antérieur à la demande qui sera déposée ultérieurement. Les demandes antérieures ne peuvent toutefois pas servir de fondement à l'étape inventive. Si des co-demandes en attente sont déposées par le même demandeur ou le même inventeur, le problème est résolu non pas par la question de l'art antérieur mais par le principe de double protection par brevet ou de premier déposant.

L'office des brevets japonais a émis une directive permettant de traiter les informations disponibles sur Internet. Cependant, cela a fait ressortir diverses questions concernant l'art antérieur disponible uniquement sur Internet qui étaient restées sans réponse.

Le groupe remarque que le droit des brevets japonais en vigueur fournit l'un des critères les plus avancés en termes de divulgation de l'art antérieur mais de nombreuses questions devront être résolues dans la pratique et par la jurisprudence.

Zusammenfassung

Das Japanische Patentgesetz unterteilt den Stand der Technik in drei Kategorien, d.h. öffentlich bekannte Erfindungen, öffentlich vorbenutzte Erfindungen und Erfindungen, die in einer Veröffentlichung beschrieben sind. Der geographische Standard für die Neuheit wurde auf den Weltstandard (absolute Neuheit) durch die Änderung von 1999 erweitert. Die Änderung führt auch ein neues Neuheitskriterium "die Erfindung war im Internet verfügbar" ein.

Die Erfindung, die mit dem übereinstimmt, was im Stand der Technik offenbart ist, weist keine Neuheit auf und die Erfindung, zu der ein Fachmann in einfacher Weise gelangt, weist keinen erfinderischen Schritt auf.

Eine anhängige Anmeldung, die noch nicht veröffentlicht ist, gehört für die Anmeldung, die später eingereicht wird, zum Stand der Technik. Die vorher eingereichten Anmeldungen können jedoch keine Basis zur Beurteilung des erfinderischen Schritts sein. Wenn mehrere Anmeldungen, die durch den gleichen Anmelder oder gleichen Erfinder eingereicht werden, anhängig sind, wird das Problem nicht durch die Frage des Standes der Technik sondern durch die Frage, ob eine Doppelpatentierung vorliegt, gelöst oder durch das Prinzip des ersten Einreichens gelöst.

Das Japanische Patentgericht hat eine Richtlinie zur Handhabung von Informationen, die durch das Internet erhältlich sind, herausgegeben. Es wurden jedoch noch viele Fragen, die bezüglich des Standes der Technik, der nur im Internet zur Verfügung steht, bis jetzt noch nicht gelöst wurden, herausgestellt.

Die Gruppe verweist darauf, dass das derzeitige Japanische Patentgesetz eines der fortschrittlichsten Kriterien bezüglich der Veröffentlichung des bekannten Standes der Technik vorsieht, aber es bestehen viele Fragen, die durch praktische Erfahrung und Fallentscheidungen gelöst werden müssen.

Report Q167

in the name of the Dutch Group
by D.J.B. Bosscher, J.L. Lobatto, H.A.M. Marsman, C.S.M. Morel, L. Oosting,
H..W. Prins (chairman), F.I.S.A.L. van Velsen, R.E. Weening, and M. van Wijngaarden.

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

This report is based on a draft prepared for the Netherlands group by a working group. The working group consisted of:

I Legal frame work

1. The Netherlands Kingdom Patent Act (ROW 1995) does not provide for specific protection of (the technical features of) utility models¹, nor does other Netherlands legislation. Utility models will not be dealt with further in this report.
2. As of the entry into force of the ROW 1995 on 1 April 1995, no substantive examination of Dutch patent applications takes place by the national Patent Office ("*Bureau voor de Industriële Eigendom*"). Until that time, applications were subject to detailed examination as to their compliance with the material requirements for patentability (primarily novelty and inventiveness). Material examination of patents granted under the ROW 1995 shall take place retro-actively by civil courts.
3. The ROW 1995 draws a distinction between patents for which the applicant requests the Office to perform a search of the state of the art with respect to the subject matter of the patent application prior to grant of the patent, and patents for which no such request is made. These latter patents are defined as so-called 'short-term' patents.
4. A 'short-term' patent shall be granted by signing and affixing the date to the application in the form of a patent specification. The short-term patent shall remain in force until the expiry of six years from the date of filing.
5. If a search of the state of the art is performed, the applicant is informed of the results by the Office prior to grant. There is no obligation for the patentee to take account of the results of the search. Patents for which a state of the art search has been performed shall remain in force until the expiry of twenty years from the date of filing.
6. A claim of the proprietor for infringement of a Dutch patent is only admissible in a court proceeding if the proprietor submits a search report on the state of the art with regard to the subject matter of the patent. This means that the proprietor of a short term patent has to obtain a search report before his claim is admissible in court proceedings.
7. Patent rights extending to the Netherlands territory can also be obtained via PCT and European Patent Office (EPC) applications.

¹ The aesthetic forms of an article model are protected on the basis of the Netherlands Copyrights Act or the Benelux Drawings and Designs Act and the doctrine of so-called shameless imitations.

8. In the Netherlands there can thus exist four kinds of patents: (1) a Dutch “short term patent” with a maximal duration of six years, (2) a Dutch patent with a maximal duration of twenty years which is the same for (3) a European patent where the Netherlands is designated, and (4) a patent filed via the PCT route in which the Netherlands is designated as part of the European patent region.
9. In a recent decision the Court of Appeal of The Hague held that patents granted pursuant to the ROW 1995 have the same legal significance as patents which have undergone substantive examination, such as European patents or patents granted under the previous Netherlands Patent Act 1910².
10. The ROW 1995 provides that inventions which are novel, inventive and susceptible of industrial application are patentable. Its provisions are applicable to all four types of patents mentioned above. A European patent - which has been subjected to substantive examination - designating the Netherlands has the same legal consequences as patents granted under the ROW 1995 and is governed by the same legal provisions. As far as nullity grounds are concerned, however, the ROW 1995 provides that patents shall be nullified if they do not comply with the material requirements listed in the ROW 1995, or, if it concerns European patents, with the requirements from articles 52-57 EPC. According to some this implies that case law from the European Patent Office (EPO) on issues such as novelty and inventive step should play a different role in Dutch legal proceedings dependant on whether a Dutch or European patent is at stake. In practice, however, the working group is not aware of substantial differences in approach in legal proceedings. EPO case law often plays an important role in Dutch legal proceedings, although it will not be discussed separately in this report.

II. Answers to the proposed questions

II.1 Determination of prior art

Introduction

11. The Netherlands working group defined novelty, disclosure and inventive step as follows:
 - a) **Novelty:** “Subject matter that is not directly, explicitly or implicitly derivable from the state of the art.”
 - b) **Inventive Step:** “The non-obvious solution of a problem given the closest state of the art in respect of said problem.”
 - c) **Prior art disclosure:** “Anything made available to the public by whatever means.” The working group is of the opinion that the individual knowledge and capacities of the recipient are to a certain extent relevant to the question whether something has become available to the public. There is lower case law indicating that “made available to the public” means that random third parties must have had access to the information concerned and must have been able to realize what the invention consists of³. The working group takes the position that the information concerned should be reproducible by the recipient.

Question 1.1⁴:

What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications that have not yet been published affect the assessment of novelty and inventive step?

² Court of Appeal of The Hague, 20 September 2001, Koppert/Boekestein. In The Netherlands all patent litigation is concentrated before the District Court of The Hague (first instance) and the Court of Appeal of The Hague (appeal). A final appeal before the Supreme Court is possible on issues of law only.

³ District Court of The Hague, 28 June 2000 and 14 February 2001, Texincare Sales/Deltex (currently being appealed).

⁴ The questions are numbered following the sequence and numbering of the Working Guidelines for Questions 167.

12. Each piece of prior art can be detrimental for the required novelty. For the establishment of inventive step, only prior art in the same or neighbouring technical fields (and addressing or relating to the same problem as the invention claimed) will be taken into account when examining the subject-matter of the patent or the patent-application. Prior art disclosures will not affect the inventive step when the prior art is in a remote field of the art or is in a neighbouring field, yet deals with a completely different objective (or problem).
13. Article 4 (3) ROW 1995 provides that the state of the art shall also comprise the contents of previously filed applications that have been entered in the Dutch patent register on or after the date of application. Article 4 (4) ROW 1995 states that the state of the art also comprises the contents of European and international applications wherein the Netherlands is designated and have been published on or after the date of application⁵.
14. Pending applications that have not been published can thus affect the assessment of novelty.
15. Article 6 ROW 1995 states that such pending applications (whether national or international) belonging to the state of the art shall not be taken into consideration in assessing inventive step.

Question 1.2:
Do the national laws give definitions or indications as to what constitutes a prior art disclosure?
16. Article 4 (2) ROW 1995 states that *“the state of art shall comprise everything made available to the public by means of a written or oral description, by use or in any other way before the date of filing the application”*.

Question 1.3:
Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law, which have been developed in various countries for determining a disclosure.
17. There are no guidelines in the ROW 1995 other than the legal definition and the exception as set forth in Article 5(1) ROW 1995, namely the situation of abuse and the international exhibition exception.
18. From case law it appears that a piece of prior art is generally considered to have been disclosed if a random third party could have (had) access to the prior art. It is not relevant whether the third party has indeed noticed the prior art; essential is that the possibility existed. Hence, inclusion in a library makes a document publicly available, while submission to an individual who is not free to redistribute the document does normally not.
19. As set out above (paragraph 11(c)) the working group is of the opinion that the individual knowledge and capacities of the recipient and the ability to reproduce the information are relevant to the question whether something has become available to the public.
20. There is first instance case law implying that the material of which a product (bed cover) was made that had been tested in a public area (a hospital), was not made publicly available because the users (medical personnel, patients) and visitors would not normally cut the cover open to investigate its contents⁶. Furthermore in another first instance decision it has been decided that an unknown process or product that is inherent to a known process is only considered to be part of the state of the art if the skilled person would have a reason to search for the process or product concerned and he could find the process without undue

⁵ This corresponds to Article 54(3) EPC, which will however be changed following the Diplomatic Conference of November 2000.

⁶ And thus, could not have realized what the invention consisted of; District Court of The Hague, 28 June 2000 and 14 February 2001, Texincare Sales/Deltex.

burden⁷. There is an ongoing discussion amongst legal practitioners in the Netherlands whether these interpretations of the state of the art definition are correct.

21. An example of an exception is the situation in which the applicant and a second party are contractually bound to keep a document or specific information confidential and this second party discloses the subject matter in breach of his contractual obligation. It is clear that such disclosure establishes an evident⁸ abuse as stated in Article 5 (1) ROW 1995 (corresponding to Article 55 (1) EPC). Consequently the disclosure is disregarded. If there is no written agreement, an implied confidentiality obligation can under circumstances be accepted if the existence of this obligation is made sufficiently plausible.
22. It is the working group's impression that the EPO is somewhat less strict than the Netherlands courts given that the EPO more quickly accepts the notion of implied secrecy. For example, results of a meeting between the boards of two USA companies were assumed to be confidential, though it will be hard to prove that parties meant to keep a discussed specific piece of information confidential⁹.
23. In this respect the Netherlands working group believes that Article 39 of the TRIPS Agreements may serve as guidance. Article 39 grants protection to undisclosed information. Article 39 (2) identifies when information is considered to be 'undisclosed'. Information is undisclosed as long as such information is secret in the sense that it is not, as a body or in the precise configuration of its components, generally known among or readily accessible to persons within the circles that normally deal with this kind of information and reasonable steps have been taken by the person lawfully in control of such information, to keep it secret.

II.2 Criteria for disclosure

Question 2.1: Means of disclosure

What are the recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

24. Article 4 (2) ROW 1995 indicates that disclosure can take place by a written or oral description, by use or in any other way. The means of disclosure are unlimited. The Netherlands working group is of the opinion that the means of disclosure are not relevant in order to determine whether information is disclosed. The definition of Article 4 (2) ROW 1995 implies that the disclosed information should be perceptible by sense. This should be taken literally: by hearing, vision, smell, taste etc. Any disclosure that is unrestrictedly perceptible or accessible by whatever means can be considered to be a disclosure in the legal sense. Thus the information derivable from an article sunk to the bottom of the ocean belongs to the state of the art if it can be reached and observed by any known diving technique.
25. It is further not relevant whether the proprietor of the information had an intention to disclose it. However, the Netherlands working group is of the opinion that it is relevant to what extent the proprietor of the information takes steps to protect confidential information (see also Article 39 TRIPS). Reference is made to a decision of the Netherlands Patent Board ("*Nederlandse Octrooiraad*") with respect to a potato machine. The construction and functioning of this machine could be seen from the public road (through a fence) and it was therefore considered disclosed (taking away the patentability of a claimed invention), although the proprietor had placed a no entrance sign. The Netherlands working group feels

⁷ District Court of The Hague, 17 January 2001, Kirin Amgen / Genetics Institute.

⁸ In the Group there was discussion whether the right word is *evident*, and not *clear*. E.g. the different authentic versions and translations of the EPC give rise to this question. The Group did not come to unanimous decision whether evident vs clear implies a heavier burden of proof.

⁹ Case law: decision of the Opposition Division (Cordis / Terumo and Boston Scientific) of September 22, 2000 in view of EP 03362826.

that the situation would be judged differently if the machine was invisible from outside, e.g. placed in a private garage.

Question 2.2: Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

26. The period of time lapsed between the moment on which a disclosure became publicly available for the first time and the filing date of a patent is not relevant for the assessment of novelty. A publication of a piece of information, irrespective of its form, constitutes a prior art disclosure, when it is perceptible to the senses. Such a public disclosure should be given the meaning that it has on the priority date of the claimed invention for which it is considered state of the art¹⁰. This means that the question which implied information is contained in a disclosure is also to be assessed at the priority date.
27. The period of time lapsed between the publication of a piece of information may be relevant for the assessment of inventive step. Experience learns that the seniority of the document affects the inventive step assessment in the way that it is less likely that such old document is relevant for the required inventive activity.

Question 2.3: Place of disclosure

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

28. Once it has been established that information has been disclosed, it is not relevant where in the world the disclosure has taken place. The place is not relevant in this respect.
29. Whether information is considered to be disclosed, however, is dependent on the law applied to assess the supposed act of disclosure. Under Dutch international private law rules (conflict of law rules) a Dutch court should assess by applying Dutch law where an act has taken place. Subsequently the Dutch court should apply the law applicable to the alleged disclosure to the question whether something was indeed disclosed (which law is to be applied should be assessed under the law of the place of disclosure as determined by the Dutch court; this assessment may lead to applicability of yet a different set of rules). Thus, the question whether information provided during a foreign shareholders' meeting should be considered confidential or not could e.g. be assessed under the law of the corporate statute of the corporation concerned. Whether a confidentiality agreement governed by foreign law has been breached or not should be assessed under the law applicable to the agreement. In the event of a publication it will generally be assumed that the contents thereof could be known to third parties without restrictions.

Question 2.4: Personal elements

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

30. There are no differences other than the legal exceptions as stated in Article 5 (1) ROW 1995 (see also question 1.3). Article 5 (1) ROW provides that a disclosure shall be disre-

¹⁰ One of the members of the Group and practitioners defended the opinion that a document should be given the meaning of its statements at the time of publication of the document when deciding novelty. A particular statement or term used in a document only has the meaning given by the author at the moment of writing and not necessarily at a later date.

garded if it occurred no earlier than six months prior to the filing of the patent application as a direct or indirect consequence of an evident abuse¹¹.

31. Information obtained from a party breaching a confidentiality agreement will constitute evident abuse and shall be disregarded¹².
32. Errors in disclosed information are not harmful for the requirement of novelty, if it is clear from the whole context that an error has been made. If this is not clear to a skilled person, then errors in disclosed information may harm the novelty of the claimed invention. Errors in a summary will constitute prior art that may affect the presence of an inventive step, even if that article is a summary of another disclosure not containing the error.

Question 2.5: Recipient of information

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

33. The Netherlands Patent Act does not contain any legal requirements regarding the ability to understand the information other than the level of understanding as presumed by the so-called skilled person. As identified above, case law requires that the recipient must have been able to realize what the invention consists of. The Netherlands working group is of the opinion that the recipient should be able to reproduce the information in some form.
34. The Netherlands working group further believes that at the moment something has been made public, every feasible method of analysis, including but without limitation disassembly and reverse engineering, will be allowed to obtain (further) information therefrom.
35. The effect of an express or implied confidentiality obligation (if sufficiently evidenced) has been discussed above. Information provided under an obligation of confidentiality is not considered to have been made available to the public.

II.2 Disclosure through new media

Question 3.1: General rules

Does paperless information, e.g. in an electronic network or through the Internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of network or communications such as the World Wide web, chatgroups or forums, e-mail and others?

36. There are as of yet no specific rules nor case law on the effect of disclosures in an electronic network or through the internet. In general, the Netherlands working group is of the opinion that the same rules apply in an electronic or internet environment as would apply in a paper environment. This is in line with the position generally taken by legal practitioners in related fields of intellectual property.
37. As stated in the response to question 2.1, the means by which the information is disclosed are not relevant for the assessment whether the information has been disclosed. The decisive factor is whether the information has been disclosed and whether a recipient is able to reproduce this piece of information.

¹¹ In a decision dated 23 June 1995 (ARS / Organon), the Netherlands Supreme Court held that under Article 5(1) ROW 1995 the priority date rather than the date of the application should be taken as the starting point for the calculation of the six months' term. However, in G 3/98 the Enlarged Board of Appeal of the EPO held that for the corresponding Article 55(1) EPC the actual filing date of the application is the relevant date.

¹² Whether confidential information that is forwarded by a breaching party to a third party which further discloses this information in good faith shall be disregarded or not under the legal exception of evident abuse is open to discussion. Within the working group there was no consensus.

38. The intention of the proprietor of the information to disclose the information is not decisive. More important is whether and to what extent the proprietor of the information has taken steps to protect confidential information. This basic rule leads to the following opinion of the Netherlands working group.
39. The information that circulates within a chatgroup should be considered as disclosed and therefore affects the novelty unless the members of the chatgroup are bound to keep this information confidential. The same applies to forums.
40. The situation with respect to e-mails may be different. The Netherlands working group feels that e-mails can only be considered as not disclosed when they fall within the protection of Article 13 of the Netherlands Constitution / Article 8 of the European Convention on Human Rights (privacy of correspondence) or when the sender took sufficient measures to prevent disclosure, for example by means of passwords and decoding or encryption. Until there is case law to the contrary, it is assumed that information provided by means of regular email (unprotected) cannot be considered comparable to a "sealed" letter, because of the theoretic electronic availability of such information for those seeking to find it.
41. Article 13 of the Dutch Constitution regulates the privacy of correspondence. As the interpretation of privacy of correspondence is very strict, new forms of digital communication (e.g. fax and e-mail) are currently excluded. In a proposed amendment to Article 13 of the Constitution, it is suggested to replace the existing privacy of correspondence, telephone and telegraph by "confidential communication".
42. By Royal Decree of 23 February 1999, the Committee for "Fundamental Rights in the Digital Era" was charged with advising the government on (1) the adaptation of the fundamental rights in Chapter 1 of the Constitution and (2) the desirability of establishing new fundamental rights. In its report, the Committee suggested a technology-independent transformation of Article 13 Constitution into a general right to confidential communication, which comprises all forms of communication that are "objectively speaking" eligible for confidentiality.

Question 3.2: Questions of confidentiality

Does it make a difference if the information is encrypted? What relevant do password, search engines and payment requirements have?

43. There is no case law as of yet. The Netherlands working group is of the opinion that encrypted information is not by nature publicly available, which holds for information which is only accessible with a secret combination of a login and password as well. If such information can subsequently be freely distributed by the recipient, however, it may be considered as disclosed (like any other communication of information not accompanied by a confidentiality obligation). If information can be found with a search engine or can be obtained through payment this constitutes an a priori assumption that the information is not confidential and/or is publicly available.

Question 3.3: Place of disclosure

What is the place of disclosure if the information is put on the Internet? Is the mere fact that a web-site can be assessed in a certain place sufficient for a disclosure in that place or should there be additional conditions requirements?

44. There is no case law as of yet. The place of disclosure may be relevant for determining the day at which the disclosure became part of the state of the art. When in New Zealand a disclosure is put on the internet in the morning, then it may be downloaded from the internet "the day (date) before" in Europe and the United States. The Netherlands working group is of the opinion that the effective day on which this disclosure entered the state of the art is the local date it was put on the internet on the place of disclosure.

Question 3.4: Timing of disclosure

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

45. There is no case law as of yet. The Netherlands working group is of the opinion that the transience of the medium is not relevant for the question whether information has been made available to the public. However, the nature of the medium will have effect on the ability of a party to present reasonable evidence to support its claim that this piece of information has been made public through the internet.

Question 3.5: Questions of evidence

Who should have the burden of proof that a specific piece of information was disclosed on the Internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

46. On the basis of the Netherlands Code of Civil Procedure (Article 177) the burden of proof as to the correctness of a claim rests with the party that makes the claim. This party should submit sufficient evidence to support its claim that the information was disclosed on the Internet.

Report Q167

in the name of the Norwegian Group
by Arild TOFTING and Morten BALLE

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

- 1.1 Prior art made publicly available before the priority date of the application affects the assessment of both novelty and inventive step. National pending applications, which have not yet been published at the priority date of the application but are published later, affect the assessment of novelty but not the inventive step.
- 1.2 The Norwegian Patents Act has a broad definition of what constitutes prior art disclosure. Prior art is defined as follows: „Everything made available to the public, either in writing, orally, by exploitation or otherwise, shall be considered as known.“
- 1.3 The Norwegian Patent Office has adopted internal guidelines based on the Guidelines for Examination from EPO. The section that is related to publicly availability is more or less a direct translation of the EPO Guidelines.

2. Criteria for disclosure

- 2.1 The means of disclosure that have an impact on novelty and inventive step are rather unlimited. No means of disclosure are excepted even if it may be difficult to substantiate the disclosure.

Necessary testing of an embodiment is an exception from the rule that the novelty is damaged if the invention has been made available to an unlimited circle of people. If the applicant /inventor can substantiate that they have made some effort to avoid public availability during the testing. The fact that the invention has been available to the public despite of said effort, the invention is not regarded as publicly known.

- 2.2 According to Norwegian Patent Law and practice there is no age limit on prior art disclosures with regard to the assessment of novelty and inventive step. However, the fact that two citations are old and that the need has existed for a number of years may be used as an argument against an obviousness rejection.
- 2.3 A public disclosure anywhere is regarded as a public disclosure for the assessment of novelty and inventive step. Norwegian law is applicable for the determination whether a disclosure has occurred.
- 2.4 The Norwegian Patents Act makes no difference whether the information is disclosed by the applicant, inventor or by any other person. However, a six months “grace period” may be granted if information about the invention is given by evident abuse by someone breaking confidentiality or if the invention is disclosed through display of the invention by the applicant or his predecessor in title at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions, Paris, November 22, 1928.

To be damaging for the novelty and inventive step a piece of information has to be an enabling disclosure. If the disclosure is not enabling due to errors and the correction of the errors are not obvious for the skilled man in the art, an erroneous disclosure will not be damaging.

- 2.5 The fact that the invention has been made publicly available is sufficient to damage the novelty even if it is impossible to prove that anyone has actually seen or accessed the information. If the information has been made available to a indefinite group of people it has been made publicly even if it is not proved that any of the recipients actually have understood the information.

If an embodiment of the invention is publicly accessible and it is possible to disassemble the embodiment to reveal it, it is regarded as a disclosure. Publicly availability of an embodiment of an invention making it possible for the man skilled in the art to reverse engineer the invention is regarded as a disclosure even if the embodiment has to be disassembled. If it is not possible for the skilled man to reverse engineer the invention without disassembling the embodiment and special efforts has been made to avoid such disassembling, the fact that such an embodiment has been used publicly is not regarded a disclosure.

As mentioned in paragraph 2.4 a disclosure made by evident abuse may give the inventor / applicant a six month "grace period", such as breaking a confidentiality agreement or implied confidentiality.

3. Disclosure through new media

- 3.1 Principally there is no difference if the information is available on paper or as paperless information in an electronic network or through the internet. The question to be answered is if the information has been made available to the public or if it was only made available to a limited group of people under direct or implied obligation to keep the information confidential.

Networks and communication such as www, chat groups, forums or e-mail, may be either publicly available or available only to a limited group of people. E-mail sent to an incorrect address may damage the novelty. Principally information laid open at the internet at a page that is not protected by a password, or in an open chat group or forum, is regarded as publication even if the page has not been visited by anyone.

- 3.2 See above.

- 3.3 The place of disclosure is irrelevant for the assessment of novelty and inventive step for disclosures at the internet as for printed or oral disclosure.

- 3.4 There is no requirement for the timing and duration of information available through electronic means. To prove that information has been made available through the internet or to substantiate dates for changes of e web-site and the content thereof, archives is desirable.

- 3.5 The party invoking the piece of information have to proof or substantiate that the piece of information has actually been made publicly available before the priority date of the application.

We do not see that there is no need for special rules for oral disclosure or disclosure in other ways. Evidence or substantiation of the publication through new media will be examined the same way as other kinds of proof or substantiation. In cases of doubt a judgement will be made on the basis of the available evidence or substantiation and contributions from the parties involved.

4. Conclusion

The Norwegian law and practise is mainly in conformity with and well harmonised with the European law and practice in this field. Harmonisation on a global basis will however be desirable.

Summary

The Norwegian Patents Act has a global novelty requirement. Information made publicly available anywhere in any language is therefore relevant in the assessment of novelty and inventive step.

There are no specific requirement for the format of the information and all kind of information either written, oral, or in electronic form is regarded the same way.

Report Q167

in the name of the Paraguayan Group

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

1. Determination of prior art

1.1 a) *What is the effect of a prior art disclosure on novelty and inventive steps?*

The state of prior art disclosure has a harmful effect on the invention, since it destroys the novelty and in view of its awareness, the invention would be obvious for any professional of the field.

b) *Are there differences between prior art regarding novelty on one hand and inventive step on the other hand?*

Yes, there are differences, since the law establishes that an invention is a novelty if there is no previous record in the state of prior art, due to which any disclosure, by any means whatsoever, affects the novelty; whereas a simple disclosure of the invention does not affect a patent's inventive level.

c) *Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

Yes, they may, since the final examination also comprehends the search for background information between the pending applications, filed prior to the examined patent.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art?*

Yes, in Art. 7 of the Patent Law

The novelty. The novelty of an invention shall be considered if it has no priority in the state of prior art.

The state of prior art shall embrace everything that has been disclosed or made available to the public, anywhere in the world, through tangible publication, oral disclosure, sales or trading, use or any other means, before the filing date of the patent application in the country, or as the case may be, before the filing date of the prior application, which priority is invoked.

In order to appreciate the novelty of the invention, the state of prior art shall also comprehend the content of a pending patent application at the Industrial Property Office, which filing date or priority should be prior to the application under examination, but only to the extent to which the content is included in the prior application at the time of publication.

The state of prior art will not embrace what has been published within the year prior to the filing date of the application in Paraguay or within the year prior to the filing date of which priority is invoked, as long as said disclosure would have resulted directly or indirectly from actions carried out by the inventor itself or its beneficiary, or from the non fulfilment of a contract or illicit action against any of them.

The disclosure resulting from the publication carried out by an industrial property office in a proceeding of concession of a patent is not comprehended in the exception of the preceding paragraph, unless the application that was subject of said publication would have been filed by someone with no right to obtain the patent or that the publication would have been done by mistake, which is attributed to said office.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

The only standards established by the law are: the disclosure, tangible by any means, and the degree of access of the public to the invention.

2. **Criteria for the disclosure**

2.1 *Means of disclosure*

a) *What are recognized means of disclosure?*

Tangible publication, oral disclosure, sales or trading, use by any other means.

b) *Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?*

The law does not establish additional requirements.

c) *If certain means of disclosure are not recognized either by law or in practice, what are the reasons?*

The law is very clear in this regard, when mentioning that the disclosure may be carried out in any way, due to which it does not exclude any means of disclosure.

2.2 *Time of disclosure*

a) *Does it matter if a disclosure has been made recently or a long time ago?*

The time of disclosure has its importance, since the law establishes the following:

The state of prior art does not cover what was disclosed within the year prior to the filing date of the application in Paraguay or within the year prior to the filing of the application, **as long as said disclosure was carried out by the inventor or its beneficiary or it would have resulted from an illicit action.**

b) *Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and the inventive step?*

Any disclosure carried out after the publication date of the patent no longer affects its novelty.

2.3 *Place of disclosure*

a) *Is the place of disclosure relevant?*

No, it is not important.

b) *How is the place of disclosure determined?*

Since the place of disclosure is not important, it is not necessary to determine it either.

c) *Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?*

Yes, it does, since the information accidentally or intentionally placed through an illicit action is not comprehended in the state of the prior art.

d) *Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?*

The law to be enforced is the one of the country in which these requirements are evaluated.

2.4 *Personal elements*

- a) *What differences does the Group observe with regard to the person who discloses the prior art?*

The Law establishes that if an invention is disclosed by the inventor or its beneficiary within the year prior to the filing, it is not comprehended in the state of prior art.

- b) *Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?*

The disclosure carried out by a person who bears an agreement of confidentiality is not considered to be comprehended in the state of prior art.

- c) *How are the errors in the disclosed information treated?*

The errors of the disclosed information are not comprehended in the state of prior art.

2.5 *Recipient of the information*

- a) *What requirements are there with regard to the ability to understand the information?*

The Law does not establish anything in this regard.

- b) *Is it possible that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?*

Yes, it is possible, but the actions carried out by a person without the authorization of the inventor or the owner of a patent constitutes an infringement and an illicit action, and therefore, it can not be considered a disclosure that affects the state of prior art.

- c) *Are there general rules providing for the effect of confidentiality or implied confidentiality?*

The Law establishes rules of confidentiality for public personnel that have access to the patents. Disclosure of the patent carried out by these people is considered an infringement by this law.

3. **Disclosure through new media**

3.1 *General rules*

- a) *Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step?*

Yes, it could, since this is a way of access to any type of information and therefore it constitutes one more mean of disclosure.

- b) *Are there specific requirements compared to other forms of disclosure?*

No, they are the same.

- c) *Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?*

There are no differences, since tangible and complete disclosure of an invention that can be proved destroys the novelty of the patent.

3.2 *Questions of confidentiality*

- a) *Does it make a difference if the information is encrypted?*

Of course, since the common public does not have access to it.

- b) *What relevance do passwords, search engines and payment requirements have?*

They have got their importance, since the disclosure carried out in the Internet must be available to everybody. If it is directed to a specific group with scientific or professional purposes, it should not be considered a disclosure that would affect the novelty.

3.3 *Place of disclosure*

a) *What is the place of disclosure if the information is put on the internet?*

According to our law, the place of disclosure does not matter; besides it is very hard to detect the place of origin of the information set in the Internet.

b) *Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?*

It is enough, since the place of disclosure does not matter. Any publication or disclosure carried out totally, completely and directed to the public in general, and that can be proved, could be included in the prior art and therefore, affect the novelty of the invention.

3.4 *Timing of disclosure*

a) *Are there certain requirements for the timing and duration of the information available through electronic means?*

We are not aware of the requirements, but there shall exist certain requirements to measure the time and duration of the information available, since our law establishes that the publication must be tangible, therefore the publication must be proved, whether it is done by visiting the web site where the information is or through any print out of said web site.

b) *Are archives necessary or desirable?*

We consider the files to be necessary at the time of proving the disclosure of the information.

3.5 *Questions of evidence*

a) *Who should have the burden of proof that a specific piece of information was disclosed on the internet?*

If information related to an invention in the process of being granted is disclosed in the Internet, the evidence must be filed by the people interested in the patent not being granted. The Paraguayan Legislation establishes that third parties may file observations or oppositions against the possibility of the concession of the patent of an invention.

b) *Does the internet require rules different to those already existing for oral disclosure or the disclosure in other ways?*

Yes, the Internet requires special rules that determine when an information contained in it constitutes a relevant and complete disclosure of an invention, and therefore, affects its novelty.

c) *Should there be different levels of evidence for different ways of disclosure?*

We believe that there should exist different levels of evidence for disclosure, due to the complexity and specialty of the subject especially in the Internet, and taking into account the different criteria applied in each country in this regard.

d) *Does the potential manipulation of the information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?*

We consider that the information disclosed through new means of diffusion require special and different standards to the ones already known.

4. Conclusion

We consider that the partial and incomplete disclosure of the invention through the Internet does not destroy the novelty. Likewise, we understand that the disclosure carried out through the Internet, which is destined to a specific group of people with access to it through passwords, special search motors with scientific, professional or educational purposes, are not part of the state of prior art.

Therefore, we bear the criteria that standards and specific rules must be established to determine the level of disclosure of an invention through the Internet. Rules that would determine, for example, the following:

- a) Easy access to said Web sites in the Internet.
- b) Clear and complete disclosure of an invention as a requirement to be comprehended in the state of prior art.
- c) Easy understanding by person who is familiar with the subject.
- d) Scientific, professional or educational goals pursued by said disclosure.
- e) The inventors' authorization or denial for said disclosure.

Traduction française

1. Détermination de l'art antérieur

- 1.1 a) *Quel est l'effet de la divulgation d'un art antérieur sur la nouveauté et l'activité inventive?*

L'effet de la divulgation de l'état de la technique est préjudiciel pour l'invention, étant donné qu'il détruit la nouveauté et en vue de la connaissance de ce fait, l'invention résulterait pertinente pour tout professionnel de la spécialité.

- b) *Existe-t-il des différences entre l'art antérieur concernant la nouveauté d'une part, et l'activité inventive d'autre part?*

Oui, il y a des différences puisque la loi établit qu'une invention est nouvelle si elle ne possède pas des précédents dans l'état de la technique, donc toute divulgation par n'importe quel moyen endommage la nouveauté, par contre une simple divulgation de l'invention n'endommage pas le niveau inventif d'un brevet.

- c) *Les demandes en cours, qui n'ont pas encore été publiées, affectent-elles l'évaluation de la nouveauté et de l'activité inventive?*

Oui, elles peuvent les endommager puisque l'examen approfondi comprend aussi la recherche des précédents parmi les demandes en attente, qui ont été présentées auparavant du brevet examiné.

- 1.2 *Les lois nationales donnent-elles des définitions ou indications sur ce qui constitue une divulgation de l'art antérieur?*

Oui, dans l'article 7 de la Loi du brevet d'invention.

De la nouveauté. On considérera qu'une invention possède une nouveauté lorsqu'elle n'a pas de précédents dans l'état de la technique.

L'état de la technique comprendra tout ce qui a été divulgué ou a été rendu accessible au public, dans n'importe quel endroit du monde, à travers une publication tangible, une divulgation orale, une vente ou une commercialisation, un usage ou tout autre moyen, avant la date de présentation de la demande dans le pays ou, avant la date de présentation de la demande antérieure dont on invoque la priorité.

A l'effet d'apprécier la nouveauté de l'invention, on inclura aussi à l'intérieur de l'état de technique, le contenu d'une demande de brevet en cours auprès de la Direction de la Propriété Industrielle dont la date de présentation, ou éventuellement, de priorité, soit antérieure à la demande en train d'être examinée, mais seulement dans la mesure où ce contenu serait inclus dans la demande de date antérieure lorsque celle-ci a été publiée.

L'état de la technique ne comprendra pas ce qui a été divulgué dans l'année qui précède la date de présentation de la demande au Paraguay, ou dans l'année qui précède la date de la demande dont la priorité est invoquée, pourvu que cette divulgation résulte directe ou indirectement des **actes** réalisés par l'inventeur lui-même ou par l'ayant cause ou d'un non-accomplissement d'un contrat ou d'un acte illicite commis contre un d'eux.

La divulgation qui résulte d'une publication faite par un bureau de la propriété industrielle dans un procès de concession d'un brevet n'est pas comprise dans l'exception du paragraphe précédant, sauf si la demande objet de cette publication a été présentée par une personne qui n'avait pas le droit d'obtenir ce brevet ou que la publication a été faite par une erreur imputable à ce bureau.»

1.3 *Quelles sont les directives utilisées pour déterminer si un élément d'art antérieur a été divulgué?*

Les seules règles établies par la loi sont, premièrement, la divulgation tangible par n'importe quel moyen, et deuxièmement, le degré d'accès du public à l'invention.

2. Critères pour la divulgation

2.1 Moyens de divulgation

a) *Quels sont les moyens reconnus de divulgation?*

Ce sont les publications tangibles, la divulgation orale, la vente ou la commercialisation, l'usage par tout autre moyen.

b) *Existe-t-il des exigences supplémentaires pour certains types de divulgations, tels que la divulgation orale ou la divulgation par l'usage, par rapport à la divulgation par le biais de documents écrits?*

La loi n'établit pas de formalités requises additionnelles.

c) *Si certains moyens de divulgation ne sont pas reconnus par la loi ou par la pratique, quelles en sont les raisons?*

La loi est très claire à ce sujet, lorsqu'elle dit que la divulgation peut être réalisée par tout moyen, alors, elle n'exclut aucun moyen de divulgation.

2.2 Date de divulgation

a) *Est-il important qu'une divulgation a été faite récemment ou depuis longtemps déjà?*

Le temps de divulgation est important puisque la loi établit le suivant:

L'état de la technique ne comprendra pas ce qui a été divulgué dans l'année qui précède la date de présentation de la demande au Paraguay, ou éventuellement, dans l'année qui précède la date de la demande, **pourvu que cette divulgation soit réalisée par l'inventeur ou son ayant cause ou pourvu qu'elle soit le résultat d'un acte illicite.**

b) *Existe-t-il des limites au-delà desquelles la publication d'une information, bien qu'elle constitue une divulgation de l'art antérieur, n'est plus pertinente pour l'évaluation de la nouveauté et de l'activité inventive?*

Toute divulgation réalisée avec postériorité à la date de publication du brevet, n'endommage pas la nouveauté de la même.

2.3 Lieu de la divulgation

a) *Le lieu de la divulgation est-il pertinent?*

Non, il n'est pas important.

b) *Comment déterminer le lieu de divulgation?*

Du moment où le lieu de divulgation n'est plus important, il n'est pas non plus nécessaire de le déterminer.

c) *Importe-t-il que la divulgation ait eu lieu dans ce pays par accident ou qu'elle ait eu lieu de façon intentionnelle?*

C'est important étant donné que l'information mise accidentellement ou délibérément à travers un acte illicite n'est pas comprise dans l'état de la technique.

d) *Quelle est la législation applicable pour déterminer si une divulgation a eu lieu (la législation du pays dans lequel l'information a été divulguée, ou la législation du pays dans lequel la nouveauté et l'activité inventive sont évaluées)?*

La loi applicable est celle du pays dans lequel ces formalités sont valorisées.

2.4 *Éléments personnels*

a) *Quelles sont les différences observées par les Groupes à l'égard de la personne qui divulgue l'art antérieur?*

La loi établit que si une invention est révélée par l'inventeur ou l'ayant cause au cours de l'année précédant la demande, ce fait n'est pas compris dans l'état de la technique.

b) *La divulgation est-elle traitée différemment si l'auteur de la divulgation était lié par un accord de confidentialité ?*

La divulgation réalisée par une personne qui possède un accord de confiance ne se considère pas comprise dans l'état de la technique.

c) *Comment sont traitées les erreurs dans les informations divulguées?*

Les erreurs de l'information divulguée ne sont pas comprises dans l'état de la technique.

2.5 *Bénéficiaire de l'information*

a) *Quelles sont les exigences à l'égard de l'aptitude à comprendre les informations?*

La loi n'établit rien à ce sujet.

b) *Est-ce que la possibilité qu'une personne puisse obtenir les informations par des étapes supplémentaires, telles que le démontage de modes de réalisation ou une procédure de construction à l'envers (reverse engineering), suffisent à constituer une divulgation?*

Oui, c'est possible, mais les actes réalisés par une personne sans l'accord de l'inventeur ou le titulaire d'un brevet constitue une infraction et un acte illicite, alors, on ne peut pas considérer comme une divulgation qui endommage l'état de la technique.

c) *Existe-t-il des règles générales couvrant l'effet de confidentialité ou la confidentialité implicite?*

La loi établit des règles de confiance pour les fonctionnaires publics qui ont accès au brevet. Elle considère un délit la divulgation à travers ces personnes de l'invention.

3. **Divulgation par les nouveaux médias**

3.1 *Règles générales*

a) *Des informations sans support papier, par exemple dans un réseau électronique ou à travers Internet, constituent-elles une divulgation suffisante susceptible d'affecter la nouveauté ou l'activité inventive?*

Oui elle peut, étant donné que c'est une forme d'accès à tout type d'information, alors elle constitue un moyen en plus pour la divulgation.

b) *Existe-t-il des exigences spécifiques par rapport à d'autres formes de divulgation?*

Il ne s'agit pas des mêmes formalités.

c) *Existe-t-il des différences à l'égard de différentes formes de réseaux ou de communications telles que la "toile" mondiale, les Groupes de discussion ou les forums, le courrier électronique et autres?*

Ils n'existent pas de différences, étant donné que la divulgation tangible et complète d'une invention qui peut être prouvée détruit la nouveauté du brevet.

3.2 *Problèmes de confidentialité*

a) *Cela fait-il une différence si les informations sont cryptées?*

Certainement, puisque le public commun n'a pas accès à elle.

b) *Quelle pertinence ont les exigences relatives aux mots de passe, aux moteurs de recherche et aux paiements sécurisés?*

Ils sont importants, puisque la divulgation que l'on réalise par Internet doit être accessible à tout le monde. Si elle est dirigée à un groupe spécifique à des finalités scientifiques ou professionnelles on ne devrait pas la considérer comme une divulgation qui endommage la nouveauté.

3.3 *Lieu de la divulgation*

a) *Quel est le lieu de divulgation si les informations sont mises sur Internet?*

D'après notre loi le lieu de la divulgation n'a pas d'importance, par ailleurs il est très difficile de détecter le lieu d'origine de l'information mise en Internet.

b) *Le simple fait qu'un site web puisse être accessible en un certain endroit suffit-il pour une divulgation dans cet endroit ou doit-il y avoir des conditions ou exigences supplémentaires?*

Il est suffisant car le lieu de la divulgation n'a pas d'importance. Toute publication ou toute divulgation réalisée sous forme totale, complète et destinée au public en général et qui peut être prouvée, pourrait être comprise dans l'état de la technique et pourra pour autant endommager la nouveauté de l'invention.

3.4 *Date de la divulgation*

a) *Existe-t-il certaines exigences quant à la date et la durée des informations disponibles par les moyens électroniques?*

Nous ne connaissons pas de formalités requises, mais certaines conditions devraient exister pour mesurer le temps et la durée de l'information disponible, puisque notre loi établit que la publication doit être tangible, alors la publication doit être prouvée, soit par la visite à un site web où l'on trouve l'information, soit par un imprimé de ce site.

b) *Des archives, sont-elles nécessaires ou souhaitables?*

Nous considérons que les archives sont nécessaires au moment de prouver la divulgation de l'information.

3.5 *Problèmes de preuve*

a) *Qui doit avoir la charge de la preuve qu'une information spécifique a été divulguée sur Internet?*

Si une information en rapport à une invention en voie de concession est divulguée en Internet la preuve doit être présentée par les personnes intéressées au fait que le brevet ne soit

pas concédé. La législation paraguayenne établit que les tiers personnes peuvent présenter des observations ou des oppositions sur le brevet d'invention.

b) *Est-ce qu'Internet nécessite des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens?*

Oui, Internet a besoin de règles spéciales qui déterminent quand une information contenu dans le réseau constitue une divulgation importante et complète d'une invention et en conséquence endommage le condition requise de nouveauté de la même.

c) *Doit-il exister différents niveaux de preuve pour différents modes de divulgation?*

Nous considérons qu'il devrait exister de différents niveaux d'évidence de la divulgation, compte tenu de la complexité et la spécialité du sujet en Internet particulièrement, et compte tenu par ailleurs de la différence de critères appliqués à ce sujet dans chaque pays.

d) *La manipulation potentielle d'informations divulguées par les nouveaux médias exige-t-elle des normes différentes pour la reconnaissance de cette divulgation, et y a-t-il des règles spécifiques pour ce type de divulgation?*

Nous considérons que l'information divulguée à travers les nouveaux moyens de diffusion a besoin de conditions spéciales et différentes de celles que nous connaissons.

4. Conclusion

Nous considérons que la divulgation partielle ou incomplète d'une invention à travers Internet ne détruit pas la nouveauté. Nous comprenons aussi que la divulgation réalisée par Internet destinée à un groupe de personnes spécifiques et qui ont accès elle par des mots de passe ou de moteurs de recherche spéciales à des finalités scientifiques, professionnelles ou éducatives ne font pas partie de l'état de la technique.

En conséquence, nous pensons que des conditions et des règles spécifiques doivent être établies pour déterminer le degré de la divulgation d'une invention par Internet.

Règles déterminant par exemple:

- a) La facilité d'accès à ces sites Web d'Internet.
- b) La divulgation claire et complète d'une invention comme condition requise pour être comprise dans l'état de la technique.
- c) La facilité de compréhension pour une personne qui possède des connaissances dans ce domaine.
- d) Les finalités scientifiques, professionnelles ou éducatives de cette divulgation.
- e) L'autorisation ou non des inventeurs pour cette divulgation.

Report Q167

in the name of the Polish Group
by Andrzej PONIKIEWSKI

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

The new Industrial Property Law of June 30, 2000 states that an invention shall be considered to be new if it does not form part of the state of the art. As the state of the art is considered everything made available to the public by means of written or oral description, by use, displaying or disclosure **in any other way** before the priority date.

- 1.1 Any disclosure destroys novelty. However, the invention is considered as not novel when complete set of its technical features is fully disclosed in the prior art. Separate disclosure of particular technical features of the invention does not foredoom about the lack of novelty. If different technical features of the invention are disclosed in different publications and it may be concluded that one skilled in the art, basing on those information, could achieve the same result, the invention is considered as obvious and thus lacking rather the inventive step than novelty.

Pending applications of earlier priority and not yet available to the public are also considered as prior art in assessment of novelty provided that they will be published in a manner specified by Law. Those applications, however, are not taken into consideration in assessment of the inventive step.

- 1.2 The definition of the prior art disclosure is given in art. 25 items 2 and 3. (see 1.1).

2. Criteria for disclosure

- 2.1. As far as means of disclosure is concerned, there are no limitations. Not only printed publications are taken into consideration, but also disclosure in any other form, including proofs of the open use of the subject of the application (such as e.g., invoices, service manuals provided with goods to the market, certificates, etc).

In addition to the searches carried out by Examiners of the Patent Office also a public may have its contribution in establishing the prior art, as according to Art. 44 of the Industrial Property Law of June 30, 2000, "any third party within six months from the date of publication of the patent application may submit to the Patent Office any observations as to the existence of grounds that may cause a patent to be denied". These observations may relate also to the prior art and disclosure known to these third parties. It is worth to mention that such observations are taken into account in the course of examination.

- 2.2. The time of disclosure is not limited in any way provided that the disclosure took place before the priority date (exception in relation to the pending applications not published on the date for which priority is determined – see point 1.1 above). In Poland, claiming priority, the Applicant is obliged to point out (allocate) one and only one priority date for each claim, which makes establishing the relevant prior art clear.

- 2.3 to 2.4 The place of the disclosure is irrelevant. In the comments to the Industrial Property Law of June 30, 2000 (Zenobiusz Miklasiński, Prawo Własności Przemysłowej. Komentarz.

ed. Urząd Patentowy Rzeczypospolitej Polskiej, Warszawa 2001) an example is given that even a unique, singular publication in an exotic language, stored in rarely visited library in a far end of the world and never lend to anybody would be considered as a prior art.

As to the applicability of the law, in all cases to determine whether the disclosure took place only Polish law is applicable.

It is also irrelevant who made a disclosure and whether it was made in good or bad faith. Merely, the fact of disclosure counts.

3. Disclosure through new media

- 3.1 There are no special rules regarding the various form of disclosure. Any disclosure, independently on its form, destroys novelty.
- 3.2 The disclosure have to be open to the public. The secret disclosure or the information unavailable to the public (e.g. encrypted or protected in any other way) seems to be considered as not destroying the novelty in the contrary to the information available after payment.
- 3.3 A place and timing of the disclosure is irrelevant (see point 2.3 to 2.4). The fact that the information was potentially available counts.
- 3.4 The burden of proof should be on the part objecting the granting (or already granted) exclusive rights on the ground of lacking novelty.

4. Conclusion

- 4.1 The group is of the opinion that “absolute” novelty have to be applied, irrelevantly on the time, place and a way, in which the invention has been disclosed. The measures to enable invalidation of the granted patent on the ground of a proof of lacking novelty have to be provided.

Report Q167

in the name of the Portuguese Group
by Gonalo MOREIRA RATO

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

- 1.1 In Portugal, the effect of a prior art disclosure on novelty and inventive step is the loss of novelty and inventive step.

There are no differences between prior art regarding novelty on one hand and inventive step on the other hand (article 51 of the Portuguese Industrial Property Code).

Pending applications, which have not yet been published, affect the assessment of novelty and inventive step, given the fact that, according to article 51 n^o2 of the Industrial Property Code, they are included in the prior art.

- 1.2 The Portuguese Industrial Property Code in article 51 n^o1 gave a definition of what constitutes prior art.

According to this article "prior art shall comprise everything which, in Portugal or elsewhere, was made available to the public before the date of the patent application by means of a description, by use or by any other means, in such a way as to be understood and worked by those skilled in the art".

- 1.3 There are no other guidelines to determine whether a piece of prior art has been disclosed.

2. Criteria for disclosure

- 2.1 In Portugal disclosure is not limited to certain means of information but it is rather unlimited.

All means of information are recognised and there are no additional requirements for certain types of disclosures.

- 2.2 There are no time limits beyond which the publication of a piece of information is no longer relevant for the assessment of novelty and inventive step.

- 2.3 In Portugal the place of disclosure is relevant. In accordance with Portuguese law (Industrial Property Code - article 51) such disclosure could have occurred in Portugal or elsewhere.

- 2.4 In our country, it makes no difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

The disclosure is not treated differently if the disclosing person was bound by a confidentiality agreement.

- 2.5 In Portugal the concept of disclosure requires that information be disclosed in such a way as to be understood and worked by those skilled in the art.

The possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering is not sufficient to constitute a disclosure.

There are no general rules providing for the effect of confidentiality or implied confidentiality.

3. Disclosure through new media

- 3.1 A paperless information, e. g. in an electronic network or through the Internet, constitute a sufficient disclosure to affect novelty or inventive step.

There are no specific requirements compared to other forms of disclosure.

There are no differences with regard to various forms of networks or communications, such as the World-wide Web, chat groups or forums, e-mail and others.

- 3.2 It does not make any difference if the information is encrypted.

Requirements as regards passwords, search engines and payment do not have any relevance.

- 3.3 The place of disclosure if information is put on the Internet is the place where they can be accessed; it doesn't matter the place itself but the possibility access.

In our opinion, the fact that we can access to a certain web in a certain place is sufficient for a disclosure in such place.

- 3.4 In Portugal there are no requirements for the timing and the duration of information available through electronic means.

Archives are not necessary as long as there are access possibilities to such information.

- 3.5 In our opinion, the burden of the proof that a specific piece of information was disclosed on the Internet should belong to those who have disclosed such information.

We do not think that Internet require rules different from those already existing for oral disclosure or the disclosure in other ways.

Traduction française

1. Détermination de l'art antérieur

- 1.1 Au Portugal, l'effet de la divulgation d'un art antérieur sur la nouveauté et l'activité inventive c'est la perte de la nouveauté et de l'activité inventive.

Il n'existe pas des différences entre l'art antérieur concernant la nouveauté d'une part et l'activité inventive d'autre part (article 51 du Code de la Propriété Industrielle).

Les demandes en cours, qui n'ont pas encore été publiées, affectent l'évaluation de la nouveauté et de l'activité inventive, une fois que, selon l'article 51 n° 2 du Code de la Propriété Industrielle, elles sont inclus dans l'art antérieur.

- 1.2 Le Code de la Propriété Industrielle portugais dans son article 51 n°1 définit très clairement ce qui constitue une divulgation de l'art antérieur.

Selon cet article "l'art antérieur est constitué par tout ce qui, dans le pays ou ailleurs, a été rendu accessible au public avant la date de dépôt de la demande de brevet par une description, une utilisation ou tout autre moyen, de manière à pouvoir être connu et exploité par les experts en la matière".

- 1.3 Il n'y a pas d'autres directives pour déterminer si un élément d'art antérieur a été divulgué au-delà de celles établis par la loi.

2. Critères pour la divulgation

- 2.1 Au Portugal la divulgation n'est pas limitée à certains moyens d'information elle est, donc, non limitée.

Tous les moyens de divulgation sont reconnus et il n'existe pas des exigences supplémentaires pour certains types de divulgations.

- 2.2 Il n'existe pas des limites au-delà desquelles la publication d'une information n'est plus pertinente pour l'évaluation de la nouveauté et de l'activité inventive.

- 2.3 Au Portugal le lieu de la divulgation n'est pas pertinent. Selon le Code de la Propriété Industrielle portugais (article 51) cette divulgation peut avoir lieu au Portugal ou ailleurs.

- 2.4 Dans notre pays le fait qu'une information soit divulguée par le demandeur d'un droit de protection intellectuelle ou par une tierce personne peut importe. Ceci concerne également la protection en matière d'expositions et le délai de grâce.

La divulgation n'est pas traitée différemment si l'auteur de la divulgation était lié par un accord de confidentialité.

- 2.5 Au Portugal le concept de divulgation implique que les informations soient divulguées de manière à être connu et exploité par les experts en la matière.

La possibilité qu'une personne puisse obtenir les informations par des étapes supplémentaires, telles que le démontage de modes de réalisation ou une procédure de construction à l'envers ne suffisent pas à constituer une divulgation.

Il n'existe pas des règles générales couvrant l'effet de confidentialité ou la confidentialité implicite.

3. Divulgation par les nouveaux médias

- 3.1 Des informations sans support papier constituent une divulgation suffisante susceptible d'affecter la nouveauté ou l'activité inventive.

Il n'existe pas des exigences spécifiques par rapport à d'autres formes de divulgation.

Il n'existe pas des différences à l'égard des différentes formes de réseaux ou de communications telles que la "toile" mondiale, les groupes de discussion ou les forums, le courrier électronique et autres.

- 3.2 Le fait que les informations sont cryptées ne fait aucune différence.

Les exigences relatives aux mots de passe, aux moteurs de recherche et aux paiements sécurisés n'ont aucune pertinence.

- 3.3 Le lieu de divulgation si les informations sont mises sur Internet est le lieu où elles peuvent être accessibles, il n'importe le lieu exacte mais tout simplement la possibilité d'accès.

À notre avis, le simple fait qu'un site web puisse être accessible en un certain endroit suffit pour une divulgation dans cet endroit.

3.4 Au Portugal il n'existe pas des exigences quant à la date et la durée des informations disponibles par les moyens électroniques.

Des archives ne sont pas nécessaires dès qu'il y a possibilité d'accès à ces informations.

3.5 À notre avis la charge de la preuve qu'une information spécifique a été divulgué sur Internet doit appartenir à ceux qui l'invoque.

Nous pensons qu'Internet ne nécessite pas des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens.

* * * * *

Nous pensons que la définition de divulgation de l'art antérieur établit dans la Convention du Brevet Européen et dans la plupart des lois européennes comme dans la loi portugaise est suffisamment large pour couvrir toutes les possibilités et donne déjà aux Tribunaux une base de travail bien définit.

Cela étant, nous pensons qu'on doit suivre cette définition.

Report Q167

in the name of the Korean Group
by Tae-Ryun CHUNG

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

1. Determination of Prior art

1.1 What is the effect of a prior art disclosure on novelty and inventive steps? Are there any differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

Under the Korean Patent Law (KPL), an invention may be denied its novelty and inventive step by a prior art disclosure. Generally, there are no differences between prior art regarding novelty and inventive step. However, pending applications which have not yet been published affect only the assessment of novelty.

1.2 Do the national laws give definitions or indications as to what constitutes a prior art disclosure?

KPL gives no definitions or indications as to what constitutes a prior art disclosure except disclosure through the internet. According to KPL, inventions (which have industrial applications) may not be patentable if they were worked in Korea, or described in a publication distributed either in Korea or in a foreign country, or available to the general public prior to the filing of the corresponding patent application through the electric communication lines as provided by the presidential decree (i.e. internet).

1.3 Which guidelines are used to determine whether a piece of prior art has been disclosed?

There are no guidelines used to determine whether a piece of prior art has been disclosed, except the means of disclosure as hereinafter explained.

2. Criteria for disclosure

2.1 Means of disclosure

What are the recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

The recognized means of disclosure in general are 1) publications and 2) electronic documents accessible through the electric communication lines or electronic networks, and 3) oral disclosure or disclosure by use. There are not additional requirements for the types of disclosure among the above three.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

It does not matter if a disclosure has been made recently or a long time ago. There are no time limits beyond which the publication of a piece of information, as far as it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step

2.3 *Place of disclosure*

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

The place of disclosure is relevant for disclosure by use only, but not for written or electronic documents as stated in the above 1.2. Though the place of disclosure by written or electronic documents is not relevant, it shall be determined by the place of distribution or the place of accessing the electronic network concerned .

When the accidental disclosure of an invention is cited as a prior art over the invention in a patent application, the invention or improvement thereto described in the patent application filed within 6 months from the accidental disclosure shall be deemed to have novelty or inventiveness, only when it has been proved that the disclosure had been made contrary to the applicant's or inventor's intention.

2.4 *Personal elements*

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

How are errors in the disclosed information treated?

When the disclosure would have been made by a person bound by a confidentiality agreement, such disclosure may be treated as being made against the intention of the person who has the right and titles to the invention (i.e. inventor or applicant). If a patent application would have been filed within six months (grace period) from the time when such accidental disclosure was made, novelty of the invention shall be assessed without consideration of the disclosure. Errors in the disclosed information shall not affect the relevance of the information.

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality?

It does not matter in assessment of the novelty and inventive step according to the prior art disclosure whether the person who acquired the information has the ability to understand the art. If the information would have been disclosed in violation of the confidentiality obligation, the information will not be deemed to be disclosed to the public in assessment of novelty and inventive step of the invention of a patent application filed by a person who is entitled to the invention, as far as the application was filed within six months from the date of disclosure. In addition, if the third party can recognize the invention from the disclosed information only through additional steps with technical difficulties and considerations which one skilled in the art cannot easily conceive, the information does not constitute a relevant disclosure.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various

forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

Yes, a paperless information in certain electronic networks constitutes a sufficient disclosure to affect novelty or inventive step. There are not any specific requirements for such a paperless information, compared to other forms of disclosure, but it should be accessible by the public. The relevant electronic networks include the Worldwide Web, but not chat groups, forums, e-mail, etc.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirement have?

Encrypted information may be excluded from the disclosed one and passwords, search engines and payment requirement may not affect the accessibility of the information, a key for deciding whether the information has been disclosed to the public.

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

A mere fact that a paperless information is obtainable on a web-site is sufficient for a disclosure and the place where the web-site is accessed does not pose a problem. Accordingly, place of disclosure through electronic networks or the internet is not important.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

There are not any requirements for the timing and the duration of information available through electronic means and archives are not necessary. However, the information should have been accessible for a period time that is sufficient for a person skilled in the art to catch the teachings.

3.5 *Questions of evidence*

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

A person or persons who will benefit from the fact of the disclosure of prior art shall have the burden of proof that a specific piece of information was disclosed on the internet. In this regard, the internet does not require rules different from those already existing for disclosure in written documents. There have not been any official discussions or court decisions on such potential manipulation and thus, any specific rules have not been provided.

4. **Conclusion**

In the KPL, there is not any provision which treats the oral disclosure differently from other kinds of disclosures, nor any precedent of the oral disclosure which was examined in the Patent Office or the courts of Korea.

Further, Korean Group believes that requirements for a definition or standard of prior art disclosure in the new media, especially of the encrypted information, should be discussed and provided at the international level.

Report Q167

in the name of the Romanian Group
by Melania RADULESCU

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

The Romanian Group has drafted the answer based on the Romanian Industrial Property Legislation but taking into account that:

- Romania adhered to the TRIPS Agreement.
- Romania is to become member of the European Patent Convention in the near future, the effect of the EP has already been extended to Romania.

1. Determination of prior art

- 1.1 According to Rule 32A of the Regulations for Implementing the Law no.64/1991, for establishing the novelty of an invention, the documents from the prior art can be taken into account only individually for each invention (the materials from the prior art are not opposable in the mosaic system).

The content of the patent applications as filed with the Patent Office which have a regular filing date or an earlier priority date and which became public prior to or after the date of a subsequent application, are a part of the prior art used for establishing the novelty.

According to Rule 32 B for assessing the inventive step, the prior art is established from which a mosaic of technical solutions is formed which is compared as a whole with the claims. The patent applications filed with the Patent Office which became public after the filing date of the application submitted to the examination are not taken into account when assessing the inventive step even if their filing date is previous.

- 1.2 In accordance with the Regulations for Implementing the Law No.64/1991, Rule 30 the prior art used for comparison with the technical solution of the invention in order to establish the novelty thereof contains the knowledge available to the public anywhere in the world prior to the date of the regular filing or recognized priority, provided that the date of making it available to the public be identifiable.

All the patent applications published belong to the prior art.

If an application is withdrawn, abandoned or rejected prior to its publication, this is not considered to belong to the prior art.

The Patent Office does not take into consideration the disclosure made within 12 months proceeding the date of the patent application filing, or the recognized priority date if this disclosure is made by the inventor or his successor in title or if this disclosure is made by a third party and the inventor or his successor in title send a written confirmation to Patent Office stating that said information was obtained directly or indirectly from him.

Patent Office does not also take into account the disclosure by the publication of the patent application if the inventor or his successor in title, within 12 months from the publication, claims in a new patent application parts which were not claimed previously from his first published patent application.

- 1.3 Rule 13 of the above mentioned Regulations stipulates that the prior art has to be presented as far as the applicant has knowledge of it and can be regarded as useful for understanding the invention, citing the documents reflecting such art; at least one solution regarded as the closest to the subject-matter of the invention will be shown; in case when the invention contains a group of inventions which fulfil the unity criterion, a solution from the prior art shall be presented for each subject-matter from the group.

2. Criteria for disclosure

- 2.1 There are no additional requirements for certain types of disclosure such as oral disclosure or disclosure by use when compared to disclosure through written documents. Romanian legal provisions refer to knowledge available to the public with the condition that the date of making it available to the public to be identifiable.
- 2.2 It does not matter if a disclosure has been made recently or a long time ago except the disclosure made by the author or his successor in title within 12 months preceding the date of the filing which is not taken into account.
- 2.3 The place of disclosure is not relevant. A disclosure anywhere in the world is taken into consideration for assessing the novelty or inventive step.

No difference is made if the disclosure has happened in a country accidentally or intentionally.

For determining whether a disclosure has occurred is applicable the law of the country in which novelty and inventive step are assessed, namely Romania.

- 2.4 The disclosure by the inventor or his successor in title made within 12 months preceding the date of the patent application filing or the recognized priority date is not taken into consideration as opposed to the patent application.

The disclosure made by a third party which obtained information directly or indirectly from the inventor or his successor in title is not taken into consideration, too, but the inventor or his successor in title should notify that to ROPTO.

- 2.5 There are no general rules providing for the effect of confidentiality or implied confidentiality.

Rule 32 B provides for requirements with regard to the ability to understand the information disclosed to the public, namely a person skilled in the art without any additional effort.

3. Disclosure through new media

- 3.1 For the time being in Romania there are no specific provisions concerning the paperless information, e.g. in an electronic network or through the Internet and the manner in which it affects or not the novelty or inventive step.

In our opinion the above mentioned information may be taken into consideration in order to establish the novelty or inventive step if a date of issuing may be identifiable for it.

- 3.2 In our opinion an encrypted information could not be taken into account to establish the fulfilment of the novelty or inventive step condition.

- 3.3 We think that the mere fact that a WEB-site can be accessed in a certain place is sufficient for a disclosure in that place. No additional conditions or requirements are necessary.

- 3.4 We think that archives are necessary for information available through electronic means.
- 3.5 In our opinion the Internet requires rules different from those already existing for oral disclosure or the disclosure in other ways. It is necessary to take into account the level of accessibility to the network, which is determined by the technical characteristics of the network, the method of communication and the access and security provisions.

We think that the potential manipulation of information disclosed through new media requires different standards for the recognition of such disclosure and specific rules are needed for this kind of disclosure.

4. Conclusion

Romanian Group consider necessary to create an harmonisation of definitions and standards concerning the prior art disclosure in assessing novelty and inventive step requirements.

In this respect we consider that a definition of prior art has to include the knowledge available to the public, anywhere in the world for which a date of issuing may be identifiable.

Concerning the accidentally disclosure we consider to be better not to take it into consideration in assessing novelty and inventive step requirements.

In our opinion the potential manipulation of information disclosed through new media requires different standards for the recognition of such disclosure.

Summary

The Romanian Group has drafted the answer based on the provisions of the Romanian IP legislation as well as the experience and practice with the national and regional authorities and courts.

Generally we would like to harmonize the definitions and standards concerning the prior art disclosure in order to facilitate the work in this field.

We consider that a definition of the prior art has to include the knowledge available to the public anywhere in the world with an identifiable date.

Concerning the disclosure through new media we consider to be better to establish rules regarding the level of accessibility, the characteristics of the network , the proofs that a specific piece of information was disclosed on the internet etc

Report Q167

in the name of the Singapore Group
by Jason [K-C CHAN](#) and [Winnie THAM](#)

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

The current standards for prior art disclosure in assessing novelty and inventive step are not dissimilar to the standards in the United Kingdom.

Anticipation (Novelty)

1. Under section 13 Patents Act (cap. 221), a patentable invention is one which satisfies the following conditions:
 - a) invention is new;
 - b) involves an inventive step; and
 - c) is capable of industrial application.
2. The requirements of novelty, inventive step and sufficiency of disclosure are distinct concepts and have to be considered separately.
3. Section 14 Patents Act (cap. 221) states that an invention shall be taken as **new** if it does not form **part of the state of the art**.

Section 15 states that an invention shall be taken to involve an **inventive step** if it is **not obvious to a person skilled in the art**, having regard to any matter which forms part of the state of art [under Section 14\(2\) and without having regard to Section 14\(3\)](#).

4. Answer to question 1.1:

- 4.1 Prior art can invalidate a patent application or a registered patent – see above. The burden of proof for anticipation and lack of inventive step is placed on the person seeking to invalidate the patent.
- 4.2 The state of the art is defined in Section 14(2) as comprising all matter which has at any time before the priority date been **made available to the public**, by written or oral description, by use or in any other way. Note that this definition of prior art is applicable to the requirement of inventive step.
- 4.3 Prior art includes matters contained in an application for a patent which was published on or after the priority date. Priority date of an invention is the date of filing of the application of the patent, [or the declared priority date for a patent application provided it is based on an application filed not more than 12 months prior to the filing of the Singapore application.](#)
- 4.4 [For the purposes of assessing novelty only, Section 14\(3\) provides that the state of the art is also taken to comprise matter contained in an application for another patent¹ which was published on or after the priority date of that invention if:](#)

¹ [A patent is defined as a patent under the Singapore Patents Act.](#)

- a) that matter was contained in the application for that other patent both as filed and as published; and
- b) the priority date of that matter is earlier than that of the invention.

To this extent, pending applications which are not yet published may affect novelty. As stated above, Section 14(3) is excluded from consideration for inventive step.

4.5 For inventive step, the state of the art described in paragraph 4.4 above is specifically excluded and should not be regarded.

5. Answers to questions 1.2 and 1.3

5.1 The definition of prior art is fairly broad, basically encompassing all matter made available at any time before the priority date, whether in writing or orally, domestic or abroad, in use or otherwise, - save matters made available in confidence (see below) and certain statutory exceptions.

Novelty

5.2 In relation to novelty, for information made available to the public, the disclosure must be sufficient to enable a person skilled in the art to put the innovation into practice, applying the common general knowledge of his craft. In the case of a product, it must enable the skilled man to make it; for a process, it must enable him to operate it. A person skilled in the art is a man of ordinary competence in the field but who is not of an imaginative or inventive turn of mind.

5.3 In determining if a piece of prior art has indeed anticipated the patent claims, the principle set out in the well-known UK case of **General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd [1972] RPC 457** has been applied in Singapore. The Court of Appeal in that case held that to determine whether a patentee's claim has been anticipated by prior art, it is necessary to compare the earlier publication with the patentee's claim. Both the prior art and patentee's claims must be interpreted as at the date of its publication, having regard to the relevant surrounding circumstances and without regard to subsequent events (ie the benefit of hindsight). If the prior art so construed discloses the same product or process that the patentee by his claim asserts he has invented or contains "clear and unmistakeable directions" to the invention, the claims has been anticipated.

5.4 Two recent cases² re-established two other fundamental principles governing novelty.

- a) 'Mosaicing' of the prior art in assessing novelty is not permissible. As a general rule, prior art documents should be read individually, to determine what information each contained. The exception to this rule is where a later document referred to an earlier document or where a series of papers, which formed a series of disclosures, referred to each other.
- b) When determining whether an invention covered by the patent has been anticipated by each disclosure in the prior art, the question to ask is: does following the teachings in that disclosure inevitably lead to the invention? If the answer is 'yes', the invention is not novel. Modifications made to prior art to lead to the invention will be discounted.

² Merck & Co Inc v Pharmaforte Singapore Pte Ltd [2000] 3 SLR 717; Genelabs Diagnostics Pte Ltd v Institut Pasteur & anor [2001] 1 SLR 121

Inventive step

- 5.5 When determining the issue of inventive step, the courts approach the question by reference to the principles laid down in the UK case of **Windsurfing International v Tabur Marine [1985] RPC 59**. This approach entails four steps:
- a) Identify the inventive concept embodied in the patent in suit.
 - b) Assume the mantle of the normally skilled but unimaginative addressee in the art (“person skilled in the art”) at the priority date and impute to him what was, at that date, common general knowledge in the art in question.
 - c) Identify what, if any, differences exist between the prior art and the alleged invention.
 - d) Ask whether, viewed without knowledge of the alleged invention (ie. without hindsight or *ex-post facto* analysis), those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

5.6 In a recent case³, the court also applied :

- the ‘well-worth trying’ test i.e. the invention is obvious if the skilled person would have felt that the invention was well worth trying, to solve a problem or achieve a beneficial result⁴; and
- the ‘lying on the road’ test (i.e. the invention is obvious if the prior art was ‘lying on the road’ and there for the research worker to use⁵).

6. Answer to question 2.1 - Means of disclosure

There is no requirement that the availability be made via a particular means, method or mode or that it must be made to a large section of the public. The fact that no one knew of its availability or had inspected it are also irrelevant. Accidental disclosure also makes no difference, as is the difficulty of assessing the prior art so long as the disclosure is enabling.

It may be of interest to note that although the “person skilled in the art” is deemed to have read all relevant prior art, it remains arguable that not all prior art may hold the same relevance, depending on the common general knowledge of the notional skilled person in the art. In other words, all prior art shall be considered but it is a question of relevance - **Amer-sham Pharmacia Biotech v Amicon Ltd and 2 Ors**, unreported 5 July 2001, UK Court of Appeal.

7. Answer to question 2.2 - Time of disclosure

The time of disclosure is also irrelevant, so long as it was made before the priority date.

8. Answer to question 2.3 - Place of disclosure

8.1 The place of disclosure is irrelevant.

8.2 In determining whether a disclosure has occurred, since a Singapore patent is involved, the sufficiency or otherwise of the purported disclosure must be construed under Singapore law, in accordance with principles governing conflict of laws.

³ Merck & Co v Pharmaforte Singapore Pte Ltd [2000] 3 SLR 717

⁴ John-Manville’s Patent [1967] RPC 479

⁵ Genentech [1989] RPC 147

9. **Answers to questions 2.4 and 2.5 - Personal elements / Recipient of information**

9.1 The disclosure of a matter constituting an invention shall be disregarded if the disclosure was due to or made in consequence of the matter having been obtained unlawfully or in breach of confidence from the inventor/proprietor or any person to whom the inventor disclosed the matter in confidence.

9.2 If the disclosure was due to or made in consequence of the inventor displaying at an international filing exhibition, and a declaration is /proprietor made on filing and evidence filed to this effect, the disclosure may be disregarded.

9.3 Disclosures made describing the invention in a paper read by the inventor/proprietor or another person with his consent before a learned society may also be disregarded. A learned society includes any club or association whose main object is the promotion of learning or science.

9.4 In such cases, in order to be disregarded, the disclosure must have occurred later than the beginning of the period of 12 months immediately preceding the date of filing the application for the patent.

10. There is no statutory definition of the public. UK caselaw on this issue will be ordinarily be persuasive and those cases suggest that depending on the circumstances, where the prior art is not ordinarily accessible to the public, that disclosure may be disregarded.

11. There is no specific requirement with regard to the ability of the notional skilled addressee to understand the information. However, that requirement is implicitly addressed by case-law, in the consideration and application of the notional skilled addressee. That addressee is deemed to be a man of ordinary competence in the field but without an inventive turn of mind. If additional steps are required, we believe that if it can be shown the notional addressee, in applying the common general knowledge to put the information into practice will undertake the additional steps (such steps being ordinary methods of trial and error and conceivably may include reverse engineering processes – **BSH Industries Patents [1995] RPC 183**, that information may have the effect of destroying novelty. But where the additional steps taken or the reverse engineering amounts to experiments with a view to “discovering something not disclosed” - **C Van der Lely NV v Bamfords Ltd [1963] RPC 61**, that may indicate that the patent is novel or inventive.

12. **Answers to questions 3.1 to 3.5 - Disclosure through new media**

12.1 There is no restriction in the Patents Act that excludes paperless information from constituting a sufficient disclosure to affect novelty or inventive step.

12.2 If the information is encrypted and only accessible by certain persons, for example, with the necessary password or through payment, there may still be a disclosure since the ease or extent of the disclosure is irrelevant. The crucial question is whether that information was made “available to the public”, as required under the Patents Act.

12.3 As there is no requirement as to place or method of disclosure, the fact that the information is accessible over the Internet should not prevent such information from being part of the prior art. However, if the information is only available electronically for a temporary period of time, it may be difficult to prove and rely on such prior art, as a matter of evidence. The burden remains on the person seeking to invalidate the patent.

12.4 Note that there are certain requirements to be fulfilled for the admissibility of computer records as evidence in court, under the Evidence Act.

Summary

Patent law in Singapore is governed by the Patents Act, which is closely modelled on United Kingdom's Patents Act 1977. Section 14 provides that an invention shall be taken as new if it does not form part of the state of the art. Section 15 provides that an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of art. The "state of the art" is defined as comprising all matter which has at any time before the priority date been made available to the public, in oral or written form or by use or any other way. The broad definition of state of the art means that the manner, time, extent or place of disclosure are usually irrelevant, so long as was made before the priority date and regarded as being made available to the public (subject to disclosure made in breach of confidence and certain statutory exceptions). Priority date of an invention is generally the date of filing of the application of the patent.

Report Q167

in the name of the South African Group
by Frank JOFFE

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

1. Determination of prior art

- 1.1.1 The law governing patents in South Africa is the Patents Act 57 of 1978 ("the Act"). Patents in South Africa are entirely creatures of statute and the law, in so far as it relates to patentability, is to be found in the Act. Of course, the courts interpret the Act and expound on its meaning, from time to time.
- 1.1.2 There are differences between the prior art regarding novelty on the one hand and inventive step on the other. These differences appear from the definitions of the prior art in relation to novelty and inventive step, which are set out in 1.2 below. In summary, the definition of the prior art for the purpose of inventive step is narrower than that for the purpose of novelty and excludes matter contained in pending patent applications and inventions used secretly and on a commercial scale in the Republic.
- 1.1.3 Pending applications which have not yet been published affect the assessment of novelty, but not inventive step. Once again, the effect of such applications is determined in the Act and is set out in 1.2 hereunder.
- 1.2.1 The Patents Act gives precise definitions of prior art disclosure in so far as it affects both novelty and inventive step.
- 1.2.2 Section 25(1) of the Act requires that an invention, in order to be patentable, must be in both new (i.e. novel) and involve an inventive step.
- 1.2.3 Section 25(5) states that:
An invention shall be deemed to be new if it does not form part of the state of the art immediately before the priority date of any claim to that invention."
- 1.2.4 Section 25(6) states that:
The state of the art shall comprise all matter (whether a product, a process, information about either, or anything else) which has been made available to the public (whether in the Republic or elsewhere) by written or oral description, by use or in any other way.
- 1.2.5 Section 25(7) states that:
The state of the art shall also comprise matter contained in an application, open to public inspection, for a patent, notwithstanding that that application was lodged at the patent office and became open to public inspection on or after the priority date of the relevant invention, if -
- a) *that matter was contained in that application both as lodged and as open to public inspection; and*
 - b) *the priority date of that matter is earlier than that of the invention.*

- 1.2.6 Section 43B states that:
Subject to this Chapter, an international application designating the Republic shall be deemed to be an application for a patent lodged at the patent office in terms of this Act.
- 1.2.7 Accordingly, disclosures in pending applications, whether South African national patent applications or PCT patent applications designating South Africa, and not yet published, are considered to be part of the prior art for the purposes of novelty.
- 1.2.8 Section 25(8) states that:
An invention used secretly and on a commercial scale within the Republic shall also be deemed to form part of the state of the art for the purposes of subsection (5).
- i.e. for the purpose of establishing novelty.
- 1.2.9 Section 25(9) states that:
In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body, the fact that the substance or composition forms part of the state of the art immediately before the priority date of the invention shall not prevent a patent being granted for the invention if the use of the substance or composition in any such method does not form part of the state of the art at that date.
- 1.2.10 Section 25(10) states that:
Subject to the provisions of section 39(6) [which deals with patents of addition], an invention shall be deemed to involve an inventive step if it is not obvious to person skilled in the art, having regard to any matter which forms, immediately before the priority date of the invention, part of the state of the art by virtue only of subsection 6 (and disregarding subsections (7) and (8)).”
- 1.3 There are no guidelines other than statute and case law which are used to determine whether a piece of prior art has been disclosed.

2. Criteria for disclosure

2.1 Means of disclosure

- 2.1.1 In principle, since (with certain statutory exceptions discussed above) the Act places no restrictions on the form of disclosure which has an impact on novelty and inventive step, any form of disclosure, provided it is to the public and within the relevant time period, will comprise part of the state of the art and will therefore impact on novelty and inventive step. The Act specifically provides for oral disclosure.
- 2.1.2 There is no specific provision for new ways of information, such as the internet. However, since the Act is clear in placing no limits on disclosure, there is no real need for a specific provision for such new ways of information.
- 2.1.3 Any means for disclosure, provided it is public, is recognized. There are no additional requirements for specific types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through certain documents.

2.2 Time of disclosure

- 2.2.1 There are no limitations on the date of the disclosure, provided such disclosure takes place before the priority date of the relevant invention.
- 2.2.2 The Act states that the state of the art comprises public disclosures made *“immediately before the priority date of that invention”*. The date and not the time of disclosure is stipulated. Accordingly, there is some room for dispute as to the precise moment at which a disclosure must take place, in order to qualify as part of the state of the art.

2.3 Place of disclosure

- 2.3.3 There are no limitations on the place of disclosure in respect of its effect on novelty or inventiveness. Accordingly, subject to the exception set out hereunder, the place of disclosure is irrelevant.
- 2.3.4 Section 26(b) of the Act provides that:
A patent shall not be invalid by reason only of the fact that the invention in respect of which the patent was granted or any part thereof was disclosed, used or known prior to the priority date of the invention-
- b) *as a result of the invention being worked in the Republic by way of reasonable technical trial or experiment by the applicant or patentee or the predecessor in title of the applicant or patentee.*
- 2.3.5 Accordingly, disclosure by way of reasonable technical trial or experiment in the Republic of South Africa is excused, when made by certain persons. Whether such excusable disclosure took place in the Republic would be determined under the laws of the Republic.
- 2.4 *Personal elements*
- 2.4.1 Section 26(a) states that:
A patent shall not be invalid by reason only of the fact that the invention in respect of which the patent was granted or any part thereof was disclosed, used or known prior to the priority date of the invention-
- a) if the patentee or his or her predecessor in title proves that such knowledge was acquired or such disclosure or use was made without his or her knowledge or consent, and that the knowledge acquired or the matter disclosed or used was derived or obtained from him or her, and, if he or she learnt of the disclosure, use or knowledge before the priority date of the invention, that he or she applied for and obtained protection for his or her invention with all reasonable diligence after learning of the disclosure, use or knowledge;
- 2.4.2 Accordingly, certain disclosures of information are excused, where such disclosure was made by a third party acquiring information from the applicant and without his knowledge or consent.
- 2.4.3 There is no provision under South African law for the grace periods relating to disclosure. Notwithstanding the provisions of the Paris Convention, of which South Africa is a signatory, there is no provision under South African law to excuse disclosures made at exhibitions.
- 2.4.4 Disclosures are indeed treated differently if the disclosing person was bound by a confidentiality agreement, as set out above. There is no provision for dealing with errors in the disclosed information.
- 2.5 *Recipient of the information*
- 2.5.1 Disclosure, in order to affect either novelty or inventive step, must be disclosure to the public. The public is not defined in the Act. Accordingly, common law principles have been established by the courts in regard to the definition to the public. Clearly, disclosures made under conditions of confidentiality are not considered to be public disclosures.
- 2.5.2 What is meant by the expression “available to the public” will depend on the facts of each particular case. Particularly where an invention is highly technical, the public will probably be interpreted to include only addressees of the patent. The South African courts have followed EPO policy that the state of the art includes anything which it was possible for the member of the public to gain knowledge of and which may be freely disclosed without a breach of confidence (either express or implied). Our courts have also held that a disclosure, in order to be considered to be part of the state of the art, must be a so called “ena-

bling disclosure”, i.e. in the case of the use of a product, the invention forms part of the state of the art only in so far as the use thereof makes available the necessary information.

2.5.3 Accordingly, there are non-statutory common law guidelines to the effect that the disclosure must probably be addressed to an addressee of the patent. There are no guidelines relating to additional steps for obtaining information, such as disassembly of embodiments or reverse engineering, and it must be assumed that information available by these means does indeed constitute disclosure. Further, as stated above in paragraph 1.2.8, section 25(8) provides unequivocally that the secret use of an invention on the commercial scale within the Republic shall be deemed to form part of the state of the art (for the purposes of novelty).

2.5.4 Disclosure under circumstances of confidentiality (whether express or implied) does not, under established common law rules, comprise disclosure to the public. Further, the provisions of Section 26(a), discussed in paragraph 2.4.1 above, excuse certain disclosures originating with the patentee and made without the patentee’s knowledge or consent.

3. Disclosure through new media

3.1 *General rules*

Since, under South African law, with certain minor exceptions, the requirement of novelty is absolute, paperless information does constitute sufficient disclosure to effect both novelty and inventive step. There are no specific requirements under our statutory law in comparison to other forms of disclosure. Neither are there differences with regard to various forms of networks or communications, other than that, in certain circumstances, such communications may be considered not to have been made to the public. There are no statutory rules in this regard, and all the circumstances, including the nature of the network or communications medium and the reasonable expectation of confidentiality by both the discloser and disclosee of the information, would be relevant considerations in deciding if such disclosure comprised part of the prior art.

3.2 *Questions of confidentiality*

While there are no guidelines in regard to encryption, it would appear that, on the basis of general principles, the encryption of information would be strong evidence of an implied obligation of confidentiality. Similarly, the use of passwords would have the same effect. However, it is not clear what implication the use of search engines may have, unless, possibly, the use of the search engine carries with it an acknowledgement of an obligation of confidentiality in respect of information uncovered. Further, the payment for information does, according to South African common law, provide some evidence that the use of such information is intended to be restricted to the parties concerned. However, it is less likely that this principle can be extended to impose an obligation of strict confidentiality on the disclosee.

3.3 *Place of disclosure*

Under South African statutory law, disclosure, provided it qualifies as such, is not territorially limited. However, certain disclosures made in the course of reasonable technical trial are only excused if they take place within the bounds of the Republic. Accordingly, particularly in regard to information placed on the internet, where that information may be accessed from locations outside the Republic, the position is somewhat unclear. This would be particularly relevant where the invention itself related to an internet application.

3.4 *Timing of disclosure*

There are no specific requirements for the timing or duration of information available through electronic means.

3.5 *Questions of evidence*

3.5.1 Clearly, the internet and other digital communications networks create problems in so far as the provision and manipulation of evidence is concerned. Such problems are not legal problems but practical problems relating to establishing the facts in each case. Under South Af-

rican law, the burden of proof generally rests with the person asserting a particular case. The Constitution of South Africa would certainly not countenance any inversion of the burden.

- 3.5.2 In our view, it is yet too early to venture an opinion as to whether developments on the internet and like communications media require rules different from those already existing for oral disclosure or the effect that such media may have on different standards for recognition of disclosure.

Report Q167

in the name of the Spanish Group
by Luis Torrents FERNÁNDEZ-MAYORALAS (Chairman), Anna AUTÓ CASSASAS, Josep CARBONELL CALLICÓ, Rafael CASTELLANOS I LLORENS, Josep M^a CASTELLÓ BARENYS, Eduardo FERREGÜELA COLON, Isidro José GARCÍA EGEA, Joan Antoni MORGADES MANONELLES, Marta PONS DE VALL I ALOMAR, Jordi ROMANÍ LLUCH, Inmaculada SUÁREZ BARRAL, Enrique DE VERDONCES LLARGUÉS and Miquel Vidal-QUADRAS TRIAS DE BES.

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

Novelty and inventive step are central elements of the system of intellectual property rights. Novelty is required mainly for technical rights, but can also found as a requirement for other IPR, such as designs. The inventive step (in other words: non-obviousness) constitutes a requirement for patents and utility models. With the help of these elements a distinction from prior art can be achieved or determined. What has been disclosed can in general not be new or inventive. However, the details of these elements vary from country to country. There is no common definition as to the term “disclosure”. The TRIPS agreement does not give a definition either, but contains the requirements of novelty (Article 25, 27) and inventive step (Article 27). Article 39 TRIPS mentions without definition “un-disclosed information” in the context of unfair competition.

In the past, the most common ways of disclosure comprised printed or written documents or the use of certain embodiments in public. Oral disclosure is also possible. With new technologies and in particular with the internet new ways of disclosure appear which have to be taken into account. The internet creates specific problems, since information is not permanent and access may be unlimited. This leads to questions of evidence, confidentiality and accessibility.

At the EXCO Meeting in Vienna 1997 AIPPI has passed a Resolution Q138A which dealt with confidentiality, disclosure and publication of data in information networks. Concerning disclosure AIPPI considered that the mere fact of transmitting information by means of a computerised network will not result in the information becoming available to the public, and in consequence being disclosed. Account should be taken of the level of accessibility to the network, which is determined by, inter alia, the technical characteristics of the network, the method of communication and the access and security provisions (see AIPPI Yearbook 1997/III, p. 311). Reference is also made to Resolution Q126 about methods and principles of novelty evaluation in patent law which was adopted in Montreal 1995 (see AIPPI Yearbook 1995/VIII, p. 383). This resolution contained general rules about disclosure and the effects of disclosure on novelty.

In this context it should be mentioned that WIPO's Standing Committee on the Law of Patents (SCP) has given various reports on the disclosure of technical information on the internet and its impact on patentability. The reports deal with specific problems with regard to the disclosure on the internet (see WIPO Reports SPC/5/2 and SPC/5/4 of April 4, 2001).

The question of disclosure always has an impact also on the grace period. This topic should be left out from the scope of this question Q167. Reference is made instead to previous resolutions of AIPPI, namely to Resolution Q75.

The title of the question implies that the main focus of Q167 is on patents and utility models. The Group Reports should concentrate on these rights. Designs have a special requirement of novelty

due to their different character as an IPR which is much more related to copyrights. Therefore, they are excluded from Q167, unless the Group Reports show a real need to discuss issues related to these rights in the context of this question.

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

Spain's 1986 Patent Law, in Article 1, determines the industrial property titles affording protection to industrial inventions as follows:

- a) Invention Patents, and
- b) Utility Models Protection Certificates.

In Spanish law, there is no definition of what represents an invention. It merely establishes the positive requisites for their patentability in Article 4, which is equivalent to Article. 52.1 of the European Patent Convention, (hereinafter called EPC) specifying that "new inventions that involve an inventive activity and which are susceptible to industrial application can be patented".

By contrast, with regard to utility models, there is indeed a definition in law stating what can be the object of said protection. To these effects, it is specified in Article 143 of the Spanish Patent Law (hereinafter called SPL) that the following can be protected as utility models: inventions which, being new and involving inventive activity, consist of giving an object a configuration, structure or constitution from which a practical advantage in its use of production may result.

With regard to the industrial property title, also contemplated in Article 143 is what comprises a utility model, demanding in any case that "some practically noticeable advantage for its use or production" be derived from it. In section 2 of the aforementioned Article, certain examples are shown of that which may form the object of said models, resolving that "in particular, protection as utility models may be awarded to utensils, instruments, tools, apparatuses, devices or parts thereof, meeting the requisites mentioned in the previous section".

There is a specific legal definition of what is to be understood by novelty and by inventive activity to the effects of considering the patentability of each industrial invention. In accordance with Article 6 of the Law, which has the same text as Article 54.1 EPC, and with regard to invention patents, it is indicated that they are new when they have not been covered by the prior art.

The prior art is formed by everything that was accessible to the public in Spain or abroad, through written or verbal description, use or other means, prior to the date on which the patent application was filed. To be understood as included therein is the content of Spanish patent or utility model applications filed prior to the date the new patent application is filed, as would have been presented originally and published either on that date or on a later date.

As an exception to the legal definition of the prior art, deliberately excluded is the express disclosure of the invention within six months prior to the date the application is filed before the Spanish Patent and Trademark Office (hereinafter called SPTO), as long as this was the direct or indirect consequence of any of the activities contemplated in Article 7 (55 EPC) which are the object of the treatment specified in section 2.2 of this Report.

With regard to utility models, the SPL defines the prior art to the effects of considering novelty with a territorial criteria, in view of which only that which has been disclosed in Spain should be taken into account. It is important to stress, that according to Spanish legislation, whereas with regard to the patents absolute novelty is required, referring to the prior art as "everything accessible to the public in Spain or abroad prior to the date the patent application is filed", with regard to utility models, said demand is relative, as it refers to "Spain" only.

It is considered that the requisite of inventive activity to the effects of patentability is fulfilled whenever, for an expert in the matter, the invention was not evident, given the prior art. In the framework of utility models, said requisite is less restrictive as the legislator merely demands that the invention does not derive from the prior art in a “very evident” way for an expert in the matter.

The SPL regulates on its article 108 the denominated “certificates of addition”. This modality allows to the patent holder which is in force to protect the inventions that improve or develop the invention object of this patent, applying for additions to the patents whenever that these additions were integrated with the object of the main patent in the same inventive unity. Additions to a patent application can also be requested but these additions will not be granted until the patent has been conceded.

It will not be necessary that the object of the addition implies an inventive activity in front of the object of the main patent.

Additions will have the priority date corresponding to their respective applications, their duration will be the same of the duration resting to the patent, and they are not subject to the payment of annuities.

1. Determination of prior art

As the title of the question indicates, the question deals with prior art disclosure. Its goal is not to deal with specific questions arising from disclosure in the context of the scope of protection or the formalities of patent applications. In order to determine criteria for prior art disclosure it should be stated at first, what the main principles are with regard to the relationship between disclosure, novelty and inventive step and how this is reflected in the various national laws.

1.1 What is the effect of a prior art disclosure on novelty and inventive steps?

The main effect of the prior art on the requisites of novelty and inventive activity is the determination that said invention cannot be patented if what is claimed were known previously (novelty) or if its content were evident for an expert in the matter (inventive activity). The prior art can be considered as a conjunct of information and knowledge used as a means of comparison with the object of the invention to determine whether or not it is new; if the object of the invention is not comprised in the prior art, is taken into consideration if this object, in relation to this conjunct of information and knowledge, is evident or not, or very evident for an expert in the matter in order to determine if it has inventive activity.

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?

The prior art is taken into account, both in evaluating the novelty and the inventive activity of the invention. In general, there are no differences regarding the criteria of application of the prior art for evaluating the novelty and inventive activity, except in the following two aspects:

- a) The form in which the elements for evaluating the novelty or the inventive activity are applied
- b) The inclusion or otherwise of previous, unpublished rights in the prior art.

To evaluate the novelty, the object of the invention is compared to each of the elements of the prior art, including in the consideration any previously filed patent and utility model applications (Article 6.3 SPL, whose content is equivalent to that of Article 54.3 EPC regarding European patent applications) with the purpose of determining whether the invention was already known at the time the application was filed.

By contrast, to evaluate the inventive activity, the object of the invention is compared to the set of elements comprising the prior art, but without including in the consideration the patents and utility models applications not published in the new patent or utility model's presentation date (Article 8.2 SPL and 56 EPC, final phrase).

Article 6.3 SPL refers to the content of the “Spanish patents or utility models applications”, therefore, PCT applications that do not design Spain will be excluded. Concerning the European patent applications, all of them are included, since the designation fee is paid in the moment that the exam is requested, it means, when the patent has already been published.

Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

With regard to this question, we refer to the comments made in the previous question.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Article 6.2 SPL (54.2 EPC) indicates that everything that was accessible to the public prior to the patent application represents the prior art. There are some exceptions to the above, comprising disclosures made in the framework of the suppositions considered in Article 7 SPL (55 EPC), which are the object of a detailed analysis in section 2.2 of this Report.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

The SPL approaches the question related to the analysis of the novelty in a different way, depending on whether it refers to patents or utility models. With regard to patents, article 6.2 of the law resolves that the prior art “is formed by everything that, prior to the date on which the patent application was filed, was accessible to the public *in Spain or abroad*, through a written or verbal description, use or other means” (Article 54.2 EPC has the same content but without specifying territory).

However, with regard to utility models, article 145 of the law resolves that the prior art “is formed by everything that, prior to the date on which the patent application for protection as a model was filed, had been disclosed *in Spain*, through a written or verbal description, use or other means.”

Although the SPL use some different expressions, “make accessible to the public” for the invention patents and “disclose” for the utility models, in the practice the concept of prior art is the same for both invention patents and utility models, and the only noticeable difference between these concepts lies in the fact that the demand of novelty for invention patents is world-wide, whereas for utility models it is limited to Spain.

The concept of disclosure referred to in the SPL must be interpreted, not as any real and effective knowledge of the background facts comprising the prior art, but the mere possibility of accessing said background facts. The law refers to said background facts in a way that is not restricted to any means consisting of a written or verbal description of use of the invention (Article 6.2). The same resolution says that prior background facts can also be found in “any other means” that enables public access to the invention. Disclosure must be proved by establishing all the means of evidence allowed in Spanish procedural laws. Until now, Spanish jurisprudence in this matter is scarce and there are a lot more assumptions regarding the existence of novelty in utility models than in patents.

Article 7 SPL, inspired by Article 55 EPC, regulates three particular assumptions in which disclosure or prior use does not destroy the novelty of the invention, as long as the disclosure occurred during the six months prior to the date the patent application was filed before the SPTO. This is referred to in section 2.2 of this Report.

Therefore, it may be affirmed then that, in Spain, there are no basic guidelines for knowing when a disclosure of an invention has taken place. The SPL merely quotes “*make accessible to the public*” or “*disclose by way of a description, use or any other means*” without providing further details. As a result, disclosure of an invention is a question of a deed that has to be proven in each case and which is subject, in the case of doubt, to the Judge’s own opinion.

2. Criteria for disclosure

The determination of a disclosure has to consider various criteria. These criteria comprise the means of information (written, oral or otherwise), the time of information (recently or a long time ago), the place of information (domestic or abroad), the person who discloses the information (the applicant of an IPR or a third person) and the recipient of the information.

2.1 Means of disclosure

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

Article 6.2 SPL, as is the case in Article 54.2 EPC, establishes the widest range of means of disclosure. So, these are not limited to verbal or written information or to that which results from the use of relevant information, but also to “any other means” of disclosure. This final part of the legal text, incorporated in Spanish law in 1986, which did not exist before, allows us to consider that any means of disclosure other than verbal, written or as a result of use can also be included to the effects of patentability. In Spanish jurisprudence, there is no background data on other possible means of disclosure. European jurisprudence considers that anything placed at the public’s disposal prior to the date of application forms part of the prior art; with the way in which the public gained access to this information being irrelevant.

Under Spanish or European legislation, there are no additional legal requisites that affect particular means of disclosure as could be the case of the Internet. Disclosure through a data processing network must therefore be considered as a prior event to the effects of patentability. The only requisite, common to all forms of disclosure, is that of the accessibility of the information to the public, which was analysed in the previous section. Spanish jurisprudence has not made any statement about the lack of recognition of certain means of disclosure.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

Recent disclosure of the invention, as in European countries and in the United States, is an element to be taken into account when considering the harm that could be done to it. This is covered in Spanish legislation if certain conditions are met. On the other hand, the restriction of elements to be borne in mind, depending on the time elapsed since the moment disclosure took place, has disappeared from the legal text.

With regard to disclosures made just before the patent application, Spanish law foresees three situations in which disclosures made during the six months prior to the patent application are not elements to be taken into account in determining the prior art. The legal limitations only contemplate means of disclosure derived from the applicant’s invention. In other words, the limitations do not affect possible data independent from this invention that could affect the inventive activity thereof. The first two situations are also foreseen in European legislation – albeit one of them with certain undertones - and the third is entirely of Spanish law. These circumstances are as follows:

- a) *Evident abuse against the applicant or causing party:* This limitation to the prior art, reflected in Article 7(a) SPL, on which there was no previous legislation, is drawn up as the equivalent of letter (a) of Article 55(1) EPC. There is no jurisprudence in Spain concerning this limitation, although we understand it could be adapted to the abundant doctrine established by the Appeals Chambers of the European Patent Office concerning situations that involve abuse against the patent applicant and which will include situations of breach of contract, inducement to breach of contract, illegitimate access to the information, etcetera.

- b) *Exhibition of the invention at official or unofficially recognised expositions:* The exception relating to expositions is referred to both in the text of the SPL, Article 7(b) and in the EPC, Article 55(1)(b). In Spanish law, there is nevertheless an omission of any reference to said expositions being recognised in the sense of the 1928 Agreement concerning International Expositions. This difference allows to extend the limitation of the prior art not only to expositions gathered in said Agreement, but to all official or unofficially recognised international, national and local expositions. Spanish jurisprudence has acknowledged said range of local trade fairs, pointing out in turn that the purpose of the legal provision is to enable prior disclosure of the product so it may become known and in demand in the appropriate areas.
- c) *Trials carried out by the applicant or causing parties:* One limitation already collected up in previous legislation and kept in Article 7(c) of current legislation, despite its not having been collected up in the text of the EPC, is that referring to the applicant or causing parties carrying out trials, as long as this does not involve an operation or commercial offer of the invention. Therefore, disclosure resulting from the applicant carrying out tests is not deemed a damaging element to the effects of considering the patentability of the invention.

On the other hand, the current SPL, as in the case of the EPC, does not foresee any limitation to novelty based on a reasonably long period of time having elapsed since disclosure occurred. This is not the case with inventions still in force, applied for according to the previous patent law, which stated that the novelty of the invention was not affected by whatever had ceased being used over a period of 50 years. This limitation affects patents applied for before 27th June 1986. Although disclosure will be relevant to the effects of considering the patentability of the invention, irrespective of the time elapsed, in terms of inventive activity, the passing of time since the publication of a given element may lead to the conclusion that the use thereof, along with other elements, would be less evident for an expert in the matter.

2.3 *Place of disclosure*

In some countries only a disclosure of a piece of information in that specific country may affect novelty whereas a disclosure abroad will not be taken into consideration. As an example, one can mention the publication of printed materials which are published in one country and of which only a few copies will cross the border to another country by accident or unintentionally.

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

With regard to patents, the place the disclosure occurs is irrelevant, as the novelty required is world-wide by nature. However, with regard to utility models, this circumstance is very relevant indeed, as only the disclosure made in Spain represents the prior art to the effects of considering the novelty and the inventive activity thereof.

The place of the disclosure, only relevant in terms of utility models, is determined according to a territorial criteria. In other words, if disclosure of the background data took place on Spanish territory.

We understand that, to the effects of the validity of a patent or utility model, it is irrelevant whether the disclosure were intentional or accidental, with the exception foreseen in Article 7.a) of the SPL, already considered in this Report, according to which any disclosure of the invention taking place during the six months prior to the application being filed in the SPTO will not be taken into account in determining the prior art, whenever it was a direct or indirect consequence of an evident case of abuse against the patent applicant or causing person.

The applicable law will be the same as that taken into account in determining the validity of the registration in question, namely the Law or legal body by virtue of which the registration in question was granted.

2.4 *Personal elements*

It may make a difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

What differences do the Groups observe with regard to the person who discloses the prior art?

In accordance with Spanish law, the most relevant legal resolution is to be found in Article 7 of the SPL in force. Indeed, in this resolution a clear differentiation is made of the disclosing behaviour of the inventor, compared to disclosures made by third parties without the inventor's consent. In this sense, the aforementioned resolution sets a time benefit in the applicant's favour when disclosure of the invention occurred during the 6 months prior to the application patent and whenever this coincides with any of the circumstances mentioned in that same Article 7 that were already discussed in section 2.2 of this Report.

In said legal text, the cases and circumstances in which disclosure will not be taken into account when determining the prior art of an invention are defined very clearly.

Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

In SPL, there is no reference whatsoever to disclosure made by a person who is compelled to keep secret due to a confidentiality agreement. Even if the disclosure occurred by accident, i.e. unintentionally, the negative effects that said disclosure brings about cannot be avoided and the damaged party can claim civil compensation for the damages caused.

However, in heading paragraph (a) of Article 7 of the SPL that especially refers to "*evident abuse against the applicant or causing party*" when the disclosure had occurred as a result of abuse against the later applicant of the patent, it will not be considered that, for this reason, the invention is included in the prior art to the effects of evaluating the patentability of the invention, as long as said abuse took place within the six month period prior to the application being filed.

How are errors in the disclosed information treated?

As to the treatment of the errors in the disclosed information, in the sense that reference is made thereby to those cases in which disclosure occurs by accident (for example, losing the documentation referring to the invention in a public place and subsequent disclosure, or if said documents are changed for others, also accidentally, getting into the hands of someone who discloses them without knowing they are confidential; or a similar error occurs in the course of electronic communications), then in our opinion we believe there is no juridical mechanism that leads to impeding the disclosure occurred in any of the above assumptions from having the negative effects foreseen in law for any other kind of disclosure that is not explicitly protected according to what is resolved in the aforementioned Article 7.

Mention can also be made of another negative circumstance regarding the applicant's interests caused by an error which occurs occasionally. This concerns the consequences of an erroneous publication of the patent application, when it was the object of express renunciation formalised prior to initiating the publication preparations. It is well known that occurs quite frequently in the case of inventions of considerable value and hence it is extraordinarily important that no undesirable disclosure be made, in order to avoid irreparable damages for the interests of the applicant.

2.5 *Recipient of the information*

In general, the concept of disclosure requires that information be disclosed to the public. There may be differences with regard to the definition of the public. This concerns, among others, confidentiality obligations or the ability to understand the information.

What requirements are there with regard to the ability to understand the information?

Spanish legislation on Industrial Property does not require the receiver of the information to have a given capacity to understand it. The Law refers to the criteria of disclosure and accessibility in general, even when it should be assumed that being unable to understand certain information could impede its being understood as disclosed.

Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?

Disassembly of embodiments and reverse engineering operations could provide information representing a disclosure.

In some cases, like that contemplated in the following answer, one could understand that these operations do not affect the novelty and/or inventive activity of the patent.

Are there general rules providing for the effect of confidentiality or implied confidentiality?

Article 7.a) SPL, already considered in section 2.2, establishes that, in determining the prior art, any disclosure of the invention taking place during the six months prior to the application being filed in the SPTO, whenever it was a direct or indirect consequence of an evident case of abuse against the patent applicant or causing person, will not be taken into account. The breach of a confidentiality commitment could be considered a form of abuse, due to which this behaviour could be considered an exception to the disclosure regarding the prior art.

Abuse could also be understood as that produced by accidental knowledge by the subject who later discloses the invention, if he does so when knowing about his obligation not to do so.

3. Disclosure through new media

Modern technologies and in particular the introduction of the internet have made access to information world-wide much easier in a much shorter time. At the same time, the life of the information seems to be getting shorter. Information is visible and maybe also reproducible for a short time. This also leads to the danger of manipulating the disclosed information which can be done either by the author or by third parties. With regard to new media this danger seems significantly higher than in other forms of disclosure, such as written documents. The world-wide web raises questions as to the place of disclosure. Merely the fact that information can be accessed all over the world may not lead to a disclosure in the legal sense in every country. Problems arise which are similar to those in connection with oral disclosure, such as questions of evidence, accessibility and duration of the information.

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step?

Disclosure carried out through Internet can logically reveal sufficient to affect the novelty and inventive activity. This will depend on the content of the information appearing on the network, on the people who may have access to it and also, in due course, on the evidence that can be obtained to prove this disclosure.

Are there specific requirements compared to other forms of disclosure?

Current Spanish legislation does not consider specific requisites regarding information that appears in an electronic network. Proof of disclosure, which should be evaluated in each case by the Courts, will be required.

Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

The fact that Spanish legislation does not refer to the new media as a means of obtaining information, means that it is not possible to establish any difference regarding the various means of communication provided by the new technologies, like the Internet, chat groups or forums, e-mail or others.

However, it should be understood that, on principle, there is a difference between the information appearing on the network, websites, forums or chat groups on the one hand, which is accessible to the public at large and, on the other, the use of e-mail which requires expressly sending the information in question to the various mail boxes of the recipients. In this latter case, sending the information, as such, is not a disclosure.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted?

If the information is encrypted then, on principle, one has to assume that it is confidential and therefore this does not represent a disclosure.

The recipient of the information and the purpose with which it was sent to him has to be taken into consideration.

What relevance do passwords, search engines and payment requirements have?

The object of the passwords is to restrict access to certain information, so it necessarily entails an obligation of confidentiality.

Access to information by unauthorised persons may, of course, derive into a later disclosure of the information, without detriment to the fact that this entails a breach of the obligation of confidentiality or an abuse toward the applicant, who can then proceed as he deems appropriate.

3.3 *Place of disclosure*

As explained earlier, in some cases the place of disclosure may be relevant for the assessment of novelty or the inventive step.

What is the place of disclosure if information is put on the internet?

Where Patents are concerned, the place where the information was disclosed, or place where the information is made accessible to the public, is irrelevant. As total novelty is required, this disclosure will in any case affect the validity of the Patent, except in the case contemplated in Article 7.a) SPL. Where Utility Models are concerned, these will only be affected by this disclosure if it took place in Spain.

In the case of public access to the information being gained over the Internet, it should be understood that said access occurred in the place where the computer terminal is installed.

Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

This question should be answered positively because, if a website is available for enquiries from a certain place, then one has to understand that it entails a disclosure of the information in the same way that a given publication in a public archive, therefore accessible, also represents a disclosure of said information.

Spanish law does not set any additional requirements concerning the place where the information is disclosed, except in what has already been explained about the different degrees of novelty required for patents and utility models.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

The moment it is revealed, resulting in disclosure, is, of course, of great importance regarding the effects of destroying the novelty and/or inventive activity of the object being claimed in the patent.

However, there is no legal demand regarding the period of time during which the information remains accessible via electronic media. It will be necessary to prove the existence, accessibility and disclosure of the information via electronic media, irrespective of the period of time during which said accessibility and disclosure were produced.

3.5 *Questions of evidence*

The fact that information on the internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or manipulation. Such problems may arise during the prosecution of a patent application as well as in infringement cases.

Who should have the burden of proof that a specific piece of information was disclosed on the internet?

On principle. It corresponds to each party to prove the certainty of the facts claimed. Civil Procedural Law also establishes that the availability and facility of proof corresponding to each party should be borne in mind, setting certain legal and juridical assumptions which, in some cases, can hinder or facilitate the evidence of the fact one wishes to prove, namely the moment the information was revealed.

Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure?

To the effects of destroying the novelty of the characteristics claimed in the patent, no distinction is made between disclosure over the Internet or by other means. The Law refers in a general and open way to written or verbal disclosure, by use or by any other means. In any case, proof of disclosure will be required.

Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

The inclusion or recognition, in procedural legislation, of various specific means of evidence for proving the existence of information in the new technological media (certificates from institutions managing/controlling said media, for example), will facilitate, in due course, the activity of proof of all parties.

Report Q167

in the name of the Swedish Group
by Ulf DAHLGREN, Bo HALLDIN, Ivan HJERTMAN, Lars HÖGLUND,
Per JOSEFSON and Arne KRANSELL

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive step?*

According to Swedish law, the granting of a patent requires that the invention is (i) new and (ii) non-obvious to a person skilled in the art, in view of prior art. Lack of novelty and/or non-obviousness has the effect that a patent applied for will not be granted or, if granted, that the patent can be revoked.

In the field of patents, Swedish practice in these aspects, in the Patent Office as well as in the courts, follows the EPO practice.

A prior art disclosure that does not completely anticipate the invention may very well be considered so close to the invention that the invention fails inventive merits.

In one respect though, there is a difference in the effect of a disclosure on novelty and on non-obviousness, respectively. The contents of a patent application filed in Sweden or for Sweden via EPO shall be considered as known if that application becomes available to the public. The published application will be relevant for determining novelty, but not non-obviousness of a subsequent Swedish patent application filed prior to said publication (cf. EPC Art. 54 and 56)

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

In the Swedish Patents Act there is a broad definition of prior art disclosures: "everything that is publicly available, be it in writing, by speech, by use or in any other way before the date of filing of the application" (Section 2, paragraph 2). Thus, there are no restrictions as to how the disclosure took place.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

Other guidelines than those given by law or decisions by the registration office and the courts, are the EPO case law and EPO Guidelines as well as Guidelines published by the Swedish Patent Office (www.prv.se). As a general rule, decisions rendered by the Swedish Patent Office follow EPO practice. This is in accordance with decision 4586-1986 of the Swedish Supreme Administrative Court (Regeringsrätten). Nowadays less important, but for a long time influential on the practice were the preparatory works of the Patents Act, in particular the report of a joint Nordic commission (NU 1963:6) which was the basis for similar patent acts that were enacted in the late 60-ties in the Nordic countries. To the extent these preparatory works are in line with the development of patent law on a European level, they are still considered useful for the interpretation and application of the patents acts.

2. Criteria for disclosure

2.1 Means of disclosure

As indicated above (1.2), under Swedish law there are no limitations as to the means of disclosure. All kinds of means are equally relevant.

In many cases the information will be immediately apparent, e.g. when presented in a sufficiently clear way (cf. EPO decision T 206/83) in a written document. In other cases though, e.g. when the invention is not visually available when used in public, but implemented in an apparatus, third party may have to spend much time and effort to disseminate it. However, such practical difficulties for third parties trying reverse engineering, are in principle not considered. Here, Swedish courts seem to apply the same view as the Enlarged Board of Appeal in G 1/92, see the decision of May 10, 1995 by the Patent Court of Appeal (Patentbesvärsträtten), reported in PATENTEYE no. 6/1995.

2.2 Time of disclosure

Time of disclosure is not relevant for the assessment of novelty under EPO and Swedish practice. This means that if a prior disclosure destroys the novelty of an invention it will have the same effect irrespective of time. The same applies in principle as regards non-obviousness.

However, one aspect of time is that it could reflect the difficulty for the person skilled in the art to find the solution according to the patent [before the filing date or priority date of the patent](#) and thereby in certain cases be used as an indicator of non-obviousness when assessing non-obviousness.

2.3 Place of disclosure

The requirement for novelty and non-obviousness is absolute. Thus, the place of disclosure is not relevant.

2.4 Personal elements

An exception in the effect of a disclosure as prior art is made for cases of evident abuse of information in relation to the inventor (cf. art. 55(1)(a) EPC) and for cases where the exhibition exemption (art. 55(1)(b) EPC) applies. [The concept of grace period is not applicable in Sweden.](#)

If the person who discloses the information was bound by a confidentiality agreement (the abuse case) the disclosure will not have any prejudicial effect on the novelty of the invention if the inventor files a patent application within a 6 months period. Here, it may be pointed out that in EPC and the corresponding Swedish regulation (2 §, 5 paragraph 1. of the Patents Act) there is qualification by the word “evident”, which is a subjective requisite. In order to be an evident abuse, it is required that the abuser has acted mala fide, i.e. that he had an intent to destroy the novelty of the invention or at least that he was aware of the fact that his measures could lead to such result, see e.g. decision of July 17, 2001 in case nr 99-282 by the Patents Appeal Court (Patentbesvärsträtten).

Although the requirement for novelty and non-obviousness is absolute in Sweden and in spite of the attitude mentioned in 2.1., the last paragraph, as regards commercially available objects containing the invention, it is accepted that inventors may wish to carry out tests of the invention before the filing of their patent applications in a public environment. In the preparatory works (NU 1963:6 p. 125) there is an example of a snow-plow. The testing of such a device on public roads is not considered to destroy the novelty under certain conditions, namely (i) that such tests are necessary to finish the invention, (ii) that all reasonable measures are taken to restrict the possibilities of the public to get information about the invention and (iii) that the tests are not carried out for a longer time and to a larger extent than what is considered defensible with regard to the character of the invention.

2.5 Recipient of the information

Whether the disclosure is public or not has to be determined *in casu*. Relevant aspects are i.a. the number of people who received the information, the relation between the persons who received the disclosure and the inventor and whether there is any explicit or at least implicit agreement on confidentiality. A generally applied rule is that, if a large or indefinite group of persons have had an opportunity to receive the information, then the disclosure has taken place. It is irrelevant whether anybody did actually make use of that possibility, it being sufficient that the opportunity has existed.

Thus, the critical question is whether or not the inventor controls the information.

The ability of the recipient to understand the information is in principle without importance. Here, the same principle applies as in the case of reverse engineering (see 2.1). The mere fact that the recipient of the information theoretically can comprehend the invention is enough for destroying the novelty.

3. Disclosure through new media

3.1 General rules

There are no statutory law, guidelines or court cases in Sweden specifically concerning the effect of information in electronic networks or communications as prior art disclosures. However, it seems reasonable that the same rules and principles should apply, whatever the media are, in view of the contribution-reward motives for the patent system, which are the same, irrespective of media.

3.2 Questions of confidentiality

Whereas the technical difficulty of finding certain information may not be a reason in itself to consider such information not to be publicly available, the fact that the information is subject to a confidentiality agreement (explicit or implicit) and made accessible only for a limited and identified number of receivers bybecause of the use of encryptions and/or passwords should satisfy the requirement of confidentiality. Certainly, inventors and their successors in title should be allowed to use electronic means for communications where normal and proper precautions are taken to preserve the confidentiality nature of the information.

3.3 Place of disclosure

In the view of the Swedish group the requirement for novelty should have general application, i.e. it should be universal. Geographical limitations in this respect do not seem suitable for today's society, with easy communication both physically and electronically world-wide.

3.4 Timing of disclosure

Although the use of electronic means raises some questions as to evidence (see 3.5), the Swedish group is in principle not in favour of introducing any specific rules regarding restrictions of time when disclosures are relevant. Again, the same rules should apply for all kinds of disclosing media. However, there is a specific aspect on the time of disclosure that should be observed. A disclosure on Internet (which is in fact made available instantaneously all over the world) will give rise to different disclosure dates in different countries owing to the time difference between said countries. Thus, a disclosure on Internet will be available e.g. in the Western hemisphere at one date (e.g. January 9) and in the Eastern hemisphere at another date (i.e. January 10). This should be taken into consideration when deciding whether the disclosure took place before the filing date of an application or not (the whole day rule).

In the legal debate (NIR 2001, p. 381-386) it has been questioned whether *the duration* of a disclosure on Internet should have any effect per se. In this respect there are no rules laid down in the Patents Act or precedents. In the view of the Swedish group, from a practical point of view it does not seem possible to qualify a disclosure as having prejudicial effect or not depending on the duration, as long as it is sufficient for a skilled person to understand the information according to the disclosure. However, it is an open question whether the time needed for understanding the information could be replaced by the time necessary for

down-loading the information (which would allow third party to disseminate the information afterwards).

3.5 Questions of evidence

Electronic information is by nature not permanent unless it is specifically saved (electronically or in printed form). However, in the view of the Swedish group, this fact does not give reason to change the principles of the burden of proof. The burden of proof that a prior disclosure is in fact a prior art disclosure will fall on the party seeking to apply such disclosure as prior art. Any party that has an interest in assessing the state of the art can do so by collecting information and save it in a permanent form with adequate evidence of the date of disclosure. The possibility of manipulating electronic information should be considered similarly to the possibility of manipulating other means of evidence, i.e. by evaluation of the evidence with regard to its reliability. A Swedish court is generally free to evaluate evidence at its discretion. Since the technique for manipulations may vary and change over time, it does not seem efficient to apply a specific different standard for new media disclosures.

4. Conclusions and summary

The requirements for novelty and non-obviousness are by far the most frequent issues dealt with in examination proceedings and in patent litigations. For this reason they are of great importance. In the view of the Swedish group it is highly desirable that the concept of novelty be harmonised worldwide, preferably within the framework of the WIPO Standing Committee on the Law of Patents. It is the understanding of the Swedish group that the work already carried out in this Committee has dealt with collecting information from various countries as to views on the concept of novelty and non-obviousness with regard to disclosures on Internet. These deliberations and the result of Q167 could hopefully end in i.a. guidelines for the examination of patent applications, e.g. under what conditions information on a website is to be considered publicly available and what should be the requirements for establishing the time of disclosures on Internet.

EPO as well as the Swedish Patent Office and Swedish courts have established principles that to some extent could be debated but nevertheless provide over-all reasonable solutions. New media have brought certain new elements into the picture, in particular from an evidence point of view. However, it is the opinion of the Swedish group that these new aspects do not justify the introduction of different standards for assessing novelty and non-obviousness since basically, the well-established standards should work well also in these cases and further that it will probably be difficult to find the proper conditions for applying a different standard for certain cases in view of the fact that the technology for new media will continue to develop rapidly and make legal solutions obsolete.

Summary

It is the opinion of the Swedish group that the general principles regarding the concept of prior art and the criteria for disclosure should apply also in cases of disclosures through new media. However, there is a need for harmonising the approach and finding proper rules or guidelines in details.

Résumé

L'Avis du groupe suédois est que les principes généraux concernant la conception de l'art antérieur et les critères de la divulgation devraient s'appliquer aussi pour la divulgation par les nouveaux médias. Cependant, il y a un besoin d'harmonisation en ce qui concerne la procédure et de trouver des règles ou directives pour les détails.

Zusammenfassung

Es ist die Meinung der schwedischen Landesgruppe dass man die allgemeinen Prinzipie bezüglich Offenbarung im Stand der Technik und die Kriterien für Offenbarung auch in Fällen von neuen Medien anwenden sollte. Man sollte aber auch Harmonisierung und gemeinsame Regeln oder Richtlinien für die Prüfung in Einzelheiten suchen.

Bericht Q167

im Namen der Schweizerischen Landesgruppe
von J. D'HAEMER (Vorsitzender), Dr. K. BECKER, A. FREI, Dr. M. GRONER,
Dr. P. HEINRICH, S.V. KULHAVY, Dr. P. PLISKA und M. ZARDI

Gegenwärtige Standards für Offenbarungen im Stand der Technik bei der Beurteilung der Voraussetzungen der Neuheit und der Erfindungshöhe

Vorbemerkungen

- A. Das schweizerische Patentgesetz ist bei der letzten Revision weitgehend an das Europäische Patentübereinkommen (und damit an das Strassburger Übereinkommen zur Vereinheitlichung gewisser Begriffe des materiellen Rechts der Erfindungspatente von 1963) angeglichen worden. Das materielle Recht für schweizerische Patente wird daher nicht nur von Entscheidungen der schweizerischen Gerichte, sondern auch von den Entscheidungen der Beschwerdekammern des Europäischen Patentamts beeinflusst, d.h. für die Beantwortung der hier gestellten Fragen müssen auch solche Entscheidungen berücksichtigt werden.
- B. Das für die Erteilung von schweizerischen Patenten zuständige Institut für Geistiges Eigentum (IGE) führt zwar eine Sachprüfung der Patentgesuche durch, es erfolgt jedoch keine Prüfung auf Neuheit und erfinderische Tätigkeit mehr, so dass für die Beantwortung der hier gestellten Fragen fast nur Entscheidungen von schweizerischen Gerichten herangezogen werden können.

1. Bestimmung des Standes der Technik

Wie der Titel der Frage zeigt, behandelt die Frage die Offenbarung im Stand der Technik. Das Ziel besteht nicht darin, spezifische Fragen zu behandeln, die aus der Offenbarung im Zusammenhang mit dem Schutzbereich oder mit Formalien der Patentanmeldung resultieren. Um Kriterien für die Offenbarung des Standes der Technik zu entwickeln, sollte zunächst festgestellt werden, welches die Hauptgrundsätze für das Verhältnis zwischen Offenbarung, Neuheit und Erfindungshöhe sind und wie sich diese in den verschiedenen nationalen Rechten widerspiegeln.

- 1.1 *Welchen Effekt hat die Veröffentlichung eines Standes der Technik auf Neuheit und Erfindungshöhe? Gibt es Unterschiede zwischen dem Stand der Technik in bezug auf Neuheit einerseits und Erfindungshöhe andererseits? Beeinflussen anhängige Anmeldungen, die noch nicht veröffentlicht sind, die Beurteilung von Neuheit und Erfindungshöhe?*

"Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört." (Art. 7(1) PatG)

"Was sich in naheliegender Weise aus dem Stand der Technik (Art. 7) ergibt, ist keine patentfähige Erfindung." (Art. 1(2) PatG)

"Den Stand der Technik bildet alles, was vor dem Anmelde- oder dem Prioritätsdatum der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benützung oder in sonstiger Weise zugänglich gemacht worden ist." (Art. 7(2) PatG)

Die erstgenannten zwei Bestimmungen des schweizerischen Patentgesetzes definieren, in Verbindung mit der letzteren, den Zusammenhang zwischen Neuheit bzw. erfinderischer Tätigkeit und dem Stand der Technik. Technische Lehren, die der Öffentlichkeit irgendwann und irgendwo im Prinzip zugänglich geworden sind, sollen nicht Gegenstand eines Patentes sein. Eine naheliegende Änderung gegenüber dem bekannten Stand der Technik genügt nicht, um Patentfähigkeit zu erreichen.

Grundsätzlich ist der Begriff des Standes der Technik derselbe im Hinblick auf die Neuheit und die erfinderische Tätigkeit. Dies folgt aus der expliziten Verbindung von Art. 1(2) mit Art. 7 PatG.

Allerdings beeinflussen auch „ältere Rechte“ die Beurteilung der Neuheit, nicht aber der erfinderischen Tätigkeit. Die entsprechende Gesetzesbestimmung lautet:

"Eine Erfindung gilt nicht als neu, wenn sie, obwohl sie nicht zum Stand der Technik gehört, Gegenstand eines gültigen Patentes ist, das auf Grund einer früheren oder einer prioritätsälteren Anmeldung für die Schweiz erteilt wurde."
(Art. 7a PatG)

Zweck dieser Bestimmung ist es, eine Doppelpatentierung derselben Erfindung zu verhindern. Deshalb wirkt nach schweizerischem Recht die nicht veröffentlichte frühere Patentanmeldung nur mit ihren Patentansprüchen neuheitsschädlich („prior claims approach“) und zudem nur, wenn sie zu einem gültigen Patent geführt hat (Entscheidung des Handelsgerichts Bern, 10. 12. 1996, SIC! 8/97, S. 2). Dies im Gegensatz zum europäischen Recht, wo für die Neuheitsprüfung der gesamte Inhalt der älteren Anmeldung als Stand der Technik gilt („whole contents approach“), wobei es bedeutungslos ist, ob die ältere Anmeldung zu einem gültigen Patent geführt hat (Art. 54(3),(4) EPÜ). Als „ältere Rechte“ im Sinn von Art. 7a PatG gelten nationale schweizerische Patentanmeldungen, europäische Patentanmeldungen mit Benennung der Schweiz und internationale Patentanmeldungen mit Bestimmung der Schweiz - immer unter der Voraussetzung, dass sie zu einem in der Schweiz gültigen Patent geführt haben. Entgegen dem Wortlaut von Art. 7a PatG braucht das ältere Patent zum Zeitpunkt des Neuheitsangriffs auf das jüngere Patent nicht mehr in Kraft zu stehen (Entscheidung des Bundesamtes für Geistiges Eigentum, 16. 1. 1979, Schweizerisches Patent-, Muster- und Markenblatt 1983 I 65). Im Zusammenhang mit der vorgelegten Frage mag auch interessieren, dass das schweizerische Recht (Art. 7a PatG) die älteren Rechte ausdrücklich vom Stand der Technik ausschliesst und den Begriff der Neuheit modifiziert, während das europäische Recht (Art. 54(3) EPÜ) den Begriff des Standes der Technik auf ältere europäische Rechte ausdehnt.

1.2 *Enthalten die nationalen Rechte Definitionen oder Hinweise darauf, worin eine Offenbarung des Standes der Technik besteht?*

Gemäss Art. 7(2) PatG (siehe Teilfrage 1.1) bildet den Stand der Technik „alles“ (d. h. alle Kenntnisse), „was vor dem Anmelde- oder dem Prioritätsdatum der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benützung oder in sonstiger Weise zugänglich gemacht worden ist.“ Dabei spielt der Ort, die Sprache, der zeitliche Abstand zum Anmelde- oder Prioritätsdatum oder der Weg (Medium) der Offenbarung keine Rolle.

1.3 *Welche Regeln werden angewandt, um zu beurteilen, ob ein bestimmter Stand der Technik offenbart worden ist? Diese Frage zielt auf Richtlinien, die nicht schon in Gesetzen enthalten sind und die in den einzelnen Ländern zur Beurteilung einer Offenbarung entwickelt wurden.*

Da im schweizerischen Patenterteilungsverfahren keine Prüfung auf Neuheit und erfinderische Tätigkeit erfolgt, sind in den „Richtlinien für die Sachprüfung der Patentgesuche“ des Eidgenössischen Instituts für Geistiges Eigentum keine Regeln zur Beurteilung der Offenbarung zu finden. Im Folgenden wird eine Auswahl solcher Regeln präsentiert, die sich aus der schweizerischen Rechtsprechung ergeben (nach P. Heinrich, „PatG-EPÜ: Kommentar zum Schweizerischen Patentgesetz und den entsprechenden

Bestimmungen des Europäischen Patentübereinkommens“, Orell Füssli Verlag, 1998, Rdn. 7.10-7.22).

Massgeblich für die Interpretation eines Dokumentes des Standes der Technik ist das Anmelde- oder Prioritätsdatum (R. E. Blum, M. M. Pedrazzini, „Das schweizerische Patentrecht“, Verlag Stämpfli & Cie, 1957, S. 343 f.). Dies im Gegensatz zur europäischen Rechtsprechung (Entscheidung T 677/91 einer Technischen Beschwerdekammer des Europäischen Patentamtes, unveröffentlicht), wonach bei der Beurteilung der Neuheit zur Ermittlung des Offenbarungsgehalts nur das zum **Publikationszeitpunkt** des Dokumentes vorhandene allgemeine Fachwissen herangezogen werden kann („Europäisches Patentübereinkommen: Kommentar“, Hrsg. M. Singer, D. Stauder, Carl Heymanns Verlag KG, 2000, Rdn. 52 zu Art. 54).

Bei der Beurteilung eines Standes der Technik ist sein Inhalt wesentlich, nicht eine wörtliche Übereinstimmung mit dem Patent, dem er entgegengehalten wird (Entscheidung des Bundesamtes für Geistiges Eigentum, 30. 10. 1972, Schweizerische Mitteilungen über Immaterialgüterrecht 1973, 35). Handelt es sich beim Stand der Technik um eine Patentschrift, so ist sie gesamthaft als ein Sprachwerk zu betrachten, ohne besondere Hervorhebung ihrer Ansprüche.

Grundsätzlich gehören die Unterlagen erteilter schweizerischer Patente vom Moment der Erteilung an zum Stand der Technik, sofern sie von jenem Zeitpunkt an beim Patentamt frei zugänglich sind, auch wenn die Patentschrift noch nicht erschienen ist (Entscheidung des Bundesamtes für Geistiges Eigentum, 15. 11. 1962, Schweizerisches Patent-, Muster- und Markenblatt 1963 I 19, sowie Entscheidung des Schweizerischen Bundesgerichts 94 II 285). Dieser Grundsatz wurde allerdings in einer späteren Gerichtsentscheidung relativiert (Entscheidung des Handelsgerichtes Zürich, 25. 7. 1984, Schweizerische Mitteilungen über Immaterialgüterrecht 1986, 315).

Der Umstand, dass ein Stand der Technik aus einem anderen Fachgebiet stammt, schliesst seine Berücksichtigung für die Beurteilung der erfinderischen Tätigkeit nicht absolut aus, weil die vor die Aufgabe gestellte Fachperson einen Grund gehabt haben könnte, die Suche nach einer Lösung auf jenes Gebiet auszudehnen (P. Heinrich, „PatG-EPÜ: Kommentar zum Schweizerischen Patentgesetz und den entsprechenden Bestimmungen des Europäischen Patentübereinkommens“, Orell Füssli Verlag, 1998, Rdn. 1.32, 1.33). Aus diesem Grund betrachtet es die schweizerische AIPPI-Arbeitsgruppe als nicht zulässig, bei der Prüfung auf erfinderische Tätigkeit einen Teil des Standes der Technik allein mit dem Argument „gattungsfremd“ auszublenden.

2. Kriterien für die Offenbarung

Die Beurteilung einer Offenbarung muss verschiedene Kriterien berücksichtigen. Diese Kriterien umfassen das Medium der Information (schriftlich, mündlich oder auf andere Weise), den Zeitpunkt der Information (kürzlich oder vor einer langen Zeit), den Ort der Information (im Inland oder Ausland), die Person, die die Information offenbart (Anmelder eines gewerblichen Schutzrechts oder eine dritte Person) und den Empfänger der Information.

2.1 Wege der Offenbarung

In den Länderberichten sollte festgestellt werden, welche Art der Offenbarung Einfluss auf Neuheit und Erfindungshöhe hat. Insbesondere interessiert, ob die Offenbarung auf bestimmte Wege der Information beschränkt oder eher unbeschränkt ist. Dies schließt mündliche Offenbarung ebenso ein wie neue Wege der Information, wie etwa das Internet, die auch im Zusammenhang mit der nächsten Frage behandelt werden.

Welches sind anerkannte Wege der Offenbarung? Gibt es zusätzliche Erfordernisse für bestimmte Arten der Offenbarung, wie mündliche Offenbarung oder die Offenbarung durch Benutzung im Vergleich zur Offenbarung durch schriftliche Dokumente? Was sind die

Gründe, falls bestimmte Wege der Offenbarung durch Gesetz oder Praxis nicht anerkannt werden?

Gemäss Art. 7(2) PatG (siehe Teilfrage 1.1) kann die Offenbarung des Standes der Technik vor dem Anmelde- oder Prioritätstag

- (i) durch schriftliche Beschreibung,
- (ii) durch mündliche Beschreibung,
- (iii) durch (nicht geheime) Benützung oder
- (iv) in sonstiger Weise

erfolgen. Diese im Gesetz aufgezählten Wege der Offenbarung (i)-(iv) sind rechtlich gleichwertig. Faktisch bestehen jedoch Unterschiede in beweismässiger Hinsicht, denn ein datiertes veröffentlichtes Dokument (i) ist als Beweismittel im Allgemeinen weniger leicht in Frage zu stellen als bspw. eine Zeugenaussage (ii),(iii).

Die Wege der Offenbarung sind nach schweizerischem Recht nicht beschränkt. Durch die Formulierung „oder in sonstiger Weise“ (iv) hat der schweizerische Gesetzgeber die Möglichkeit weiterer Wege der Offenbarung offen gelassen. Dies ist im Hinblick auf die neuen Medien (Teilfrage 3) von Interesse. Nach Ansicht der schweizerischen AIPPI-Arbeitsgruppe ist eine Veröffentlichung im Internet ein Spezialfall der schriftlichen Beschreibung (i) und gilt demnach als Offenbarung des Standes der Technik.

2.2 *Zeit der Offenbarung*

Macht es einen Unterschied, ob die Offenbarung erst kürzlich oder vor einer langen Zeit erfolgt ist? Gibt es Grenzen, jenseits derer die Veröffentlichung einer Information, obschon sie eine Offenbarung des Standes der Technik begründen könnte, nicht länger als relevant für die Beurteilung der Neuheit und der Erfindungshöhe angesehen wird?

Es spielt keine Rolle, wie alt eine Offenbarung ist. Wenn sie vor dem Anmelde- oder Prioritätsdatum erfolgt ist, begründet sie einen Stand der Technik im Sinn von Art. 7(2) PatG. Trotzdem kann der Zeitpunkt der Offenbarung für die Beurteilung der Patentierbarkeit relevant sein, wie nachfolgend erklärt wird.

Die Neuheit wird durch jede ältere identische Offenbarung zerstört, unabhängig vom Zeitpunkt der Offenbarung.

Bei der Beurteilung der erfinderischen Tätigkeit wird hingegen gemäss schweizerischer Rechtsprechung eine alte Veröffentlichung nicht berücksichtigt, wenn sie die Technik nicht beeinflusst hat, sondern seit Langem in Vergessenheit geraten ist (Entscheidung des Schweizerischen Bundesgerichts 94 II 319). Somit werden alte Veröffentlichungen etwas anders gewichtet als in der Rechtsprechung der Technischen Beschwerdekammern des Europäischen Patentamtes, gemäss welcher auch alte Dokumente für die Prüfung herangezogen werden, wobei allerdings ein grosser Zeitabstand zwischen der Veröffentlichung und dem Prioritätstag ein zusätzlicher Hinweis auf erfinderische Tätigkeit sein kann.

2.3 *Ort der Offenbarung*

In einigen Ländern wirkt sich eine Offenbarung auf die Neuheit nur dann aus, wenn die Offenbarung der Information in dem betreffenden Land stattgefunden hat, während eine Offenbarung im Ausland nicht berücksichtigt wird. Als Beispiel kann die Veröffentlichung von gedruckten Materialien genannt werden, die in einem Land veröffentlicht werden und von denen nur wenige Exemplare zufällig oder ungewollt die Grenze in ein anderes Land überschreiten.

Ist der Ort der Offenbarung relevant? Wie wird der Ort der Offenbarung bestimmt? Macht es einen Unterschied, ob die Offenbarung in einem bestimmten Land zufällig oder gewollt erfolgt ist? Welches Recht ist anwendbar, um zu beurteilen, ob eine Offenbarung stattgefunden hat (das Recht des Landes, in dem die Information offenbart wurde, oder das Recht des Landes, in dem Neuheit und Erfindungshöhe zu beurteilen sind)?

Der Ort der Offenbarung ist nicht relevant. Es wird weltweite, absolute Neuheit verlangt. Somit erübrigen sich die restlichen Fragen.

2.4 *Persönliche Elemente*

Es kann unterschiedlich zu behandeln sein, ob eine Information durch den Anmelder eines gewerblichen Schutzrechts oder durch eine dritte Person offenbart wird. Dies betrifft auch den Ausstellungsschutz und die Neuheitsschonfrist.

Welche Unterschiede stellen die Gruppen im Hinblick auf die Person fest, die den Stand der Technik veröffentlicht? Wird eine Veröffentlichung anders behandelt, wenn die offenbarende Person durch eine Geheimhaltungsabrede gebunden war? Wie werden Irrtümer in der offenbarten Information behandelt?

Es spielt keine Rolle, durch welche Person der Stand der Technik offenbart wurde. Eine Offenbarung durch den Anmelder selbst ist genau so neuheitsschädlich wie durch jede andere Person. Die Schweiz kennt keine allgemeine Erfinderschonfrist („period of grace“).

Ausnahmen hiervon bilden die beiden in Art. 7b PatG definierten „unschädlichen Offenbarungen“:

- (a) offensichtlich missbräuchliche Offenbarungen zum Nachteil des Anmelders oder
- (b) Zurschaustellung auf einer anerkannten Ausstellung im Sinn des Übereinkommens vom 22. November 1928,

vorausgesetzt dass diese Offenbarung innerhalb von sechs Monaten vor dem Anmelde- oder Prioritätsdatum stattfand. In diesem Zusammenhang sei auf den Unterschied zwischen schweizerischem und europäischem Recht hingewiesen: Die sechs Monate werden nach Art. 7b PatG vom Anmelde- oder Prioritätsdatum an zurück gerechnet, nach Art. 55(1) EPÜ (bestätigt durch die Entscheidung G 3/98 der Grossen Beschwerdekammer des Europäischen Patentamtes, Amtsblatt EPA 2001, 62) nur vom Einreichungsdatum an.

Eine Geheimhaltungspflicht macht die Offenbarung nicht ungeschehen. Die veröffentlichte Information gehört künftig zum Stand der Technik, auch wenn die offenbarende Person zur Geheimhaltung verpflichtet gewesen wäre.

Zu Irrtümern in der offenbarten Information ist keine schweizerische Rechtsprechung bekannt. Gemäss europäischem Recht wirken sich (nicht ohne Weiteres erkennbare) Fehler in der Offenbarung nicht neuheitsschädlich aus (Entscheidung T 77/87 einer Technischen Beschwerdekammer des Europäischen Patentamtes, Amtsblatt EPA 1990, 280).

2.5 *Empfänger der Information*

Im allgemeinen erfordert das Prinzip der Offenbarung, dass Informationen der Öffentlichkeit gegenüber offenbart werden. Es mag Unterschiede mit Blick auf die Definition des Begriffs „Öffentlichkeit“ geben. Dies betrifft u.a. Vertraulichkeitsverpflichtungen oder die Fähigkeit, die Information zu verstehen.

Welche Erfordernisse gibt es im Hinblick auf die Fähigkeit zum Verständnis der Information? Reicht die Möglichkeit, dass eine Person Informationen durch zusätzliche Maßnahmen, wie etwa die Demontage von Vorrichtungen oder reverse engineering, erhält, aus, um eine Offenbarung zu begründen? Gibt es allgemeine Regeln im Hinblick auf Vertraulichkeit oder stillschweigend vereinbarte Vertraulichkeit?

Zur Beurteilung sowohl der Neuheit als auch der erfinderischen Tätigkeit wird eine fiktive Fachperson herangezogen. Diese ist mit dem allgemeinen Fachwissen auf ihrem Gebiet und mit der Fähigkeit zum logischen Denken, nicht aber mit Intuition oder Erfindertätigkeiten ausgestattet. Voraussetzung für eine relevante Offenbarung des Stands der Technik ist, dass diese fiktive Fachperson die offenbarte Information zu verstehen imstande ist.

Für die Offenbarung eines Standes der Technik reicht es aus, wenn die Öffentlichkeit von der Erfindung prinzipiell hat Kenntnis nehmen können; es ist unwichtig, ob jemand wirklich davon Kenntnis genommen hat. Es genügt, dass eine unbestimmte Anzahl von Personen die abstrakte Möglichkeit hatte, ein Dokument einzusehen, wenn sie danach fragten (Entscheidung des Schweizerischen Bundesgerichts 94 II 285). Analog dazu wird eine Offenbarung auch durch die blosse abstrakte Möglichkeit begründet, dass beliebige (nicht zur Geheimhaltung verpflichtete) Fachleute infolge einer Benützungshandlung von der Erfindung in einer Weise Kenntnis nehmen, die ihnen die Ausführung erlaubt (Entscheidungen des Handelsgerichts Bern, 26. 11. 1990, und des Schweizerischen Bundesgerichts, 15. 8. 1991, Schweizerische Mitteilungen über Immaterialgüterrecht 1993, 123).

Was zusätzliche Massnahmen wie Demontage oder Analyse betrifft, so wird nach schweizerischem Recht eine Neuheitsschädliche Offenbarung begründet, wenn diese zusätzlichen Massnahmen der Fachperson angesichts der Umstände zuzutrauen sind. Dies wird vor allem dann bejaht, wenn der Aufwand für die Untersuchung mässig ist und wenn die Fachperson auch Anlass hatte, in dem Produkt eine Neuigkeit zu vermuten. Als Beispiel sei ein Fall genannt, in welchem der Fachmann durch Reklameschriften auf die Neuigkeit aufmerksam gemacht worden war und es ihm ohne grosse Mühe und ohne Zerstörung des Produktes möglich war, das Produkt zu untersuchen (Entscheidung des Schweizerischen Bundesgerichts 68 II 393). Wenn aber die Neuigkeit nicht schon bei einem oberflächlichen Augenschein, sondern erst nach einer Zerstörung des Produktes erkannt werden kann, so begründet ein In-Verkehr-Bringen des Produktes noch keine Neuheitsschädliche Offenbarung (Entscheidung des Schweizerischen Bundesgerichts 58 II 285). Die schweizerische Rechtsprechung setzt somit bezüglich der Zugänglichkeit eine andere Gewichtung als die europäische, gemäss welcher der Aufwand für die Untersuchung des Produktes unerheblich ist (Entscheidungen G 1/92 und T 952/92 der Beschwerdekammern des Europäischen Patentamtes, Amtsblatt EPA 1993, 277 bzw. 1995, 755).

Informationen, die nur einer Geheimhaltungspflicht unterstehenden Personen zugänglich gemacht werden, begründen keine Offenbarung des Standes der Technik. Die Geheimhaltungspflicht kann ausdrücklich oder auch nur stillschweigend vereinbart worden sein. Wenn allerdings der Verpflichtete seine Geheimhaltungspflicht verletzt, so gehört die offenbarte Information künftig zum Stand der Technik. Durch Hinterlegung einer Patentanmeldung nach Art. 7b PatG (vgl. Teilfrage 2.4) innerhalb von sechs Monaten nach der missbräuchlichen Offenbarung kann der Anmelder den Schaden immerhin in Grenzen halten.

3. Offenbarung durch neue Medien

Moderne Technologien und insbesondere die Einführung des Internets haben den Zugang zu Informationen weltweit in deutlich kürzerer Zeit vereinfacht. Gleichzeitig scheint sich das Leben von Informationen zu verkürzen. Die Information ist während eines kurzen Zeitraums sichtbar und möglicherweise auch reproduzierbar. Dies führt auch zu der Gefahr der Manipulation von offenbarten Informationen, die entweder durch den Urheber oder durch dritte Parteien vorgenommen werden kann. Im Hinblick auf neue Medien scheint diese Gefahr deutlich höher zu sein als bei anderen Formen der Offenbarung, wie etwa schriftlichen Dokumenten. Das World-Wide-Web wirft Fragen auch im Hinblick auf den Ort der Offenbarung auf. Allein der Umstand, dass eine Information weltweit abgerufen werden kann, muss nicht zu einer Offenbarung im Rechtssinne in jedem Land führen. Insofern ergeben sich ähnliche Probleme wie im Zusammenhang mit der mündlichen Offenbarung, insbesondere Fragen der Beweisführung, des Zugangs und der Dauerhaftigkeit von Informationen.

3.1 Allgemeine Regeln

- *Bewirkt eine papierlose Information, z.B. in einem elektronischen Netzwerk oder über das Internet, eine ausreichende Offenbarung, um Neuheit oder Erfindungshöhe zu beeinflussen?*

Zur Präzisierung der Frage: Es werden nicht Neuheit und Erfindungshöhe (in Europa erfinderische Tätigkeit) beeinflusst sondern die patentrechtlichen Kriterien Neuheit und erfinderische Tätigkeit erfüllt oder nicht erfüllt. Somit stellt sich die Frage: Ist eine elektronische Information für diese Kriterien als Offenbarung relevant, solange sie nur gespeichert (aber abrufbar) ist?

Nach Meinung der Schweizer Gruppe ist der Bildschirm, eine visuelle Schnittstelle, als Papierersatz zu betrachten, sobald die Informationen darauf abgebildet werden können.

*Die elektronisch gespeicherte und **öffentlich abrufbare** (d.h. der Öffentlichkeit zugängliche) Information ist, analog zum Buch in einer öffentlichen Bibliothek, als publiziert und damit als ausreichend offenbart zu erachten.*

- *Gibt es im Vergleich mit anderen Arten der Offenbarung spezifische Erfordernisse?*
Ausgehend von der obigen Überlegung gibt es keine spezifischen Erfordernisse.
- *Bestehen Unterschiede im Hinblick auf verschiedene Formen der Netzwerke oder der Kommunikation, wie etwa das World-Wide-Web, Chat-Groups, Forums, E-Mail oder andere?*

Solange die Zugänglichkeit dieser verschiedenen Formen der Kommunikation nicht beschränkt ist, bestehen keine Unterschiede zu anderen Arten der Offenbarung.

Eine Ausnahme bildet das E-Mail, da es sich an einen oder mehrere spezifisch bezeichnete Adressaten richtet und der Öffentlichkeit nicht zugänglich ist, sofern der Provider nicht jedermann ermöglicht, den E-Mail-Verkehr generell einzusehen.

3.2 *Fragen der Vertraulichkeit*

- *Macht es einen Unterschied, wenn die Information verschlüsselt ist?*
Die verschlüsselte Information ist analog zur unter Verschluss aufbewahrten, ohne zusätzliche Mittel nicht erfassbaren Information zu werten. Entscheidend ist einzig die Frage, ob jedermann Zugang zur verschlüsselten Information bekommen kann oder ob der Kreis der Empfänger definiert und beschränkt ist. Geknackte verschlüsselte Information ist durch Missbrauch zur Publikation gekommen und kann somit unter den Bedingungen des Art. 7b PatG als unschädliche Offenbarung ausser Betracht bleiben.
- *Welche Relevanz besitzen Passwörter, Suchmaschinen und die Gebührenpflichtigkeit von Informationen?*

Passwörter: Zählen zu elektronischen Schlüsseln, sie gewähren Zugang zur Information für den der sie kennt. Passwörter haben den gleichen Rang wie die Verschlüsselung, zu der es einen "key" bzw. ein Passwort braucht. Entscheidend ist somit auch die Frage, ob der Zugang zum Passwort eingeschränkt oder nicht eingeschränkt ist.

Suchmaschinen: Suchmaschinen haben mit Vertraulichkeit nichts zu tun. Suchmaschinen suchen zusammen, was öffentlich zugänglich, also nicht vertraulich ist.

Gebührenpflichtigkeit: Gebührenpflichtige Informationen können von jedermann gegen Gebühr bezogen werden und sind somit nicht vertraulich. Gebührenpflichtigkeit beschränkt den Kreis der Empfänger nicht.

3.3 *Ort der Offenbarung*

Wie zuvor erläutert, kann in einigen Fällen der Ort der Offenbarung für die Beurteilung der Neuheit oder Erfindungshöhe relevant sein.

- *Welches ist der Ort der Offenbarung, wenn eine Information in das Internet eingestellt wird?*

Vergleicht man es mit der Zuständigkeit der Gerichte bei Streitsachen, so wäre es der Ort, an dem der Erfolg eintritt, mit andern Worten, dort wo die Offenbarung wahrgenommen wird (also nicht der Ort des Servers). Vergleicht man es mit dem Standort von Bibliotheken, wo die Informationen zu greifen sind, wäre es der Ort des Servers.

- *Genügt der blosse Umstand, dass eine Website an einem bestimmten Ort zugänglich ist, für eine Offenbarung an dem betreffenden Ort, oder sollte es zusätzliche Bedingungen oder Erfordernisse geben?*

Für das Kriterium der absoluten Neuheit genügt es, wenn die Information beliebig abgerufen werden kann. Der Ort der Information spielt keine Rolle, weil der Erfolg der Neuheitsschädlichen Offenbarung überall auf der Welt eintreten kann.

3.4 *Zeitpunkt der Offenbarung*

- *Gibt es bestimmte Erfordernisse für den Zeitpunkt und die Dauerhaftigkeit der Information, die durch elektronische Mittel verfügbar ist?*

Zeitpunkt: Der Zeitpunkt (Tag) ist wesentlich. Die Feststellung des Zeitpunktes im Sinne des Beweises ist bei Informationen auf dem Web völlig unsicher. Das Datum von elektronischen Informationen ist nicht vertrauenswürdig.

Dauerhaftigkeit: Die Dauerhaftigkeit ist nicht wesentlich. Es reicht auch eine kurze Dauer der öffentlichen Verfügbarkeit, damit eine Offenbarung für die Betrachtung der Neuheit und erfinderischen Tätigkeit relevant wird.

- *Sind Archive notwendig oder wünschenswert?*

Zum Zweck der Beweisführung und um Informationen einem vertrauenswürdigen Zeitpunkt der Offenbarung zuordnen zu können und auf Dauer zu sichern, wären (zertifizierte) Archive wünschenswert.

3.5 *Fragen der Beweisführung*

Informationen im Internet mögen im Einzelfall nicht so dauerhaft sein wie schriftliche Dokumente. Dies kann zu einem Verlust des Dokuments führen oder Probleme der Beweisführung oder Manipulation aufwerfen. Solche Probleme können sich sowohl während des Erteilungsverfahrens als auch bei Verletzungsverfahren ergeben.

- *Wer sollte die Beweislast dafür tragen, daß eine bestimmte Information über das Internet offenbart wurde?*

Die Beweislast soll derjenige tragen, der die Vorpublikation behauptet.

- *Erfordert das Internet Regeln, die sich von den schon bestehenden Regeln für die mündliche Offenbarung oder die Offenbarung auf anderem Wege unterscheiden?*

Wenn der Anspruch an die Strenge des Beweises durch erweiterte Regeln bezüglich oder wegen des Internet angegriffen würde, wäre das ein Schritt zur Rechtsunsicherheit. Es sollen dieselben Beweisregeln zum Beweis der Vorpublikation gelten wie bis anhin. Die leichte bzw. einfache Manipulierbarkeit der elektronisch gespeicherten Informationen erschwert zwar die Beweisführung, erfordert jedoch keine speziellen Regeln.

- *Sollte es unterschiedliche Grade des Beweises für verschiedene Wege der Offenbarung geben?*

Nein, die Rechtssicherheit erfordert eine einheitliche Handhabung der Beweisführung.

- *Erfordert die potentielle Manipulation von Informationen, die durch neue Medien offenbart wurden, unterschiedliche Maßstäbe für die Anerkennung solcher Offenbarungen und gibt es für diese Art von Offenbarungen spezifische Regeln?*

Mit der potenziellen Manipulation von Informationen stellt sich das Problem der Beweisführung. Es sollten jedoch keine unterschiedlichen Massstäbe für die Anerkennung von Offenbarungen durch neue Medien aufgestellt werden.

Eine Möglichkeit, mit einer zusätzlichen Massnahme für die neuen Medien die Strenge der Beweisführung einzuhalten, wäre die Schaffung von staatlichen oder öffentlich-rechtlichen, jedermann zugänglichen Archiven, in welchen Informationen hinterlegt werden können, die als Beweismittel dienen sollen.

4. Vorschläge für die zukünftige Harmonisierung

Nachdem immer mehr Länder, nicht nur in Europa, sich für die Modernisierung und Angleichung ihrer Patentgesetze an das Europäische Patentübereinkommen bzw. das Strassburger Übereinkommen einsetzen und vor allem die entsprechenden Vorschriften betreffend Neuheit und erfinderische Tätigkeit von diesen Übereinkommen übernehmen, ist eine naheliegende Harmonisierung davon zu erwarten, dass noch weitere Länder diesem Beispiel folgen.

Eine derartige Vereinheitlichung der materiellen Voraussetzungen erscheint der Schweizerischen Gruppe der AIPPI wichtiger als eine Diskussion der Detailfragen im Zusammenhang mit der Offenbarung des Standes der Technik.

Im Falle einer Revision des schweizerischen Patentgesetzes könnte eine komplette Harmonisierung des Artikels 7 PatG mit dem entsprechenden Artikel 54 EPUe in Betracht gezogen werden.

Zusammenfassung

Die Schweiz hat, als Vertragsstaat des Europäischen Patentübereinkommens, für die Voraussetzungen der Neuheit und der Erfindungshöhe (in Europa: Erfinderische Tätigkeit) sein Patentgesetz an die Bestimmungen des Strassburger Übereinkommens von 1963 angeglichen. Damit sind die Standards für Offenbarungen im Stand der Technik entsprechend diesem Übereinkommen geregelt und werden allgemein als "absolutes" Neuheitserfordernis bezeichnet, d.h. die Offenbarungen sind unabhängig von Weg, Zeit, Ort und Empfänger der Information zu betrachten.

Die Offenbarung durch neue Medien erfordert dementsprechend keine neuen Vorschriften und es stellt sich - jedoch nur für diejenige Partei, welche im Streitfall die Beweislast trägt, d.h. welche eine Offenbarung im Stand der Technik nachweisen soll - in Einzelfällen nur die Frage der Beweisführung. Zur Erleichterung dieser Bürde wäre es sinnvoll, staatliche oder öffentlich-rechtliche, allen zugängliche Archive für Informationen durch neue Medien zu schaffen.

Eine weitere Harmonisierungsmöglichkeit sieht die Schweizerische Landesgruppe darin, dass noch weitere Länder ihre Patentgesetze an das Strassburger Übereinkommen anpassen.

Résumé

La Suisse est un Etat contractant de la Convention sur le brevet européen et a aligné, par conséquent, sa loi des brevets pour les conditions de nouveauté et de niveau inventif (en Europe: activité inventive) aux règles de la Convention de Strasbourg de 1963. Les critères de divulgation dans l'état de la technique sont, par conséquent, déterminés par cette convention et sont connus en général comme condition de nouveauté "absolue", c'est-à-dire que les publications sont traitées indépendamment des moyens, de la date, du lieu et du bénéficiaire de l'information.

La divulgation par les nouveaux média ne nécessite pas de règles nouvelles et ne pose que la question de la preuve dans certains cas, mais seulement pour la partie qui doit apporter la preuve en cas de litige, c'est-à-dire fournir la preuve d'une divulgation dans l'état de la technique. Pour simplifier cette preuve, on pourrait recommander d'établir des archives pour les informations par les nouveaux média qui soient accessibles à tout le monde et gérées par l'Etat ou une organisation contrôlée par l'Etat.

Le Groupe Suisse de l'AIPPI voit une possibilité d'harmonisation améliorée en ce que des pays additionnels alignent leur loi des brevets à la Convention de Strasbourg.

Summary

As a contracting state of the European Patent Convention, Switzerland has adapted its patent law for the conditions of novelty and inventive step to the rules of the Strasbourg Convention of 1963. The standards for disclosures in the state of the art are, therefore, determined by this convention and are generally referred to as "absolute" novelty requirement, i.e. disclosures are to be looked at independently from the means, the time, the place and the recipient of the information.

The disclosure through new media does not require, therefore, new rules and it raises only - but only for the party which in conflict cases has to bring evidence, i.e. which has to prove the disclosure in the state of the art - the question of proof in particular cases. To simplify the burden of proof, it would be advisable to establish archives for informations through new media which are open to everybody and managed by the state or state-controlled organisations.

The Swiss Group of AIPPI sees a possibility for further harmonisation in that further countries would adapt their patent laws to the Strasbourg Convention.

Report Q167

in the name of the UK Group

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Introduction

There is no provision, at present, in the UK for utility models and the report therefore concentrates on the effect of novelty and inventive step requirements for Patents. Our answers are principally confined to the position under the UK Patents Act 1977 and the European Patent Convention as interpreted by the English Courts and the Technical Boards of Appeal of the European Patent Office.

Determination of prior art

1.1 *What is the effect of a prior art disclosure on novelty and inventive step?*

The current situation in the UK (under the EPC and the UK Patent Act) is that any disclosure made available to the public anywhere in the world prior to the priority date is relevant to novelty and inventive step.

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

There is no difference in the relevance of a piece of prior art for novelty and inventive step considerations except in relation to certain copending patent applications in the UK (including European and PCT patent applications designating the UK). Co-pending patent applications which have an earlier priority date and which are eventually published (but are not published at the priority date of the patent application in question) are relevant for novelty consideration. Co-pending patent applications which are not eventually published are not relevant either for novelty or inventive step.

Under the proposals for the Community Patent Convention an unpublished UK patent application (which eventually publishes) will be relevant to the novelty of a CPC application. However, an unpublished UK national patent application is only relevant to the novelty of the UK designation of a European application (although the EPO does not examine the effect of such copending national applications) or to another UK application.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

This is defined in Section 2 (2) of the UK Patents Act:

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

Information is disclosed when its disclosure from one party to another is unfettered by confidentiality obligations. The disclosure must be enabling. A disclosure is enabling if a skilled person can reproduce its teaching.

This is supported by the EPO and UKPO guidelines and case law (Milliken [1996] FSR 292, Asahi [1991] RPC 485).

2. Criteria for Disclosure

2.1 Means of disclosure

What are recognised means of disclosure?

Written or oral disclosure or use in any way

Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?

The only difference in relation to the types of disclosure is the requirement for proof (see 3.5). Oral disclosure is more difficult to prove, particularly before the EPO, see for example, T1212/97, as is proof of prior use where the EPO require what occurred to be proved “beyond reasonable doubt”. The obscurity of a piece of prior art is not relevant although this could affect whether it is part of the common general knowledge and consequently can reasonably be read with another document (T206/83), *Windsurfing v Tabur Marine*, [1985] RPC 59 and *Hoechst-Celanese v BP*, [1997] FSR 547.

If certain means of disclosure are not recognised either by law or in practice, what are the reasons?

Not relevant.

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

See the answer to Q2.1. When the disclosure took place is irrelevant, except if its age affects whether it can be considered as part of the common general knowledge.

2.3 Place of Disclosure

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

See the answers to Q1.1 and 1.3. What constitutes a disclosure unfettered by confidentiality obligations may be dependent on contract/employment law in the country where that disclosure took place, *Lux Traffic v Pike Signals* [1993] RPC 107. Disclosure at an international exhibition falling within the terms of the Convention on International Exhibitions is permitted under Section 2(4)(c) of the UK Patents Act provided a patent application is filed within six months of the Exhibition.

2.4 Personal elements

What differences do the Groups observe with regard to the person who discloses the prior art?

There are very limited provisions in Section 2(4) of the UK Patent Act in relation to exceptions to what constitutes a disclosure as outlined in the answer to Q1.1. Primarily, these relate to disclosed information that was illegally acquired from the applicant (or otherwise published in breach of confidence).

Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?

See the answer to Q2.3 above.

How are errors in the disclosed information treated?

When it is clear from contemporaneous evidence that the literal disclosure of a document is erroneous, then the erroneous disclosure is not part of the state of the art (T77/87).

2.5 *Recipient of the information*

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?

Oral disclosure to an audience that is not in a position to understand the invention does not constitute a disclosure to that audience prejudicial to patentability, as outlined in Q1.1, (T877/90).

If the invention is provided to a third party in such a manner that its nature can be determined by disassembly of elements or reverse engineering then this constitutes a prejudicial disclosure (G1/92), although the date of disclosure is the date at which this reverse engineering could have taken place, (T461/88).

Are there general rules providing for the effect of confidentiality or implied confidentiality?

See the answer to Q2.3 above. Mere encryption of information of itself does not make this information confidential, Mars UK v Teknowledge [2000] FSR 138.

3. **Disclosure through new media**

3.1 *General rules*

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the World-wide Web, chat groups or forums, e-mail and others?

The key criterion is whether the information is made available to the public (e.g. as in Q1.1). Whether disclosure has taken place will depend on the individual facts. Information sent by letter is considered to be not available to the public whilst that on a postcard is. It is believed that e-mail correspondence is closer to the former but there is not yet case law on this.

Information on the world-wide web is considered published unless the information is protected in some way (e.g. by restricting access).

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

See Q3.1 and Q1.3 also Q2.5

3.3 *Place of disclosure*

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

The place of disclosure is irrelevant, see Q2.3. There are no additional conditions or requirements.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

The issue is one of evidence, if it is possible to prove that the information was available, however temporarily, then it is a prejudicial disclosure. It is no different from a book appearing on library shelves even though nobody may have known it was there (T381/87).

3.5 Questions of evidence

Who should have the burden of proof that a specific piece of information was disclosed on the internet?

The party attempting to invalidate a patent should bear the burden of proof.

Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways?

The outcome of the Court's attitude in relation to Q3.1 may be relevant here but the answer is probably no.

Should there be different levels of evidence for different ways of disclosure?

No.

Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

No.

4. Conclusion

The current definition of prior art (prejudicial disclosure) applied in the UK is simple, straightforward and supported by case law, and consistent with that applied by other members of the EPC. In addition, it is believed that the standards applied by the EPC signatories and Japan are moving closer together. Consequently, it is felt that any harmonisation should be to the standard applied by the EPO.

The question of what constitutes an "enabling" disclosure is an important one which merits further study by AIPPI.

Summary

UK law on novelty and inventive step is in accordance with that of the other member states of the European Patent Convention. Decisions from the UK Courts are consistent with those from the Boards of Appeal of the European Patent Office.

Any enabling disclosure, be it written or oral or in electronic form, is relevant to novelty and inventive step. Information is not disclosed if it is in breach of confidentiality obligations. There are no fundamental differences between written and oral disclosures and those through new media although the evidence required to prove disclosure may differ.

Any international harmonisation in this area should be to the standard applied by the EPO.

Résumé

La législation britannique sur la nouveauté et l'activité inventive est en conformité avec celle des autres états membres de la Convention sur le brevet européen. Les décisions des tribunaux britanniques sont conformes à celles des Boards of Appeal de l'Office européen des brevets (OEB).

Toute "enabling disclosure" (divulgarion en vue de réaliser l'invention), qu'elle se présente sous forme écrite ou orale ou électronique, se rapporte à la nouveauté et l'activité inventive. Les informations ne sont pas divulguées si elles sont en rupture des obligations en matière de confidentialité. Il n'y a pas de différences fondamentales entre les divulgations écrites et orales et celles faites par l'intermédiaire de nouveaux moyens, bien que les preuves requises pour prouver la divulgation puissent être différentes.

Toute harmonisation internationale dans ce domaine devrait être suivant la norme appliquée par l'OEB.

Zusammenfassung

Das englische Recht bezüglich Neuheit und erfinderischer Tätigkeit stimmt mit dem der übrigen Mitgliedsstaaten des Europäischen Patentübereinkommens überein. Die Urteile der englischen Gerichtshöfe stehen mit denen der Beschwerdekammern des Europäischen Patentamtes in Einklang.

Für jede ausführbare Offenbarung, gleich ob sie schriftlich, mündlich oder in elektronischer Form vorliegt, sind Neuheit und erfinderische Tätigkeit maßgeblich. Informationen werden nicht offenbart, wenn dies eine Verletzung der Geheimhaltungspflicht bedeuten würde. Es bestehen keine grundlegenden Unterschiede zwischen schriftlichen und mündlichen Offenbarungen sowie denen, die mittels neuzeitlicher Medien vorliegen, jedoch können die erforderlichen Beweismittel für die Prüfung der Offenbarung variieren.

Jede internationale Harmonisierung auf diesem Gebiet sollte dem Standard entsprechen, der vom EPA angewendet wird.

Report Q167

in the name of the United States Group
by Edward G. FIORITO (Chair),
Linda S. RESH, and Stephen WEBB

**Current standards for prior art disclosure in assessing novelty
and inventive step requirements**

1. Determination of Prior Art

1.1 What is the effect of a prior art disclosure on novelty and inventive steps (obviousness)? Are there differences between prior art regarding novelty on the one hand and inventive step (obviousness) on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step (obviousness)?

Prior art disclosures that may affect novelty and obviousness under United States patent law are identified in 35 U.S.C. § 102,¹ as interpreted by federal case law and patent office

¹

Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in -
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g)
 - (1) during the course of an interference conducted under section 135 or section 291, another inventory involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or
 - (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

practice. The same categories of disclosures constitute prior art for both novelty and obviousness analyses.

Pending unpublished United States applications and foreign applications that are the subject of a priority claim in a United States application that has not yet been published may be used to prove priority of invention under 35 U.S.C. § 102(g) in an interference proceeding. In addition, should the pending application be published under section 122(b) of the United States patent laws or issue as a United States patent, all information disclosed in the application is available as a prior art reference as of the date when the application for patent was filed. This is the case even though the disclosure does not become public until a patent issues or the patent application is published.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Yes. Section 102 (set out above) of the United States patent laws indicates what types of disclosures may constitute prior art.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure?*

Printed publication

Public accessibility is the primary consideration for printed publication status. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 936 (Fed. Cir. 1990) (distributing four reports describing complicated military system to approximately fifty people was not publicly accessible so as to constitute printed publications); In re Hall, 781 F.2d 897, 899 (Fed. Cir. 1986) (single catalogued doctoral dissertation was a printed publication as it was “sufficiently accessible to one interested in the art”); Preemption Devices, Inc. v. Minnesota Mining & Mfg. Co., 732 F.2d 903, 905 (Fed. Cir. 1984) (affirming lower court’s decision that “the dissemination of six copies to an individual was not a ‘publication. . . .’”).

Prior knowledge

Prior knowledge of an invention cannot be secret or private knowledge; it must be known to the public. E.g. Alexander Milburn Co., 270 U.S. at 325 (noting that prior knowledge of an earlier inventor would not have barred patenting the invention at issue had the earlier inventor “written out his prior description and kept it in his portfolio uncommunicated to anyone”); Baron v. Bausch & Lomb, Inc., 25 USPQ2d 1641, 1662 (W.D.N.Y. 1992) (“Private knowledge is not part of the prior art.”).

Prior use

Although section 102(a) does not require it expressly, United States case law requires that a prior use must be “public” for it to serve as prior art. Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998) (“[I]n order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been available to the public.”); Carella v. Starlight Archery, 804 F.2d 135, 139 (“[T]he § 102(a) language ‘known or used by others in this country’ means knowledge or use which is accessible to the public.”). However, this publicity requirement may be met by an absence of affirmative steps by the prior user to conceal the use, as opposed to positive steps to make the device or process known to the public. See National Research Development Corp. v. Varian Associates, Inc., 28 U.S.P.Q.2d 1436, 1447 (D.N.J. 1993) (“There is simply no requirement that the prior user make an effort to make the invention publicly accessible, so long as he or she uses it in the ordinary course of business without efforts to conceal it.”).

On the other hand, § 102(b) specifically mentions “public use.” However, courts have interpreted this provision broadly allowing seemingly private use to constitute public use. E.g. Baxter Int’l, Inc. v. Cobe Laboratories, Inc., 88 F.3d 1054, 1059–60 (Fed. Cir. 1996) (private laboratory use of invention by scientist unaffiliated with inventor constituted public use); In re Smith, 714 F.2d 1127, 1134 (Fed. Cir. 1983) (defining public use as “any use of [an] invention by a person other than the inventor who is under no limitation, restriction, or obliga-

tion of secrecy to the inventor.”). The “experimental” use of an invention is not regarded as a public use. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 1120 (Fed. Cir. 1996) (noting that the “[experimental use] doctrine is based on the underlying policy of providing an inventor time to determine if the invention is suitable for its intended purpose.”).

On Sale

The on-sale bar of § 102(b) precludes patenting an invention that was on sale in the United States more than one year prior to the applicant’s filing date. 35 U.S.C. § 102(b). For an invention to be considered “on sale” for purposes of § 102(b), two conditions must have been satisfied before the critical date of one year prior to the inventor’s date of application. *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67 (1998). The product must have been the subject of a commercial offer for sale, and the invention must have been ready for patenting. *Id.* The second condition can be met by proof that the product had actually been reduced to practice, or “by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” *Id.*

Prior Patent

A patent, regardless of whether it is granted in the United States or a foreign country, will constitute a prior art disclosure for both novelty and obviousness analyses. Because foreign countries frequently grant rights that are markedly different from those granted in the United States, an issue arises as to whether such grants are “patents” under United States patent law.² *Id.* See also *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1992) (German *Geschmacksmuster* qualifies as a foreign patent under § 102(a) and constitutes prior art for use in an obviousness analysis, “because [it] fully discloses the design upon which German law conferred the exclusive rights attendant to the registration. . . .”); *Atlas Glass Co. v. Simonds Mfg. Co.*, 102 F. 643 (3d Cir. 1900) (Danish “eneret” held to be a patent within the meaning of the statute even though it merely conferred the exclusive right to make the patented device in Denmark); *Brooks v. Norcross*, 4 F. Cas. 294 (No. 1957) (C.C.D. Mass. 1851) (noting that secret and publicly inaccessible grants by foreign countries would not constitute a patent). If a foreign patent does not confer rights sufficient to qualify as a patent under § 102(a), it may nevertheless constitute prior art as a prior printed publication so long as it meets the requirements of that form of disclosure.

2. Criteria for Disclosure

The determination of a disclosure has to consider various criteria. These criteria comprise the means of information (written, oral or otherwise), the time of information (recently or a long time ago), the place of information (domestic or abroad), the person who discloses the information (the applicant of an IPR or a third person) and the recipient.

2.1 Means of Disclosure

It should be stated in the Group Reports which form of disclosure has an impact on novelty and inventive step. In particular it will be interesting to hear if disclosure is limited to certain means of information or rather unlimited. This includes oral disclosure as well as new ways of information, such as the internet, which will also be covered in the next question.

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

Section 102 of the United States patent laws sets forth the recognized means of disclosure that may constitute prior art. Patents, printed publications, pending United States patent applications, offers for sale in the United States, and prior knowledge or use in the United States are all recognized means of disclosure that may constitute prior art. See 35 U.S.C. § 102.

² The rights granted through foreign “patents” are examined in a determination of whether a foreign patent constitutes prior art for purposes of § 102(a), (b), or (d).

Oral testimony offered to establish prior knowledge, use or invention of a purported invention, particularly when provided by interested persons, generally requires corroborating testimony or evidence in support and will not alone support a finding of lack of novelty or of obviousness

2.2 *Time of Disclosure*

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

A patent or publication serves as a prior art disclosure, which may be used to assess novelty and obviousness, no matter how old the patent or publication. *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F.2d 345, 350 (2nd Cir. 1945) (“A patent may have lain for years unheeded, as little contribution to the sum of knowledge as though it had never existed, an idle gesture long since drifted into oblivion. Nevertheless, it will be as effective to invalidate a new patent, as though it had entered into the very life blood of the industry.”)

Prior knowledge or prior use may fall into the category of “lost art” and become unavailable as prior art because evidence of such prior knowledge or prior use is no longer available.

2.3 *Place of Disclosure*

In some countries only a disclosure of a piece of information in that specific country may affect novelty whereas a disclosure abroad will not be taken into consideration. As an example, one can mention the publication of printed materials which are published in one country and of which only a few copies will cross the border to another country by accident or unintentionally.

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

Prior knowledge, use, sale or invention, not embodied in a patent or printed publication, serves as prior art only if it occurs in the United States. A prior patent or printed publication serves as prior art regardless of the country in which it is disclosed. 35 U.S.C. §§ 102(a) & (b). When this limitation on what could constitute prior art was adopted in the mid-1800's, foreign inventions that had been patented or printed were considered to have been “already given to the world and open to the people of this country, as well others, upon reasonable inquiry.” *Gaylor v. Wilder*, 51 U.S. 477, 497 (1850). However, if the foreign invention had not been patented or printed in a publication, people in the United States would not benefit from its discovery, as “the means of obtaining [the] knowledge would not be within their reach.....” *Id.* Therefore, “it would be the same as if the [invention] had never been discovered.” *Id.* Although these concerns have been alleviated, if not eliminated, by our more connected modern world, this restriction on foreign prior art remains in place in the United States patent laws.

No distinction is made in considering whether something constitutes a prior art disclosure under United States patent law as to whether the disclosure was made intentionally or accidentally.

2.4 *Personal Elements*

It may make a difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

Under United States law, several types of disclosures only constitute prior art if made by a party other than the inventor. Section 102(a) explicitly precludes patenting “an invention [that] was known or used by others.” 35 U.S.C. § 102(a). An applicant’s own prior original work cannot anticipate his own later invention under section 102(a). E.g. *In re Katz*, 687 F.2d 450, 454 (CCPA 1982) (“[O]ne’s own work is not prior art under section 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a)”) Section 102(b) provides for a one year grace period for an inventor’s disclosures. Similarly, § 102(e) pending United States patent applications require disclosure “by another.” 35 U.S.C. § 102(e).

Although a putative inventor may have a breach of contract or other legal action against a party who discloses information relating to an invention in breach of a confidentiality agreement, a disclosure that otherwise satisfies the requirements of section 102 would constitute prior art even if made in breach of a confidentiality agreement. For example, if material covered by a confidentiality agreement were included in a printed publication that satisfies the requirements such as public accessibility for such a disclosure, such a disclosure would serve as prior art under section 102(b).

2.5 Recipient of the Information

In general, the concept of disclosure requires that information be disclosed to the public. There may be differences with regard to the definition of the public. This concerns, among others, confidentiality obligations or the ability to understand the information.

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

For a disclosure to constitute prior art for novelty and obviousness analyses, the disclosure must enable one of ordinary skill in the art to comprehend and make the invention. The prior art is not required to teach principles or skills that are well-known to one of ordinary skill in the art to which the invention pertains.

The existence of a confidentiality agreement or a finding of implied confidentiality is considered in determining whether a use is “public” under §§ 102(a) and (b). *Fujitsu Microelectronics*, 853 F. Supp. 808, 816 (M.D. Pa. 1994) (noting that the presence of a confidentiality agreement “weigh[ed] heavily against the [] presentations having been public uses”). Similarly, a written disclosure made under a confidentiality agreement does not qualify as a publication under Sections 102(a) or 102(b) and disclosure of information in confidence does not qualify as public knowledge under Section 102(a).

3. Disclosure through new media

Modern technologies and in particular the introduction of the internet have made access to information world-wide much easier in a much shorter time. At the same time, the life of the information seems to be getting shorter. Information is visible and maybe also reproducible for a short time. This also leads to the danger of manipulating the disclosed information which can be done either by the author or by third parties. With regard to new media this danger seems significantly higher than in other forms of disclosure, such as written documents. The world-wide web raises questions as to the place of disclosure. Merely the fact that information can be accessed all over the world may not lead to a disclosure in the legal sense in every country. Problems arise which are similar to those in connection with oral disclosure, such as questions of evidence, accessibility and duration of the information.

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat rooms or forums, e-mail and others?

The United States does not have any special rules or laws expressly indicating whether information disclosed on the internet constitutes prior art. Whether electronically transmitted information will be determined to be prior art under United States patent law is not clear. Patent protection is barred under Section 102 of the United States patent statute if, among other things, (a) the invention was known or used by others in the United States prior to the invention thereof by the applicant for patent, or (b) the invention was disclosed in a printed publication anywhere in the world more than one year before the priority date of the application for patent. Disclosures made over the internet likely may qualify as prior art under one of these two provisions.

The term “printed publication” has been broadly construed in the United States. See *In re Wyer*, 665 F.2d 221, 227 (if a document is “available and accessible to the persons concerned with the art,” it is a printed publication “whether ... printed ... on microfilm or magnetic disk or tape ...”). Given this broad definition, a disclosure made by presenting information on a web site likely would constitute prior art as a printed publication if it met the requirements of public accessibility required for such a prior art disclosure. Some method would be required to provide public accessibility to the information, such as indexing of the information by a search engine to permit access.

Disclosure of information in private e-mails should not constitute sufficient disclosure to affect novelty or inventive step (non-obviousness). Such information is not publicly accessible.

3.2 *Questions of confidentiality*

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

The encryption of information should be considered in determining whether the information is publicly accessible. If the information is encrypted so as to maintain the information as confidential, such information likely would not constitute a prior art disclosure under United States patent law.

The possibility of the information being uncovered by a search by a search engine should be considered in determining the public accessibility of the information.

Whether payment is required to view the information does not appear to be important in determining its public availability provided that the information is available to anyone concerned with the art who is willing to pay the fee.

3.3 *Place of disclosure*

As explained earlier, in some cases the place of disclosure may be relevant for the assessment of novelty or the inventive step.

For prior knowledge or use to constitute prior art under United States patent law, the information must be known or used in the United States. Accordingly, in considering whether a disclosure on the internet constitutes prior knowledge or use in the United States, the place of disclosure is relevant. Given the nature of internet communications, the proper analysis likely would be whether the information was publicly accessible to those concerned with the art in the United States, not whether the information originated from or was maintained on a computer in the United States.

3.4 *Timing of disclosure*

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

The information should appear on the internet long enough so that it is accessible to the public. This should be decided on a case-by-case basis. Various factors should be considered including how often the particular web site is accessed. Archives are desirable to establish what material was placed on the internet and when that information was placed on the internet.

3.5 Questions of evidence

The fact that information on the internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or manipulation. Such problems may arise during the prosecution of a patent application as well as in infringement cases.

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

During prosecution, the United States Patent Office should have the burden of proving that the information was disclosed. In the case of an infringement action, the accused infringer who is seeking to invalidate the patent should have the burden of proving that the information was disclosed.

No need exists for different rules to determine whether a specific piece of information was disclosed on the internet. The same rules applicable for oral disclosure, including a requirement for corroboration of oral testimony, may be applied.

Summary

Current United States patent law relating to novelty and obviousness is well-documented and well-settled. How this law will be applied to disclosures through new media such as the internet, however, remains an open question. The United States does not have any special rules or laws expressly indicating whether information disclosed on the internet constitutes prior art. This question also has not yet been addressed and resolved by the courts in the United States that handle patent cases.

The current United States patent law appears flexible and robust enough to address the novel issues presented by disclosures through new media such as the internet without requiring amendment to the United States patent laws or the creation of new rules or laws. Certain disclosures through new media such as the internet that satisfy the requirements of public accessibility are likely to be found to constitute prior art under United States patent law.

Résumé

Les Etats-Unis actuels le droit des brevets concernant la nouveauté et l'évidence est bien documentée et bien-arrangée. Comment cette loi sera appliquée aux révélations par de nouveaux médias tels que l'Internet, cependant, une question en suspens des restes. Les Etats-Unis n'ont aucunes règles spéciales ou loi indiquant expressément si l'information révélée sur l'Internet constitue l'art antérieur. Cette question également n'a pas été encore adressée et n'a pas été résolue par les cours aux Etats-Unis qui manipulent des cas de brevet.

Les Etats-Unis actuels le droit des brevets semblent flexibles et assez robuste pour aborder les questions de nouveauté présentées par des révélations par de nouveaux médias tels que l'Internet sans exiger l'amendement aux Etats-Unis faites breveter les lois ou la création de nouvelles règles ou lois. Certaines révélations par de nouveaux médias tels que les Internet qui répondent aux exigences de l'accessibilité publique sont susceptibles de s'avérer constituer l'art antérieur en vertu du droit des brevets des Etats-Unis.

Zusammenfassung

Die derzeitigen Patentgesetze der Vereinigten Staaten bezüglich Neuheit und Offensichtlichkeit sind gut dokumentiert und arrangiert. Wie diese Gesetze jedoch für Veröffentlichung durch neue Medien, wie z.B. das Internet angewendet werden, verbleibt eine unbeantwortete Frage. Die Vereinigten Staaten haben keine speziellen Regeln oder Gesetze, die ausdrücken, ob Informationen, die über das Internet veröffentlicht werden, bestehendes Wissen darstellen. Diese Frage ist auch von den Gerichten in den Vereinigten Staaten, die Patent fälle behandeln, noch nicht adressiert und gelöst worden.

Die derzeitigen Patentgesetze scheinen flexibel und robust genug zu sein, die Angelegenheit der Veröffentlichung von Neuheiten durch neue Medien, wie z.B. das Internet, zu behandeln, ohne die Notwendigkeit einer Ergänzung der Patentgesetze der Vereinigten Staaten oder der Erstellung neuer Regeln oder Gesetze. Bestimmte Veröffentlichungen durch neue Medien, wie z.B. das Internet, die die Bestimmungen des öffentlichen Zuganges erfüllen, werden wahrscheinlich beurteilt werden, bestehendes Wissen nach den Patentgesetzen der Vereinigten Staaten darzustellen.

Report Q167

in the name of the Uruguayan Group

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Patents of Invention and Utility Patents

Introduction

The main requirements established by our legislation in regard to patentability are in fact: novelty, inventive step and industrial applicability and such concepts are defined in our Patent Act.

1. Determination of prior art

- 1.1 Our Patent Examiners do in fact discriminate novelty and inventive step in regard to an application under examination, and any of these aspects may be grounds for lack of patentability.
- 1.2 Article 9 of our Patent Act, provides definitions as to novelty and prior art, as follows:

Article 9:

“The invention is deemed novel when it is not within the state of the art.

By state of the art it is meant the know-how that has been made known to the public before the application filing date or, if this is the case, before verified priority, through an oral or written description or by any other means, within the country or abroad, so that said know-how can be executed.

The contents of an already filed application whose corresponding steps are being taken in the country, with a filing date or, if this is the case, with a priority date, prior to the date of the application under examination, shall also be considered within the state of the art, providing said contents will be kept in the first application when published.”

As appreciated from the above transcribed article 9, the contents of a pending application which has not yet been published may be cited as prior art in regard to a second application, once the first is published.

- 1.3 In order to determine whether a piece of prior art has been disclosed, the following steps are taken:
 - a) An official search as to anticipations is carried out at the Patent Office. Such search is conducted amongst the Europe (PCT), US and national archives on the basis of the international codes of patent classification.
 - b) Publication of an application in the Industrial Property Bulletin opens a term of 60 days within which any interested party may file observations thereto, including citations of disclosed and relevant prior art.

2. Criteria for disclosure

The aspects raised in points 2.1 through 2.5 are dealt with in articles 9 and 10 of our Patent Act.

The criteria as to means and place of the information disclosed are dealt with in article 9 above. As stated therein, there is no difference as to whether disclosure is written, oral or otherwise, neither as to the place involved, which may be in the country or abroad.

However, the third paragraph of article 9 seems to exclude those foreign applications not filed in Uruguay and not published worldwide.

Furthermore, the said article includes a condition in regard to the information disclosed: "so that such know-how can be executed".

In regard to time and person disclosing information, these aspects appear in article 10 of our said Act:

Article 10:

"Novelty shall not be affected by the disclosure of the invention made within the term of one year before the filing date of the application or the invoked priority, providing said disclosure comes directly or indirectly from actions performed by the inventor as well as by his/her heirs or by third parties, based on information obtained directly or indirectly from said inventor."

Our law does not differentiate if the disclosure happens accidentally or intentionally, and in order to established if disclosure has occurred, our Examiners will always apply the relevant provisions of our legislation.

Without prejudice to the above, articles 120 and 121 of our law, in accordance with TRIPS, establish the sanctions applicable to those persons intervening in the prosecution of an application, who may violate a confidentiality agreement:

Article 120:

"Those employees of the Industrial Property Office acting in the proceedings of the applications for the rights governed hereby shall respect the confidentiality of this information. Violation of the same shall be deemed as serious offence."

Article 121:

"Those persons working for the Industrial Property Office who take part in the proceedings of the rights granted hereunder shall not take part in said proceedings on their own interest or representing third parties, neither directly nor indirectly, until the term of two years as from the date when the labor relation ceased.

Violation of the previous provision shall entail the following penalties:

- a) Dismissal, if the person is a civil servant.
- b) Contract cancellation, if the person signed a labor contract with the Industrial Property Office.
- c) Fine, in the event that the person intervenes before the above mentioned two year term has elapsed.

The amount of the fine shall vary from 10 to 100 UR (ten to one hundred monthly readjusted monetary units) according to the seriousness of the infringement."

3. Disclosure through new media

Bearing in mind that our legislation does not differentiate in regard to means or place of information, the disclosure through new media would fall within the provisions of articles 9 and 10 of our Patent Act.

Any interested party declaring that a specific piece of information was disclosed on the internet, will have to submit evidence to such effect.

Report Q167

in the name of the Venezuelan Group

Current standards for prior art disclosure in assessing novelty and inventive step requirements

1. Determination of prior art

As the title of the question indicates, the question deals with prior art disclosure. Its goal is not to deal with specific questions arising from disclosure in the context of the scope of protection or the formalities of patent applications. In order to determine criteria for prior art disclosure it should be stated at first, what the main principles are with regard to the relationship between disclosure, novelty and inventive step and how this is reflected in the various national laws.

1.1 a) *What is the effect of a prior art disclosure on novelty and inventive steps?*

The effect of prior art disclosure is established in Article 17 of Decision 486 of the Andean Community: for the purposes of determining patentability, no account shall be taken of any disclosure of the contents of the patent during the year prior to the filing date of the application in the Member Country or during the year before the date of priority, if claimed, providing that the disclosure was attributable to:

- i) the inventor or the inventor's assignee;
- ii) a competent national office that publishes the contents of a patent application filed by the inventor or the inventor's assignee in contravention of the applicable provision; or,
- ii) a third party who obtained the information directly or indirectly from the inventor or the inventor's assignee.

The effect of prior art on novelty is established in Article 18 of Decision 486 of the Andean Community: An invention shall be regarded as involving an inventive step if, for a person in the trade with average skills in the technical field concerned, the said invention is neither obvious nor obviously derived from the state of the art.

b) *Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand?*

No there are no differences in the interpretation, novelty it is related to the determination of existence of an inventive step.

c) *Do pending applications which have not yet been published affect the assessment of novelty and inventive step?*

If the application is not yet published it will have no effect on the assessment of novelty and inventive step. Nevertheless Article 16 states that solely for the purpose of determining novelty, the contents of a patent application pending before the competent national office and having a filing date or priority application date earlier than the date of the patent or patent priority application under examination, shall likewise be considered part of the state of the art, provided that the said contents are included in the earlier application when published or that the period stipulated in Article 40 of

eighteen months after the filing date in the Member Country concerned or, where priority is claimed, after the date of application.

1.2 *Do the national laws give definitions or indications as to what constitutes a prior art disclosure?*

Products or processes already patented and everything that has been made available to the public by written or oral description, use, marketing, or any other means prior to the filing date of the patent or, where appropriate, of the priority claimed may not be the subject of new patents on the sole ground of having been put to a use different from that originally contemplated by the initial patent.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

There are no specific guidelines other than those given by law.

2. Criteria for disclosure

The determination of a disclosure has to consider various criteria. These criteria comprise the means of information (written, oral or otherwise), the time of information (recently or a long time ago), the place of information (domestic or abroad), the person who discloses the information (the applicant of an IPR or a third person) and the recipient of the information.

2.1 *Means of disclosure*

a) Products or processes already patented and everything that has been made available to the public by written or oral description, use, marketing, or any other means prior to the filing date of the patent or, where appropriate, of the priority claimed may not be the subject of new patents.

b) *What are recognized means of disclosure?*

Everything that has been made available to the public by written or oral description, use, marketing, or any other means prior to the filing date of the patent or, where appropriate, of the priority claimed.

c) *Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?*

There are no additional requirements.

2.2 *Time of disclosure*

a) *Does it matter if a disclosure has been made recently or a long time ago?*

No.

b) *Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?*

No.

2.3 *Place of disclosure*

In some countries only a disclosure of a piece of information in that specific country may affect novelty whereas a disclosure abroad will not be taken into consideration. As an example, one can mention the publication of printed materials which are published in one country and of which only a few copies will cross the border to another country by accident or unintentionally.

a) *Is the place of disclosure relevant?*

No.

b) *How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally?*

Article 17 of Decision 486 of the Andean Community states that no account shall be taken of any disclosure of the contents of the patent during the year prior to the filing date of the application in the Member Country or during the year before the date of priority, if claimed, providing that the disclosure was attributable to:

- i) a competent national office of the Andean Community publishes the contents of a patent application filed by the inventor or the inventor's assignee in contravention of the applicable provision; or,
 - ii) a third party who obtained the information directly or indirectly from the inventor or the inventor's assignee.
- c) *Which is the applicable law for determining whether a disclosure has occurred?*
- The applicable law for determining whether a disclosure has occurred is the law of the country in which novelty and inventive step is assessed.

2.4 *Personal elements*

It may make a difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

- a) *What differences do the Groups observe with regard to the person who discloses the prior art?*
- It depends who discloses the prior art and when it is disclosed. If it is the inventor or the inventor's assignee; a competent national office or a third party who obtained the information directly or indirectly from the inventor or the inventor's assignee.
- b) *Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?*
- If the disclosure was attributable to a third party who obtained the information directly or indirectly from the inventor or the inventor's assignee no account shall be taken of any disclosure of the contents of the patent during the year prior to the filing date of the application in the Member Country or during the year before the date of priority, if claimed.
- c) *How are errors in the disclosed information treated?*
- No account will be taken of any disclosure of the contents of the patent during the year prior to the filing date of the application in the Member Country or during the year before the date of priority, if claimed.

2.5 *Recipient of the information*

In general, the concept of disclosure requires that information be disclosed to the public. There may be differences with regard to the definition of the public. This concern, among others, confidentiality obligations or the ability to understand the information.

- a) *What requirements are there with regard to the ability to understand the information?*
- There are no specific rules concerning the ability to understand the information.
- b) *Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure?*
- No.
- c) *Are there general rules providing for the effect of confidentiality or implied confidentiality?*
- No.

3. Disclosure through new media

Modern technologies and in particular the introduction of the internet have made access to information world-wide much easier in a much shorter time. At the same time, the life of the information seems to be getting shorter. Information is visible and maybe also reproducible for a short time. This also leads to the danger of manipulating the disclosed information which can be done either by the author or by third parties. With regard to new media this danger seems significantly higher than in other forms of disclosure, such as written documents. The world-wide web raises questions as to the place of disclosure. Merely the fact that information can be accessed all over the world may not lead to a disclosure in the legal sense in every country. Problems arise which are similar to those in connection with oral disclosure, such as questions of evidence, accessibility and duration of the information.

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

No, the state of the art comprises everything that has been made available to the public by written or oral description, use, marketing, or any other means prior to the filing date of the patent or, where appropriate, of the priority claimed.

3.2 Questions of confidentiality

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

There are no specific indication related to encrypted or relevance to passwords, search engines and payment requirements have.

3.3 Place of disclosure

As explained earlier, in some cases the place of disclosure may be relevant for the assessment of novelty or the inventive step.

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

The law does not make any difference on the place of disclosure.

3.4 Timing of disclosure

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

The law does not make any difference on the timing of disclosure.

3.5 Questions of evidence

The fact that information on the internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or manipulation. Such problems may arise during the prosecution of a patent application as well as in infringement cases.

a) *Who should have the burden of proof that a specific piece of information was disclosed on the internet?*

The person who states that the specific piece of information was disclosed on the internet.

b) *Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways?*

Yes, there is no general experience that will indicate the same behaviour of the internet disclosure as for oral disclosure or the disclosure in other ways.

- c) *Should there be different levels of evidence for different ways of disclosure?*

There should be equivalent levels of evidence for different ways of disclosure.

- d) *Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?*

Yes there should be different standards for the recognition of disclosure through new media. Locally, there are no such rules.

Traduction française

1. Détermination de l'art antérieur

Comme l'indique le titre de la question, celle-ci traite des divulgations de l'art antérieur. Son but n'est pas de traiter des questions spécifiques découlant de la divulgation dans le contexte de la portée de la protection ou des formalités des demandes de brevet. Pour déterminer les critères pour la divulgation de l'art antérieur, il convient de mentionner en premier lieu quels sont les principes généraux concernant la relation entre la divulgation, la nouveauté et l'activité inventive, et la manière dont ceci se reflète dans les différentes lois nationales.

- 1.1 a) *Quel est l'effet de la divulgation d'un art antérieur la nouveauté et l'activité inventive?*

L'effet de la divulgation de l'art antérieur est établi dans Article 17 de la Décision 486 de la Communauté andine: ne sera pas pris en compte aucune révélation des volumes du brevet pendant le prior de l'année à la date du classement dans le Pays Membre pour les propos de déterminer l'habilité évidente, ou pendant l'année avant la date de priorité, oui, a exigé et a réclamé que la révélation était attribuable à:

- i) l'inventeur ou le cessionnaire de l'inventeur;
- ii) un bureau national compétent qui publie le contenu d'une application brevetée classée par l'inventeur ou le cessionnaire de l'inventeur dans l'infraction de la provision applicable; ou,
- iii) une troisième partie qui a obtenu directement ou indirectement l'information de l'inventeur ou le cessionnaire de l'inventeur.

L'effet d'art antérieur sur la nouveauté est établi dans Article 18 de la Décision 486 de la Communauté andine: Une invention sera considérée comme impliquée dans un pas inventif si, pour une personne dans le commerce avec peu d'habilités dans le champ technique impliqué, dite invention n'est pas évidente ni obligatoirement dérivé de la pointe du progrès.

- b) *Existe-t-il différences entre l'art antérieur concernant la nouveauté d'une part, et l'activité d'autre part?*

Non, il n'y a pas de différences dans l'interprétation, la nouveauté est en rapport avec la détermination de l'existence d'un pas inventif.

- c) *Les demandes en cours, qui n'ont pas encore été publiées, affectent-elle l'évaluation de la nouveauté et de l'activité inventive?*

Si l'application n'est pas encore publiée il n'aura aucun effet sur l'estimation du nouveauté et pas inventif. Néanmoins l'Article 16 déclare qu'uniquement pour le but de déterminer la nouveauté, le contenu d'une application brevetée en suspens avant le

bureau national compétente et en ayant une date de classement ou une date d'application de priorité avant la date de l'application en suspens ou en suspens sous examen, sera considéré également partie de la pointe du progrès, pourvu que le dit contenu soit inclus dans l'application précédente quand a été publié ou que la période a été stipulée dans Article 40 de dix-huit mois après la date du classement dans le Pays Membre intéressé ou, où la priorité est exigée après la date d'application.

1.2 *Les lois nationales donnent-elles des définitions ou indications sur ce qui constitue une divulgation de l'art antérieur?*

Les produits ou les processus sont déjà brevetés et tout ce qui a été mis à la disposition du public par écrit ou en description orale, usage, marketing, ou tous autres moyens avant la date du classement du brevet ou, où adéquatément a la priorité réclamée l'affaire de nouveaux brevets ne peut pas être sur le seul terrain d'où il provient originairement pour un usage différent de celui contemplé par le brevet initial.

1.3 *Quelles sont les directives utilisées pour déterminer si un élément d'art antérieur a été divulgué?*

Cette question vise les directives autres que celles énoncées par la loi qui ont été établies dans les différents pays pour déterminer une divulgation.

2. Critères pour la divulgation

La détermination d'une divulgation doit prendre en compte différents critères. Ces critères comprennent les moyens d'information (écrits, oraux, ou autres), la date de l'information (récent ou ancienne), le lieu de l'information (domestique ou à l'étranger), la personne qui divulgue l'information (le demandeur d'un droit de protection intellectuelle ou une tierce personne) et le bénéficiaire de l'information.

2.1 Moyens de divulgation

a) Les Produits du a. ou les processus qui ont déjà été brevetés et tout ce qui a été mis à la disposition du public par écrit ou par description orale, usage, marketing, ou tout autre moyen avant la date du classement du brevet ou, le destinataire de la priorité exigée dans l'affaire de nouveaux brevets ne peut pas l'être.

b) *Quels sont les moyens reconnus de divulgation?*

Tout par ce qui a été mis à la disposition du public par écrit ou par description orale, usage, marketing, ou tout autre qui a été fait disponible au public écrit ou description orale, usage, marketing, ou tous autres moyens avant la date du classement du brevet ou, le destinataire de la priorité réclamée.

c) *Existe-t-il des exigences supplémentaires pour certains types de divulgation, tels que la divulgation orale ou la divulgation par l'usage, par rapport`a la divulgation par le biais des documents écrits?*

Il n'y a pas d'exigences supplémentaires.

2.2 Date de divulgation

a) *Est-il important qu'une divulgation ait été faite récemment ou depuis longtemps déjà?*

Non.

b) *Existe-t-il des limites au-delà desquelles la publication d'une information, bien qu'elle constitue une divulgation de l'art antérieur, n'est plus pertinente pour l'évaluation de la nouveauté et de l'activité inventive?*

Non.

2.3 Lieu de la divulgation

Dans certains pays, seule une divulgation d'une information dans ce pays spécifique peut affecter la nouveauté, tandis qu'une divulgation à l'étranger ne sera pas prise en considération. A titre d'exemple, on peut citer la publication de documents imprimés qui sont publiés dans un pays et dont seuls quelques exemplaires traversent la frontière vers un autre pays, par accident ou par inadvertance.

a) *Le lieu de la divulgation est-il pertinent?*

Non.

b) *Comment déterminer le lieu de la divulgation? Importe-t-il que la divulgation ait eu lieu dans ce pays par accident ou qu'elle ait eu lieu de façon intentionnelle?*

L'article 17 de Décision 486 de la Communauté andine déclare qu'il ne sera pas prise en considération toute divulgation du contenu du brevet pendant l'année avant la date du classement de l'application dans le Pays Membre ou pendant l'année avant la date de priorité, si a réclamé, en fournissant les preuves que la révélation était attribuable à:

i) un bureau national compétent de la Communauté andine qui publie le contenu d'une application brevetée classée par l'inventeur ou le cessionnaire de l'inventeur dans l'infraction de la provision applicable; ou,

ii) une troisième partie qui a obtenu directement ou indirectement l'information de l'inventeur ou le cessionnaire de l'inventeur.

c) *Quelle est la législation applicable pour déterminer si une divulgation a eu lieu?*

La loi applicable pour déterminer si une divulgation s'est produite est la loi du pays dans lequel la nouveauté et le pas inventif ont été évalués.

2.4 *Éléments personnels*

Le fait qu'une information soit divulguée par le demandeur d'un droit de protection intellectuelle ou par une tierce personne peut importer. Ceci concerne également la protection en matière d'expositions et le délai de grâce.

a) *Quelles sont les différences observées par les Groupes à l'égard de la personne qui divulgue l'art antérieur?*

Cela dépend de qui divulgue l'art antérieur et quand il est divulgué. Si c'est l'inventeur ou le cessionnaire de l'inventeur; un bureau national compétent ou une troisième partie qui ont obtenu directement ou indirectement l'information de l'inventeur ou le cessionnaire de l'inventeur.

b) *La divulgation est-elle traitée différemment si l'auteur de la divulgation était lié par un accord de confidentialité?*

Si la divulgation était attribuable à une troisième partie qui a obtenu directement ou indirectement l'information de l'inventeur ou le cessionnaire de l'inventeur, sera prise en considération toute divulgation du contenu du brevet pendant l'année avant la date du classement de l'application dans le Pays Membre ou pendant l'année avant la date de priorité, si l'a réclamé.

c) *Comment sont traitées les erreurs dans l'information divulguée?*

Se prendra en considération toute divulgation du contenu du brevet pendant l'année avant la date du classement de l'application dans le Pays Membre ou pendant l'année avant la date de priorité, s'il l'a réclamé.

2.5 *Bénéficiaire de l'information*

En général, le concept de divulgation implique que les informations soient divulguées au public. Il peut exister des différences quant à la définition du public. Ceci concerne, entre autres choses, les obligations de confidentialité ou l'aptitude à comprendre les informations.

a) *Quelles sont les exigences à l'égard de l'aptitude à comprendre les informations?*

Il n'y a pas de règles spécifiques à propos de la capacité de comprendre l'information.

- b) *Est-ce que la possibilité qu'une personne puisse obtenir les informations par des étapes supplémentaires, telles que le démontage de modes de réalisation ou une procédure de construction à l'envers (reverse engineering), suffisent à constituer une divulgation?*

Non.

- c) *Existe-t-il des règles générales couvrant l'effet de confidentialité ou la confidentialité implicite?*

Non.

3. Divulgation par les nouveaux médias

Les technologies modernes, et en particulier l'introduction d'internet, ont largement facilité l'accès aux informations au niveau mondial, et ce dans des temps beaucoup plus courts. En même temps, la longévité des informations semble se réduire. Les informations sont visibles et éventuellement aussi reproductibles pendant une courte durée. Ceci mène également au risque de manipulation des informations divulguées, soit par l'auteur, soit par des tiers. En ce qui concerne les nouveaux médias, ce danger semble considérablement plus important que dans d'autres formes de divulgation, telles que les documents écrits. La "toile" mondiale soulève des questions quant au lieu de divulgation. Le simple fait que les informations puissent être accessibles dans le monde entier peut ne pas conduire à une divulgation au sens juridique du terme dans tous les pays. Il y a des problèmes similaires à ceux liés à la divulgation orale, tels que les questions de preuves, d'accessibilité et de durée des informations.

3.1 Règles générales

Des informations sans support papier, par exemple dans un réseau électronique ou à travers Internet, constituent-elles une divulgation suffisante susceptible d'affecter la nouveauté ou l'activité inventive? Existe-t-il des exigences spécifiques par rapport à d'autres formes de divulgation? Existe-t-il des différences à l'égard de différentes formes de réseaux ou communications telles que la "toile" mondiale, les groupes de discussion ou les forums, courrier électronique et autres?

Non, la pointe du progrès comprend tout ce qui a été mis à la disposition du public, par écrit ou description orale, usage, marketing, ou tous autres moyens avant la date du classement du brevet ou, où approprié, de la priorité réclamée.

3.2 Problèmes de confidentialité

Cela fait-il une différence si les informations sont cryptées? Quelle pertinence ont les exigences relatives aux mots de passe, aux moteurs de recherche et aux exigences sécurisées?

Il y a aucune indication spécifique racontée à codée ou pertinente aux mots de passe, les objets de recherche et les exigences du paiement.

3.3 Lieu de la divulgation

Comme expliqué précédemment, dans certains cas, le lieu de divulgation peut être pertinent pour l'évaluation de la nouveauté ou de l'activité inventive.

Quelle est le lieu de divulgation si les informations sont mises sur Internet? Le simple fait qu'un site web puisse être accessible en un certain endroit ou doit-il y avoir des conditions ou exigences supplémentaires?

La loi ne fait pas toute la différence sur le lieu de divulgation.

3.4 Date de la divulgation

Existe-t-il certaines exigences quant à la date et la durée des informations disponibles par les moyens électroniques? Des archives sont-elles nécessaires ou souhaitables?

La loi ne fait pas de différence sur le réglage de révélation.

3.5 *Problèmes de preuve*

Le fait que des informations sur Internet puissent ne peut pas être aussi permanentes qu'un document écrit peut donner lieu à une perte de ce document ou à des problèmes de preuve ou de manipulation. Ces problèmes peuvent surgir lors de la procédure d'examen de la demande de brevet ainsi que lors de procès en contrefaçon.

- a) *Qui doit avoir la charge de la preuve qu'une information spécifique a été divulgué sur Internet? Est-ce qu'internet nécessite des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens?*

La personne qui déclare que le renseignement spécifique a été divulgué sur l'internet.

- b) *Est-ce qu'internet nécessite des règles différentes de celles existant déjà pour la divulgation orale ou la divulgation par d'autres moyens?*

Oui, il n'y a aucune expérience générale qui indiquera le même comportement de la divulgation d'Internet comme pour divulgation orale ou par des autres moyens.

- c) *Doit-il exister différents niveaux de preuve pour différents modes de divulgation?*

Il devrait y avoir des niveaux équivalents d'évidence pour différents modes de divulgation.

- d) *La manipulation potentielle d'informations divulguées par les nouveaux médias exige-t-elle des normes différents pour la reconnaissance de cette divulgation, et y a-t-il des règles spécifiques pour ce type de divulgation?*

Oui il devrait y avoir des niveaux différents pour la reconnaissance de divulgation à travers nouveaux médias. Localement, il n'y a pas de telles règles.

Deutsche Uebersetzung

1. Bestimmung des Standes der Technik

Wie der Titel der Frage zeigt, behandelt die Frage die Offenbarung im Stand der Technik. Das Ziel besteht nicht darin, spezifische Fragen zu behandeln, die aus der Offenbarung im Zusammenhang mit dem Schutzbereich oder mit Formalien der Patentanmeldung resultieren. Um Kriterien für die Offenbarung des Standes der Technik zu entwickeln, sollte zunächst festgestellt werden, welches die Hauptgrundsätze für das Verhältnis zwischen Offenbarung, Neuheit und Erfindungshöhe sind und wie sich diese in den verschiedenen nationalen Rechten widerspiegeln.

- 1.1 a) *Welchen Effekt hat die Veröffentlichung eines Standes der Technik auf Neuheit und Erfindungshöhe?*

Die Wirkung der vorausgehenden Erfindungsentdeckung wird in Artikel 17. von Entscheidung 486 der Andischen Gemeinschaft begründet: für die Zwecke, Patentfähigkeit zu bestimmen, wird während vorhergehenderes Jahres vor dem Registrierungsdatum des Antrages im Mitgliedsstaat oder während des Jahres vor dem Datum der Priorität, wenn es fordert wird, keine Entdeckung der Inhalten des Patenten in Betracht zieht. Ausserdem, die Entdeckung kann zurückführbar sein auf:

- i) den Erfinder oder den Rechtsnachfolger des Erfinders;
- ii) ein fähiges nationales Büro, das den Inhalt einer Patentanmeldung, die von dem Erfinder oder dem Rechtsnachfolger des Erfinders in Verstoß gegen die anwendbare Bereitstellung registriert ist, veröffentlicht; oder,

- iii) einen dritten Teil, den die Informationen direkt oder indirekt vom Erfinder oder dem Rechtsnachfolger des Erfinders erhielt.

Die Wirkung der vorausgehenden Erfindung auf Neuheit wird im Artikel 18 von Entscheidung 486 der Andischen Gemeinschaft begründet: man muss denken, dass eine Erfindung schöpferischen Schritt hat, wenn für eine Person im Handel mit durchschnittlichen Fähigkeiten im technischen Feld die genannte Erfindung weder offenbar, noch offensichtlich ableitbar von dem Wesen der Erfindung ist.

- b) *Gibt es Unterschiede zwischen dem Stand der Technik in bezug auf Neuheit einerseits und Erfindungshöhe andererseits?*

Nein, es gibt keine Unterschiede in der Auslegung. Neuheit wird in Verbindung mit der Bestimmung der Existenz eines schöpferischen Schrittes gebracht.

- c) *Beeinflussen anhängige Anmeldungen, die noch nicht veröffentlicht sind, die Beurteilung von Neuheit und Erfindungshöhe?*

Wenn die Patentanmeldung noch nicht veröffentlicht wird, hat es keine Wirkung auf die Einschätzung von Neuheit und schöpferischem Schritt. Trotzdem, Artikel 16. bestätigt, dass die Inhalts der Patentanmeldung, die vor dem fähigen nationalen Büro unerledigt sei und Registrierungsdatum oder eine Anmeldungsprioritätsdatum vorher dem Datum des Patentes oder der Prioritätsanmeldung des Patentes unter Inspektion habe, nur für den Zweck, Neuheit zu bestimmen, ebenso für Teil des neusten Wesens der Erfindung gehalten werden, vorausgesetzt, dass die genannten Inhalts im vorhergehenden Patentanmeldung als veröffentlicht eingeschlossen wird, oder dass die festgelegte Periode in Artikel 40 achtzehn Monaten nach dem Registrierungsdatum in dem Mitgliedstaat ist, oder, wo Priorität fordert wird, nach dem Datum der Anmeldung.

- 1.2 *Enthalten die nationalen Rechte Definitionen oder Hinweise darauf, worin eine Offenbarung des Standes der Technik besteht?*

Produkte oder Prozesse, die schon patentiert worden sind, und alles, was dadurch zur Öffentlichkeit entweder geschrieben oder mündliche Beschreibung verfügbar gemacht worden ist, die Verwendung, Marketing oder irgendwelche andere Mittel vor dem Registrierungsdatum des Patentes oder, wo es fordert wird, der Priorität, sollen nicht das Thema eines neuen Patentes sein, nur auf den Gründung einer neuen Verwendung, die nicht wie im dem originellen des anfänglichen Patentes in Erwägung gezogen wird.

- 1.3 *Welche Regeln werden angewandt, um zu beurteilen, ob ein bestimmter Stand der Technik offenbart worden ist?*

Es gibt keine bestimmten Richtlinien anders als jene, die von Gesetz gegeben sind.

2. Kriterien für die Offenbarung

Die Beurteilung einer Offenbarung muss verschiedene Kriterien berücksichtigen. Diese Kriterien umfassen das Medium der Information (schriftlich, mündlich oder auf andere Weise), den Zeitpunkt der Information (kürzlich oder vor einer langen Zeit), den Ort der Information (im Inland oder Ausland), die Person, die die Information offenbart (Anmelder eines gewerblichen Schutzrechts oder eine dritte Person) und den Empfänger der Information.

2.1 Wege der Offenbarung

- a) Produkte oder Prozesse, die schon patentiert worden sind, und alles, was dadurch zur Öffentlichkeit entweder geschrieben oder mündliche Beschreibung verfügbar gemacht worden ist, die Verwendung, Marketing oder irgendwelche andere Mittel vor dem Registrierungsdatum des Patentes oder, wo es fordert wird, der Priorität, sollen nicht das Thema eines neuen Patentes sein.
- b) *Welches sind anerkannte Wege der Offenbarung?*

Alles, was dadurch zur Öffentlichkeit entweder geschrieben oder mündliche Beschreibung verfügbar gemacht worden ist, die Verwendung, Marketing oder irgendwelche andere Mittel vor dem Registrierungsdatum des Patentbesitzes oder, wo es fordert wird, der Priorität.

- c) *Gibt es zusätzliche Erfordernisse für bestimmte Arten der Offenbarung, wie mündliche Offenbarung oder die Offenbarung durch Benutzung im Vergleich zur Offenbarung durch schriftliche Dokumente?*

Es gibt keine zusätzlichen Anforderungen.

2.2 Zeit der Offenbarung

- a) *Macht es einen Unterschied, ob die Offenbarung erst kürzlich oder vor einer langen Zeit erfolgt ist?*

Nein.

- b) *Gibt es Grenzen, jenseits derer die Veröffentlichung einer Information, obschon sie eine Offenbarung des Standes der Technik begründen könnte, nicht länger als relevant für die Beurteilung der Neuheit und der Erfindungshöhe angesehen wird?*

Nein.

2.3 Ort der Offenbarung

In einigen Ländern wirkt sich eine Offenbarung auf die Neuheit nur dann aus, wenn die Offenbarung der Information in dem betreffenden Land stattgefunden hat, während eine Offenbarung im Ausland nicht berücksichtigt wird. Als Beispiel kann die Veröffentlichung von gedruckten Materialien genannt werden, die in einem Land veröffentlicht werden und von denen nur wenige Exemplare zufällig oder ungewollt die Grenze in ein anderes Land überschreiten.

- a) *Ist der Ort der Offenbarung relevant?*

Nein.

- b) *Wie wird der Ort der Offenbarung bestimmt? Macht es einen Unterschied, ob die Offenbarung in einem bestimmten Land zufällig oder gewollt erfolgt ist?*

Artikel 17 von Entscheidung 486 der Andischen Gemeinschaft bestätigt, dass während des Jahres vor dem Registrierungsdatum der Anmeldung im Mitgliedsstaat oder während des Jahres vor dem Datum der Priorität, wenn es fordert wäre, keine Entdeckung des Inhaltes des Patentbesitzes in Erwägung gezogen werden wird, und die Entdeckung kann zurückführbar sein auf:

- i) ein fähiges nationales Büro der Andischen Gemeinschaft, das den Inhalt einer Erfindungsentdeckung Anmeldung veröffentlicht, die vom Erfinder oder dem Rechtsnachfolger des Erfinders in Verstoß gegen die anwendbare Bereitstellung registriert wird; oder,
- ii) einen dritten Teil, der die Informationen direkt oder indirekt vom Erfinder oder dem Rechtsnachfolger des Erfinders erhielt.

- c) *Welches Recht ist anwendbar, um zu beurteilen, ob eine Offenbarung stattgefunden hat?*

Das anwendbare Gesetz zum Entschließen, ob eine Entdeckung vorgekommen ist, ist das Gesetz des Landes, indem Neuheit und schöpferischer Schritt bewertet werden.

2.4 Persönliche Elemente

Es kann unterschiedlich zu behandeln sein, ob eine Information durch den Anmelder eines gewerblichen Schutzrechts oder durch eine dritte Person offenbart wird. Dies betrifft auch den Ausstellungsschutz und die Neuheitsschonfrist.

- a) *Welche Unterschiede stellen die Gruppen im Hinblick auf die Person fest, die den Stand der Technik veröffentlicht?*

Es hängt davon ab, wer die vorausgehende Erfindung enthüllt, und wann es enthüllt wird. Wenn es der Erfinder oder der Rechtsnachfolger des Erfinders ist; ein fähiges nationales Büro oder eine dritte Partei, die die Informationen direkt oder indirekt vom Erfinder oder dem Rechtsnachfolger des Erfinders erhielt.

- b) *Wird eine Veröffentlichung anders behandelt, wenn die offenbarende Person durch eine Geheimhaltungsabrede gebunden war?*

Wenn die Entdeckung zurückführbar einer dritten Partei wäre, die die Informationen direkt oder indirekt vom Erfinder oder dem Rechtsnachfolger des Erfinders erhielt, wird während des Jahres vor dem Registrierungsdatum der Anmeldung im Mitgliedsstaat oder während des Jahres vor dem Datum der Priorität, wenn es fordert wäre, keine Entdeckung des Inhaltes des Patentes in Erwägung gezogen werden.

- c) *Wie werden Irrtümer in der offenbarten Information behandelt?*

Es wird während des Jahres vor dem Registrierungsdatum der Anmeldung im Mitgliedsstaat oder während des Jahres vor dem Datum der Priorität, wenn es fordert wäre, keine Entdeckung des Inhaltes des Patentes in Erwägung gezogen werden.

2.5 Empfänger der Information

Im allgemeinen erfordert das Prinzip der Offenbarung, dass Informationen der Öffentlichkeit gegenüber offenbart werden. Es mag Unterschiede mit Blick auf die Definition des Begriffs "Öffentlichkeit" geben. Dies betrifft u.a. Vertraulichkeitsverpflichtungen oder die Fähigkeit, die Information zu verstehen.

- a) *Welche Erfordernisse gibt es im Hinblick auf die Fähigkeit zum Verständnis der Information?*

Es gibt keine bestimmten Regeln in Hinsicht auf die Fähigkeit, die Informationen zu verstehen.

- b) *Reicht die Möglichkeit, dass eine Person Informationen durch zusätzliche Maßnahmen, wie etwa die Demontage von Vorrichtungen oder reverse engineering, erhält, aus, um eine Offenbarung zu begründen?*

Nein.

- c) *Gibt es allgemeine Regeln im Hinblick auf Vertraulichkeit oder stillschweigend vereinbarte Vertraulichkeit?*

Nein.

3. Offenbarung durch neue Medien

Moderne Technologien und insbesondere die Einführung des Internets haben den Zugang zu Informationen weltweit in deutlich kürzerer Zeit vereinfacht. Gleichzeitig scheint sich das Leben von Informationen zu verkürzen. Die Information ist während eines kurzen Zeitraums sichtbar und möglicherweise auch reproduzierbar. Dies führt auch zu der Gefahr der Manipulation von offenbarten Informationen, die entweder durch den Urheber oder durch dritte Parteien vorgenommen werden kann. Im Hinblick auf neue Medien scheint diese Gefahr deutlich höher zu sein als bei anderen Formen der Offenbarung, wie etwa schriftlichen Dokumenten. Das World-Wide-Web wirft Fragen auch im Hinblick auf den Ort der Offenbarung auf. Allein der Umstand, dass eine Information weltweit abgerufen werden kann, muss nicht zu einer Offenbarung im Rechtssinne in jedem Land führen. Insofern ergeben sich ähnliche Probleme wie im Zusammenhang mit der mündlichen Offenbarung, insbesondere Fragen der Beweisführung, des Zugangs und der Dauerhaftigkeit von Informationen.

3.1 Allgemeine Regeln

Bewirkt eine papierlose Information, z.B. in einem elektronischen Netzwerk oder über das Internet, eine ausreichende Offenbarung, um Neuheit oder Erfindungshöhe zu beeinflussen? Gibt es im Vergleich mit anderen Arten der Offenbarung spezifische Erfordernisse? Bestehen Unterschiede im Hinblick auf verschiedene Formen der Netzwerke oder der Kommunikation, wie etwa das World-Wide-Web, Chat-Groups, Forums, E-Mail oder andere?

Nein, das neuste Wesen der Erfindung umfasst alles, was dadurch zur Öffentlichkeit entweder geschrieben oder mündliche Beschreibung verfügbar gemacht worden ist, die Verwendung, Marketing oder irgendwelche andere Mittel vor dem Registrierungsdatum des Patentes oder, wo es fordert wäre, der Priorität.

3.2 *Fragen der Vertraulichkeit*

Macht es einen Unterschied, wenn die Information verschlüsselt ist? Welche Relevanz besitzen Passwörter, Suchmaschinen und die Gebührenpflichtigkeit von Informationen?

Es gibt kein bestimmtes Anzeichen in Verbindung mit kodierte Informationen oder Relevanz zu Passwörtern, Suchmaschinen und Zahlungsanforderungen

3.3 *Ort der Offenbarung*

Wie zuvor erläutert, kann in einigen Fällen der Ort der Offenbarung für die Beurteilung der Neuheit oder Erfindungshöhe relevant sein.

Welches ist der Ort der Offenbarung, wenn eine Information in das Internet eingestellt wird? Genügt der bloße Umstand, dass eine Website an einem bestimmten Ort zugänglich ist, für eine Offenbarung an dem betreffenden Ort, oder sollte es zusätzliche Bedingungen oder Erfordernisse geben?

Das Gesetz macht auf der Stelle der Bekanntgabe keinen Unterschied

3.4 *Zeitpunkt der Offenbarung*

Gibt es bestimmte Erfordernisse für den Zeitpunkt und die Dauerhaftigkeit der Information, die durch elektronische Mittel verfügbar ist? Sind Archive notwendig oder wünschenswert?

Das Gesetz macht auf dem Timing der Bekanntgabe keinen Unterschied

3.5 *Fragen der Beweisführung*

Informationen im Internet mögen im Einzelfall nicht so dauerhaft sein wie schriftliche Dokumente. Dies kann zu einem Verlust des Dokuments führen oder Probleme der Beweisführung oder Manipulation aufwerfen. Solche Probleme können sich sowohl während des Erteilungsverfahrens als auch bei Verletzungsverfahren ergeben.

a) *Wer sollte die Beweislast dafür tragen, dass eine bestimmte Information über das Internet offenbart wurde?*

Die Person, die bestätigt, dass der bestimmten Teil der Information auf das Internet enthüllt wurden

b) *Erfordert das Internet Regeln, die sich von den schon bestehenden Regeln für die mündliche Offenbarung oder die Offenbarung auf anderem Wege unterscheiden?*

Ja, es gibt keine allgemeine Erfahrung, die auf das gleiche Verhalten der Internetentdeckung wie für mündliche Entdeckung oder die Entdeckung auf andere Weisen hinweisen wird

c) *Sollte es unterschiedliche Grade des Beweises für verschiedene Wege der Offenbarung geben?*

Es sollte gleichwertige Niveaus des Beweises für andere Wege der Entdeckung geben.

d) *Erfordert die potentielle Manipulation von Informationen, die durch neue Medien offenbart wurden, unterschiedliche Maßstäbe für die Anerkennung solcher Offenbarungen und gibt es für diese Art von Offenbarungen spezifische Regeln?*

Ja, es sollte andere Standards für die Anerkennung der Entdeckung durch neue Medien geben. Örtlich gibt es keine solchen Regeln.